

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEOCHORD, INC.
Petitioner

v.

UNIVERSITY OF MARYLAND, BALTIMORE

Patent Owner

Case No. IPR2016-00208
Patent No. 7,635,386

**PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO
PATENT OWNER'S MOTION TO DISMISS**

Table of Contents

	Page
I. UMB HAS NOT WAIVED SOVEREIGN IMMUNITY	1
A. UMB Did Not Waive Immunity by Its Litigation Conduct.....	2
B. UMB Did Not Waive Immunity in the Harpoon MLA	5
II. COVIDIEN IS INDISTINGUISHABLE AND CORRECTLY DECIDED	6
A. Covidien is not distinguishable	7
B. This Case is Governed by FMC, not Cuozzo.....	7
C. Claims of Constitutional and Statutory Abrogation Are Meritless	9
III. CONCLUSION.....	10

Table of Authorities

	Page(s)
Cases	
<i>Baum Research and Dev. Co., Inc. v. Univ. of Mass. at Lowell</i> , 503 F.3d 1367 (Fed. Cir. 2007)	2, 6
<i>Biomedical Patent Mgmt. Corp. v. California, Dep’t of Health Servs.</i> , 505 F.3d 1328 (Fed. Cir. 2007)	9
<i>Central Virginia Community Coll. v. Katz</i> , 546 U.S. 356 (2006).....	9
<i>Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.</i> , 527 U.S. 666 (1999).....	1, 2
<i>Cuozzo Speed Techs. LLC v. Lee</i> , 136 S. Ct. 2131 (2016) (Opp’n).....	7, 8, 9
<i>Edelman v. Jordan</i> , 415 U.S. 651 (1974).....	2, 6
<i>Fed. Mar. Comm’n v. South Carolina State Ports Auth.</i> , 535 U.S. 743 (2002).....	1, 7, 8
<i>Florida Dep’t of Health & Rehab. Servs. v. Florida Nursing Home Ass’n</i> , 450 U.S. 147 (1981).....	6
<i>Florida Dep’t of State v. Treasure Salvors, Inc.</i> , 458 U.S. 670 (1982).....	2, 3, 4, 5
<i>Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank</i> , 527 U.S. 627 (1999).....	9, 10
<i>Hill v. Blind Ind. and Servs. of Maryland</i> , 179 F.3d 754 (1999).....	4, 5

Table of Authorities
(continued)

	Page(s)
<i>Lapides v. Bd. of Regents of Univ. Sys. of Georgia</i> , 535 U.S. 613 (2002).....	3, 4, 5
<i>State Contracting & Eng’g Corp. v. State of Florida</i> , 258 F.3d 1329 (Fed. Cir. 2001)	3, 4, 5
<i>Vas-Cath, Inc. v. Curators of Univ. of Missouri</i> , 473 F.3d 1376 (Fed. Cir. 2007)	3
Statutes	
Patent Remedy Act.....	9, 10
Other Authorities	
37 C.F.R. 42.5(c).....	5
Fourteenth Amendment	10
Fed. R. Civ. P. 12(b)(6).....	2

Petitioner's Opposition does not dispute (1) that UMB is a sovereign arm of the State of Maryland or (2) that, under *Fed. Mar. Comm'n v. South Carolina State Ports Auth.*, 535 U.S. 743 (2002) ("*FMC*"), *inter partes* review ("*IPR*") "substantially resembles" civil litigation, just as *Covidien* found. Petitioner also has no answer to UMB's showing that it retains substantial rights in the '386 Patent and that this IPR cannot proceed without UMB. Petitioner simply ignores the dispositive issue of substantial rights and asserts without argument that Harpoon "should be considered . . . the 'effective patentee'." Opp'n at 3. Petitioner purports to criticize the *Covidien* panel for ignoring "binding . . . precedent," but that precedent has no bearing on the analysis of sovereign immunity. And Petitioner offers arguments for ostensible waiver and abrogation of immunity that are squarely precluded by decisions of the Supreme Court and Federal Circuit. Petitioner's arguments are meritless. The IPR should be dismissed.

I. UMB HAS NOT WAIVED SOVEREIGN IMMUNITY

Petitioner claims that UMB waived immunity by defending on the merits before "belated[ly]" seeking dismissal, and waived expressly in the Harpoon MLA. The test for waiver of sovereign immunity "is a stringent one." *Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 675 (1999) (quotation marks and citation omitted). A State waives immunity only if it "voluntarily invokes [the] jurisdiction" of a forum (waiver by litigation conduct), or

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.