

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ST. JUDE MEDICAL, LLC,
Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA,
Patent Owner.

Case IPR2017-01338 (Patent 6,502,575)
Case IPR2017-01339 (Patent 6,164,283)¹

Before PATRICK R. SCANLON, JAMES A. WORTH, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

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

¹ Although the proceedings have not been consolidated, this Order addresses issues that are common to each of the above-referenced proceedings. The parties may use this style caption when filing a single paper in multiple proceedings, provided that such caption includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the caption.”

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On July 18, 2017, the Board held a conference call between Judges Scanlon, Worth, and Woods and counsel for Petitioner St. Jude Medical, LLC (“St. Jude”) and Patent Owner The Regents of the University of California (“The Regents”).

The Regents requested a conference call seeking authorization to file a motion to dismiss based on Eleventh Amendment immunity as a state entity, and seeking to postpone the due date of the Patent Owner Preliminary Response pending the motion to dismiss. On the conference call, The Regents argued that this case follows the example of three recent Board cases: *See Covidien LP v. University of Florida Research Foundation Inc.*, IPR2016-01274 (PTAB Jan. 25, 2017) (Paper 21); *NeoChord Inc. v. University of Maryland*, Case IPR2016-00208 (PTAB May 23, 2017) (Paper 28); and *Reactive Surfaces Ltd., LLC v. Toyota Motor Corp.*, Case IPR2017-00572 (PTAB July 13, 2017) (Paper 32). The Regents further contends that it should not be required to file a Preliminary Response to the Petition if it is entitled to Eleventh Amendment immunity.

St. Jude states that it does not object to the granting of authorization for The Regents to file a motion to dismiss but indicates that St. Jude would file an opposition thereto on the merits. St. Jude indicates that it plans to argue that The Regents has waived any Eleventh Amendment immunity, e.g., in a related district court proceeding. St. Jude further opposes postponing the due date of the Patent Owner Preliminary Response because it would prefer that this proceeding finish prior to trial in the district court proceeding, which is currently scheduled for February 2019, according to St.

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Jude.² St. Jude also suggested that The Regents was aware of the Eleventh Amendment issue prior to contacting the Board and may have delayed before seeking to stay the schedule.

Under the current schedule the Patent Owner Preliminary Response is due August 16, 2017, and if an *inter partes* review were instituted, the Board's final written decision would have a statutory due date of no later than November 16, 2018.

After considering the circumstances of this case, we find it to be in the interest of justice to obtain briefing on this issue, and we authorize The Regents to file a motion to dismiss. We further postpone the due date for the Patent Owner Preliminary Response for two months.

Accordingly, having heard from the parties, we authorize The Regents to file its motion by July 25, 2017. The Regents's brief is limited to fifteen (15) pages. In its briefing, The Regents should bear in mind the arguments made by St. Jude during the teleconference.

St. Jude may file an opposition, also limited to fifteen (15) pages, by August 1, 2017. The Regents may further file a reply to St. Jude's opposition by August 8, 2017, limited to ten (10) pages.

Accordingly, it is

ORDERED that The Regents of the University of California is authorized to file, no later than July 25, 2017, a Motion to Dismiss Based on Sovereign Immunity, limited to fifteen (15) pages;

² In its Mandatory Notice, Patent Owner identifies, *inter alia*, the following case as related: *The Regents of the University of California v. St. Jude Medical, LLC*, Case No. 4:16-cv-06210 (N.D. Cal.). Paper 4, 2 (IPR2017-01338).

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FURTHER ORDERED that St. Jude may file, no later than August 1, 2017, an Opposition to Patent Owner's Motion, limited to fifteen (15) pages;

FURTHER ORDERED that The Regents of the University of California may file, no later than August 8, 2017, a Reply to Petitioner's Opposition to Patent Owner's Motion, limited to ten (10) pages;

FURTHER ORDERED that the Patent Owner Preliminary Response in each of IPR2017-01338 and IPR2017-01339 shall be due on October 16, 2017; and

FURTHER ORDERED that no other filings are authorized at this time.

PETITIONER:

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PATENT OWNER:

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