

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ST. JUDE MEDICAL, LLC,  
Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA,  
Patent Owner.

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Case IPR2017-01338 (Patent 6,502,576)  
Case IPR2017-01339 (Patent 6,164,283)<sup>1</sup>

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

WORTH, *Administrative Patent Judge*.

DECISION  
Granting Patent Owner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

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<sup>1</sup> Although the proceedings have not been consolidated, this Decision 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 January 12, 2017, the Board issued an Order (Paper 20, “the Order”), denying The Regents’ request for a further two-month extension of the due date for the Patent Owner Preliminary Response, or in the alternative, that any Patent Owner Preliminary Response be due one month from a decision on the pending motion to dismiss, or further 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).

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On January 26, 2018, the Regents filed “Patent Owner’s Request for Rehearing Under 37 C.F.R. § 42.71(d)” (Paper 21, “Request”), seeking reconsideration of the Order. Patent Owner also requested a call with the Board. The Request asked the Board to grant an extension of the Patent Owner Preliminary Response or stay the proceeding so that The Regents do not have to substantively participate in the proceedings. Request 1. The Regents argues, *inter alia*, that the Board has not yet ruled on the threshold jurisdiction issue of sovereign immunity, and that St. Jude would not be prejudiced by a further delay:

Based on the current schedule in the co-pending proceeding, the district court litigation will be finished before a final decision has been rendered by this Board. As such, SJM’s [St. Jude’s] invalidity counterclaims—including those before the Board—will have been fully adjudicated by the district court before a decision in these proceedings with or without a further extension or stay of the POPR due date.

In contrast, The Regents will suffer irreparable injury from being forced to litigate a matter in violation of its sovereign immunity rights. The Regents’ irreparable injury categorically outweighs SJM’s purported prejudice.

Request 2; *see also id.* at 3–4.

On January 30, 2018, a conference call was held between Judges Scanlon, Worth, Woods, and counsel for the parties. On the call, St. Jude requested leave to file an opposition to the Request. On the call, the Board granted St. Jude authorization to file an opposition within two days, i.e., by February 1, 2018. The Board concomitantly indicated to the parties that any Order on the Request would provide at minimum two days further extension for the Patent Owner Preliminary Response.

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On February 1, 2018, St. Jude filed “Petitioner’s Opposition to the Request for Reconsideration” (Paper 22, “Opposition”). St. Jude argues that although any Final Written Decision would occur after the district court trial date, (a) the timing is quite close; (b) district court trial schedules frequently change; and (c) even if the Final Written Decision occurs after the trial date, it may inform any remaining portion of litigation, e.g., on remand from the Federal Circuit. Opposition 1 (citing *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 721 F.3d 1330, 1340 (Fed. Cir. 2013)). St. Jude further argues, *inter alia*, that The Regents fails to explain the harm to itself in any concrete way, and that The Regents initiated the lawsuit in federal court. *Id.* at 2.

The Board typically grants rehearing only where it has overlooked or misapprehended an issue. *See* 37 C.F.R. §42.71(d). Nevertheless, there is an additional factor here, i.e., the passage of time, such that St. Jude would now be in the position of preparing for filing a Patent Owner Preliminary Response in the event that the case is not dismissed. We are persuaded that St. Jude should not be asked to prepare a brief on the merits while its motion to dismiss for sovereign immunity is still pending.

Accordingly, it is

ORDERED that The Regents’ request for rehearing is granted; and

FURTHER ORDERED that any Patent Owner Preliminary Response would be due one month from a decision on The Regents’ motion to dismiss, i.e., in the event that the proceeding is not dismissed.

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