

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEOCHORD, INC.,
Petitioner,

v.

UNIVERSITY OF MARYLAND, BALTIMORE and
HARPOON MEDICAL, INC.,
Patent Owner.

Case IPR2016-00208
Patent 7,635,386 B1

Before SALLY C. MEDLEY, ERICA A. FRANKLIN, and
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

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

On January 31, 2017, oral argument was heard on the merits of the instituted grounds pursuant to the Scheduling Order for this proceeding. The afternoon before the hearing, Patent Owner University of Maryland, Baltimore (“the University”) contacted the Board seeking authorization to file a motion to dismiss based on sovereign immunity. Because of the lack of written briefing on this issue, the panel informed the parties that a separate conference call would be held for the University to seek written briefing, pursuant to the Board’s requirements for prior authorization. *See* 37 C.F.R. § 42.20(b). That call was scheduled for February 7, 2017.

On February 7, 2017, the Board held a conference call between Judges Medley, Franklin, and Worth and counsel for Petitioner NeoChord, Inc. (“NeoChord”) and the University.¹ A court reporter was present on the call, and the University has filed a copy of the transcript in the record. Paper 21.

The University argued that it is an arm of the State of Maryland, and is entitled to dismissal based on the panel’s decision in *Covidien LP v. University of Florida Research Foundation Inc.*, PTAB Case IPR2016-01274 (Jan. 25, 2017) (Paper 21) (granting motion to dismiss). The panel inquired whether the University’s request was timely, and why this issue had not been pleaded sooner. The University represented that it contacted the Board to seek authorization within three business days of issuance of the *Covidien* decision.

NeoChord argued, *inter alia*, that the University must show that its request, subject to Rule 42.5(c), is based on good cause, or in the interest of

¹ Harpoon Medical, Inc. has not entered a separate appearance in this proceeding.

justice, in order to excuse the late action. The University argued that good cause existed because of the timing of the *Covidien* decision, and that, in any event, the interest of justice was provided by the sovereign status of Maryland.

After considering the unique circumstances of this case, we find it to be in the interest of justice to obtain briefing on this issue, and we authorize the University to file a motion to dismiss. Pursuant to the discussion on the conference call, the University has represented that it will file therewith a redacted copy of its license agreement with its exclusive licensee, Harpoon Medical, Inc.²

Accordingly, having heard from the parties, we authorize the University to file its motion by February 21, 2017. The University's brief is limited to fifteen (15) pages. In its briefing, the University should bear in mind the arguments made by NeoChord during the teleconference. E.g., Paper 21, 17:18–23:5.

NeoChord may file an opposition, also limited to fifteen (15) pages, by February 28, 2017. The University may further file a reply to NeoChord's opposition by March 7, 2017, limited to ten (10) pages.

Accordingly, it is

ORDERED that the University of Maryland, Baltimore is authorized to file, no later than February 21, 2017, a Motion to Dismiss Based on Sovereign Immunity, limited to fifteen (15) pages, and may file, in addition, a redacted copy of its license agreement with Harpoon Medical, Inc.;

² Petitioner argued that the filing of a license agreement would require a showing in the interest of justice. Paper 21, 19–21. We so determine.

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FURTHER ORDERED that NeoChord, Inc. may file, no later than February 28, 2017, an Opposition to Patent Owner's Motion, limited to fifteen (15) pages;

FURTHER ORDERED that the University of Maryland, Baltimore may file, no later than March 7, 2017, a Reply to Petitioner's Opposition to Patent Owner's Motion, limited to ten (10) pages; and

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

PETITIONER:

Patterson Thuent Pedersen, P.A.
Brad D. Pedersen
Eric H. Chadwick
Chad J. Wickman

pedersen@ptslaw.com
chadwick@ptslaw.com
wickman@ptslaw.com

PATENT OWNER:

Cooley LLP
C. Scott Talbot
Erik B. Milch
Nancy A. Vashaw

stalbot@cooley.com
emilch@cooley.com
nvashaw@cooley.com
IPR2016-00208@cooley.com