

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LSI CORPORATION and
AVAGO TECHNOLOGIES U.S., INC.,
Petitioners,

v.

REGENTS OF THE UNIVERSITY OF MINNESOTA,
Patent Owner.

Case IPR2017-01068
Patent 5,859,601

Before ROBERT J. WEINSCHENK, CHARLES J. BOUDREAU, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

PER CURIAM.

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

I. INTRODUCTION

Pursuant to our authorization (Paper 22), Patent Owner, Regents of the University of Minnesota, filed a Motion to Stay the instant proceeding pending appellate review of the Order Denying Patent Owner's Motion to Dismiss (Paper 19) based on Eleventh Amendment immunity. Paper 23. Petitioners, LSI Corp. and Avago Technologies U.S., Inc., filed an Opposition to Patent Owner's Motion to Stay (Paper 24), to which Patent Owner filed a Reply (Paper 25).

II. ANALYSIS

“[A] motion by a State or its agents to dismiss on Eleventh Amendment grounds involves a claim to a fundamental constitutional protection.” *Puerto Rico Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc.*, 506 U.S. 139, 145 (1993). Moreover, “the value to the States of their Eleventh Amendment immunity . . . is for the most part lost as litigation proceeds past motion practice.” *Id.* The collateral order doctrine, therefore, authorizes immediate appeal of an order denying a claim of Eleventh Amendment immunity. *Id.* at 147; *see also Bell v. New Jersey*, 461 U.S. 773, 778–79 (1983) (“[W]e conclude that, at least in the absence of an appealable collateral order, the federal courts may exercise jurisdiction only over a final order of [an agency].” (internal citations omitted)); *Mathews v. Eldridge*, 424 U.S. 319, 331 n.11 (1976) (“[T]he core principle that statutorily created finality requirements should, if possible, be construed so as not to cause crucial collateral claims to be lost and potentially irreparable injuries to be suffered remains applicable.”); *Chehazeh v. Attorney Gen. of U.S.*, 666 F.3d 118, 136 (3d Cir. 2012) (marshaling Courts of Appeals

decisions and noting “unanimous view” that the “collateral order doctrine applies to judicial review of agency decisions”); *Carolina Power & Light Co. v. U.S. Dep’t of Labor*, 43 F.3d 912, 916 (4th Cir. 1995) (“It is well-settled that these requirements of the collateral order doctrine apply not only to judicial decisions, but also to appeals from executive agency action.”).

In view of the particular circumstances of this case, including the unique nature of the Eleventh Amendment immunity right at issue, as well as the fact that the stay requested pertains to the specific proceeding for which appellate review is sought, we conclude that it is appropriate to suspend the deadline for filing of Patent Owner’s Preliminary Response pending appellate review of the Order Denying Patent Owner’s Motion to Dismiss (Paper 19) based on Eleventh Amendment immunity.

Accordingly, in the event Patent Owner files its notice of appeal seeking collateral order review of the Order Denying Patent Owner’s Motion to Dismiss (Paper 19) based on Eleventh Amendment immunity on or before February 20, 2018, the date identified by Patent Owner as the deadline for filing that notice (Paper 23, 1), the deadline for Patent Owner to file a Preliminary Response in this proceeding will be suspended pending resolution of the appeal.

We are mindful, however, of Petitioners’ concern that this proceeding not be unduly delayed. Therefore, should Patent Owner fail to file a notice of appeal seeking review of the Order Denying Patent Owner’s Motion to Dismiss (Paper 19) on or before February 20, 2018, absent a showing of good cause for further suspension, the deadline for Patent Owner to file a Preliminary Response in this proceeding will be set for March 7, 2018.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that in the event Patent Owner files a notice of appeal seeking review by the United States Court of Appeals for the Federal Circuit of the Order Denying Patent Owner's Motion to Dismiss (Paper 19) on or before February 20, 2018, the deadline for Patent Owner to file a Preliminary Response in this proceeding will be suspended pending resolution of that appeal;

FURTHER ORDERED that, in the event Patent Owner fails to file a notice of appeal seeking review by the United States Court of Appeals for the Federal Circuit of the Order Denying Patent Owner's Motion to Dismiss (Paper 19) on or before February 20, 2018, absent a showing of good cause for further suspension, the deadline for Patent Owner to file a Preliminary Response in this proceeding will be set for March 7, 2018; and

FURTHER ORDERED that the parties are to timely apprise the Board of developments or changes in the status of any appellate proceedings concerning the Order Denying Patent Owner's Motion to Dismiss (Paper 19).

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