

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 6,502,576)
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.”

IPR2017-01338 (Patent 6,502,576)

IPR2017-01339 (Patent 6,164,283)

On July 20, 2017, the Board granted Patent Owner, The Regents of the University of California (“The Regents”), authorization to file a motion to dismiss based on Eleventh Amendment immunity and postponed, by two months, the due date for the Patent Owner Preliminary Response, i.e., to October 16, 2017. Paper 7. On July 25, 2017, The Regents filed “Patent Owner’s Motion to Dismiss.” Paper 9. On August 1, 2017, Petitioner, St. Jude Medical, LLC (“St. Jude”), filed “Petitioner’s Opposition to Motion to Dismiss.” Paper 13. On August 8, 2017, The Regents filed “Patent Owner’s Reply to Opposition to Motion to Dismiss.” Paper 14. The Board denied a request from St. Jude to file a sur-reply. Paper 17.

On September 12, 2017, the Board granted The Regents a second two-month extension of the due date for the Patent Owner Preliminary Response, i.e., until December 16, 2017. On November 22, 2017, the Board granted The Regents a third two-month extension of the due date for the Patent Owner Preliminary Response, i.e., until February 16, 2017.

On December 29, 2017, counsel for St. Jude sent an e-mail to the Board, with carbon copy to counsel for The Regents, as follows:

Petitioner wishes to apprise the panel of decisions recently issued by the PTAB bearing on the issue of waiver of sovereign immunity, including:

-*LSI Corp. v. University of Minnesota*, Trial No. IPR2017-01068 (PTAB Dec. 19, 2017)(expanded panel);

-*Ericsson, Inc. v. University of Minnesota*, Trial Nos. IPR2017-01186, IPR2017-01197, IPR2017-01200, IPR2017-01213, IPR2017-01214, IPR2017-01219, (PTAB Dec. 19, 2017)(expanded panel).

On January 8, 2018, The Regents sent an e-mail to the Board seeking a conference call to request supplemental briefing on the PTAB decisions

IPR2017-01338 (Patent 6,502,576)

IPR2017-01339 (Patent 6,164,283)

raised by St. Jude and to request a further two-month extension of the deadline for the Patent Owner Preliminary Response.

On January 10, 2018, a conference call was held between Judges Scanlon, Worth, Woods, and counsel for the parties. On the call, The Regents withdrew its request for supplemental briefing but maintained its request for a further two-month extension of the due date for the Patent Owner Preliminary Response. The Regents requested, in the alternative, that any Patent Owner Preliminary Response be due one month from a decision on the pending motion to dismiss. The Regents also requested, in the alternative, that the panel stay these proceedings pending decision by another Board panel on whether to stay the University of Minnesota proceedings, i.e., in view of possible appellate review of the decisions in those proceedings. *See, e.g., Ericsson Inc. and Telefonaktiebolaget LM Ericsson, v. Regents Of The University of Minnesota*, Cases IPR2017-01186, -1197, -1200, -1213, -1214, -1219 (PTAB Jan. 5, 2018) (Paper 17). St. Jude opposed the requests for a further extension or stay. St. Jude argued that it would be prejudiced by a further extension or stay of these proceedings. St. Jude stated that it would like the Board to resolve these proceedings and that there is a co-pending district court proceeding (which is not subject to a stay).

After having already granted three extensions of the due date for the Patent Owner Preliminary Response, we decline to grant a further extension thereof or to stay these proceedings. We are mindful of the timing of the co-pending district court proceeding.

IPR2017-01338 (Patent 6,502,576)

IPR2017-01339 (Patent 6,164,283)

Accordingly, it is

ORDERED that The Regents's request for a further extension of the Patent Owner Preliminary Response or to stay these proceedings is *denied*.

IPR2017-01338 (Patent 6,502,576)

IPR2017-01339 (Patent 6,164,283)

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