

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

Held: January 31, 2017

BEFORE: SALLY C. MEDLEY, ERICA A. FRANKLIN, and
JAMES A. WORTH, Administrative Patent Judges.

The above-entitled matter came on for hearing on Tuesday,
January 31, 2017, commencing at 1:59 p.m., at the U.S. Patent
and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

Case IPR2016-00208
Patent 7,635,386 B1

APPEARANCES:

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1 PROCEEDINGS

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3 JUDGE WORTH: Good morning. This is an oral
4 hearing in PTAB Case Number IPR2016-00208 between
5 Petitioner Neochord, Inc. and the owner of U.S. Patent 7,635,386,
6 University of Maryland, Baltimore.

7 My name is Judge Worth. On my left is Judge Franklin.
8 On my right is Judge Medley.

9 As you know per our order, each party has 30 minutes
10 to present their argument. Because Petitioner has the burden to
11 show unpatentability of the original claims, Petitioner will
12 proceed first followed by Patent Owner. Petitioner may reserve
13 rebuttal time, but may only use its time to rebut Patent Owner's
14 arguments.

15 Before we begin, we understand that the parties
16 contacted the Board because they were interested in having a
17 conference call to gain authorization for briefing. We appreciate
18 that contact and because that issue has not been briefed up to this
19 point, we're going to ask the parties to hold on off on commenting
20 on that issue. And if the parties are interested in pursuing that
21 issue after this hearing on the merits, then please contact us again
22 and we will set up a conference call for that purpose.

23 MR. MILCH: Your Honor, if I may make a comment
24 to that issue.

25 JUDGE WORTH: Please.

1 MR. MILCH: With respect to the recent decision in the
2 Covidien case, which was just handed down last week, it's our
3 opinion that given the fact that the University of Maryland,
4 Baltimore is an arm of the state, in light of that decision the
5 PTAB does not have jurisdiction over this matter and for that
6 reason we believe that at least some briefing should be heard or
7 the trial dismissed.

8 JUDGE WORTH: Right. So we appreciate your
9 standing statement and because there has been no briefing up
10 until this point, we don't think that this would be the best use of
11 time to have an oral hearing. And if University of Maryland
12 would like to have briefing, then we suggest that pursuant to the
13 Board's rules that Patent Owner seek a conference call for
14 authorization to submit a motion or a briefing.

15 MR. MILCH: Thank you, Your Honor.

16 JUDGE WORTH: Does Petitioner have any comment
17 on that?

18 MR. PEDERSEN: Yes. Thank you, Your Honors, for
19 that because that was the point that Petitioner was going to make
20 was that there is nothing in the record or the papers that would
21 address this and so discussion of that issue would be not
22 warranted at this time given that the record is devoid of any
23 discussion of either the facts or the law that would be surrounding
24 this issue.

1 Our primary point with respect to this issue would be
2 that this is late, that if the evidence that would be necessary for
3 them to establish the ability to utilize sovereign immunity were to
4 be introduced, it would have to be introduced as supplemental
5 disclosure and they would have to prove why the information
6 could not have been introduced previously.

7 Given that we are here now at the oral hearing, we think
8 that there was plenty of opportunity to have raised this issue
9 previously and that Patent Owner has effectively waived this
10 issue.

11 JUDGE MEDLEY: Well, I think what Judge Worth's
12 point is that we're going to table all this.

13 MR. PEDERSEN: And we totally agree with that.

14 JUDGE MEDLEY: We don't want to hear your
15 arguments as to why they were late and we don't really want to
16 hear any arguments as to why you don't think you're late. I think
17 what we want to do today is get to the merits of the case and
18 what's been briefed before us. And then once you guys get
19 together and determine when you're available, give us some
20 times, then we can pick a time and we can discuss this at a later
21 date.

22 MR. PEDERSEN: And we're fine with that, Your
23 Honor.

24 JUDGE WORTH: Also first things first, I'd like to ask
25 the parties to state their appearance for the record.

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