

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYLOR COLLEGE OF MEDICINE,
Petitioner,

v.

THE BOARD OF REGENTS OF THE
UNIVERSITY OF TEXAS SYSTEM and GENSETIX, INC.,
Patent Owner.

Cases

IPR2018-00948 (Patent 8,728,806 B2)
IPR2018-00949 (Patent 9,333,248 B2)

Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

IPR2018-00948 (Patent 8,728,806 B2)

IPR2018-00949 (Patent 9,333,248 B2)

In an email dated July 3, 2018, The Board of Regents of the University of Texas System (“Patent Owner) requested authorization to file a motion to dismiss in IPR2018-00948 and IPR2018-00949. Patent Owner indicated that the request would be based on Patent Owner’s claim of sovereign immunity. In the email, Patent Owner proposed a briefing schedule for the proposed motions and indicated that Petitioner consented to the proposed briefing schedule.

On July 10, 2018, we issued an order denying Patent Owner’s request but authorized Patent Owner to renew its request once the Federal Circuit issue its decision in *Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals, Inc.*, Appeal No. 18-1638 (“*Saint Regis*”). (Paper 7). We also suspended the deadline for filing the Patent Owner’s preliminary response until the Federal Circuit issued its decision in *St. Regis*.

On July 20, 2018, the Federal Circuit issued its decision in *St. Regis. Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals, Inc.*, 2018 WL 3484448 (Fed. Cir. 2018). In an email dated July 25, 2018, Patent Owner renewed its request to file a motion to dismiss on the grounds of sovereign immunity.

1. Request to File Motion to Dismiss

We have considered Patent Owner’s renewed request and authorize filing a motion to dismiss. Patent Owner may file a motion to dismiss, not to exceed 15 pages, no later than August 13, 2018. The motion to dismiss shall be limited to the issue of whether sovereign immunity is applicable to the present proceeding. Petitioner may file a response to Patent Owner’s motion to dismiss, not to exceed 15 pages, no later than August 27, 2018. Patent Owner may file a reply to Petitioner’s response, not to exceed 5 pages, no later than September 4, 2018.

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2. Patent Owner's Preliminary Response

In our order of July 10, 2018, we suspended the deadline for filing of the Patent Owner's Preliminary Response. In light of our authorizing Patent Owner to file a motion to dismiss, we deem it proper to continue to suspend the deadline for the response until we decide Patent Owner's motion to dismiss. Patent Owner's Preliminary Response will now be due within 30 days of our decision on Patent Owner's motion to dismiss.

Accordingly, it is

ORDERED that Patent is authorized to file a motion to dismiss, not to exceed 15 pages, no later than August 13, 2018;

FURTHER ORDERED that Petitioner is authorized to file a response to Patent Owner's motion to dismiss, not to exceed 15 pages, no later than August 27, 2018;

FURTHER ORDERED that Patent Owner is authorized to file a reply to Petitioner's response, not to exceed 5 pages, no later than September 4, 2018; and

FURTHER ORDERED that the deadline for the filing of Patent Owner's Preliminary Response will be extended until 30 days after our decision on Patent Owner's motion to dismiss.

IPR 2018-00948 (Patent 8,728,806 B2)

IPR 2018-00949 (Patent 9,333,248 B2)

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