

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MERCK SHARP & DOHME LLC,  
Petitioner

v.

HALOZYME, INC.,  
Patent Owner

---

Case PGR2025-00030  
U.S. Patent No. 12,054,758

---

**PATENT OWNER'S UPDATED MANDATORY NOTICES  
PURSUANT TO 37 C.F.R. § 42.8(a)(3)**

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Patent Owner Halozyme, Inc. (“Patent Owner”) hereby files these updated mandatory notices pursuant to 37 C.F.R. § 42.8(a)(3) to update Patent Owner’s list of related matters to include the recently-filed post-grant review proceeding PGR2025-00050 and to update the listing of Patent Owner’s back-up counsel and service information. No other changes are made to the mandatory notices.

## **I. RELATED MATTERS**

On April 24, 2025, Patent Owner filed a complaint for infringement by Petitioner Merck Sharp & Dohme LLC (“Petitioner”) of U.S. Patent No. 12,054,758 (“the ’758 patent”), among other patents. *Halozyme, Inc. v. Merck Sharp & Dohme LLC f/k/a/ Merck Sharp & Dohme Corp.*, Civil Action No. 2:25-cv-03179 (D.N.J.). Also at issue in this civil action are the following related U.S. patents: 10,865,400; 11,041,149; 11,066,656; 11,952,600; 12,018,298; 12,037,618; 12,049,652; 12,077,791; 12,091,692; 12,104,185; 12,110,520; 12,152,262; 12,195,773; and 12,264,345.

On May 7, 2025, Petitioner filed a petition for post-grant review (proceeding no. PGR2025-00050) of related U.S. Patent No. 12,077,791, which is at issue in the above-referenced civil action. Petitioner has previously filed petitions for post-grant review of several other related patents, most of which are also at issue in the above-referenced civil action. The chart below provides a full list of these patents and post-grant review proceedings.

<b>U.S. Patent No.</b>	<b>PGR No.</b>	<b>PGR Petition Filed</b>	<b>At Issue In DNJ Civil Action</b>
11,952,600	PGR2025-00003	November 12, 2024	Yes
12,018,298	PGR2025-00004	November 26, 2024	Yes
12,152,262	PGR2025-00006	December 10, 2024	Yes
12,123,035	PGR2025-00009	December 27, 2024	No
12,110,520	PGR2025-00017	January 17, 2025	Yes
12,060,590	PGR2025-00024	February 21, 2025	No
12,049,652	PGR2025-00033	March 7, 2025	Yes
12,104,185	PGR2025-00039	March 28, 2025	Yes
12,037,618	PGR2025-00042	April 15, 2025	Yes
12,091,692	PGR2025-00046	April 29, 2025	Yes
12,077,791	PGR2025-00050	May 7, 2025	Yes

The '758 patent is related to the following pending U.S. Patent Applications:

<b>Appl. No.</b>	<b>Filed</b>
18/759,577	June 28, 2024
18/922,889	October 22, 2024
18/069,651	December 21, 2022
18/340,786	June 23, 2023
19/071,005	March 5, 2025
19/071,055	March 5, 2025
19/075,092	March 5, 2025
19/071,264	March 5, 2025
19/071,345	March 5, 2025

Related U.S. Patent Application No. 18/659,215 issued as U.S. Patent No. 12,195,773 on January 14, 2025. Related U.S. Patent Application No. 18/778,554 issued as U.S. Patent No. 12,264,345 on April 1, 2025.

## II. LEAD AND BACK-UP COUNSEL

Lead Counsel for Patent Owner is:

Eldora L. Ellison, Ph.D. (Reg. No. 39,967) (*unchanged*)  
[eellison-PTAB@sternekessler.com](mailto:eellison-PTAB@sternekessler.com)  
STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1101 K Street, NW, 10th Floor  
Washington, DC 20005  
202-772-8508 (telephone)  
202-371-2540 (facsimile).

Back-up Counsel for Patent Owner are:

R. Wilson Powers III, Ph.D. (Reg. No. 63,504) (*unchanged*)  
[rpowers-PTAB@sternekessler.com](mailto:rpowers-PTAB@sternekessler.com)  
STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1101 K Street, NW, 10th Floor  
Washington, DC 20005  
202-772-8876 (telephone)  
202-371-2540 (facsimile);

Jennifer Meyer Chagnon (Reg. No. 55,440) (*unchanged*)  
[jchagnon-PTAB@sternekessler.com](mailto:jchagnon-PTAB@sternekessler.com)  
STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1101 K Street, NW, 10th Floor  
Washington, DC 20005  
202-772-8890 (telephone)  
202-371-2540 (facsimile);

Tyler C. Liu (Reg. No. 72,126) (*unchanged*)  
[tliu-PTAB@sternekessler.com](mailto:tliu-PTAB@sternekessler.com)  
STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1101 K Street, NW, 10th Floor  
Washington, DC 20005  
202-772-8641 (telephone)  
202-371-2540 (facsimile); and

Aubrey Haddach (Reg. No. 48,374) (*newly added*)  
[ahaddach@halozyme.com](mailto:ahaddach@halozyme.com)  
HALOZYME, INC.  
12390 El Camino Real  
San Diego, CA 92130  
858-204-6690 (telephone).

### III. SERVICE INFORMATION

Please address all correspondence to the lead and back-up counsel as shown above. Patent Owner consents to electronic service by e-mail at all of the e-mail addresses listed above and [PTAB@sternekessler.com](mailto:PTAB@sternekessler.com).

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Eldora L. Ellison/

Eldora L. Ellison, Ph.D.  
Registration No. 39,967  
Attorney for Patent Owner

Date: May 21, 2025

1101 K Street, NW, 10th Floor  
Washington, DC 20005  
(202) 371-2600

**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

I certify that the above-captioned **PATENT OWNER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8(a)(3)** was served in its entirety on May 21, 2025, upon the following parties via electronic mail:

Jeffrey P. Kushan (Lead Counsel)  
Leif Peterson (Back-up Counsel)  
SIDLEY AUSTIN LLP  
Mark Stewart (Back-up Counsel)  
MERCK SHARP & DOHME LLC  
[jkushan@sidley.com](mailto:jkushan@sidley.com)  
[leif.peterson@sidley.com](mailto:leif.peterson@sidley.com)  
[mark.stewart@merck.com](mailto:mark.stewart@merck.com)  
[HalozymePGRs@sidley.com](mailto:HalozymePGRs@sidley.com)

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Eldora L. Ellison/

Eldora L. Ellison, Ph.D.  
Registration No. 39,967  
Attorney for Patent Owner

Date: May 21, 2025

1101 K Street, NW, 10th Floor  
Washington, DC 20005  
(202) 371-2600