

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.”

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On July 20, 2017, following a conference call with Patent Owner The Regents of the University of California (“The Regents”), and Petitioner St. Jude Medical, LLC (“St. Jude”), the Board authorized Patent Owner to file a motion to dismiss and set a briefing schedule for the parties. Paper 7.

Pursuant to this authorization, The Regents filed “Patent Owner’s Motion to Dismiss” on July 25, 2017. Paper 9. On August 1, 2017, St. Jude filed “Petitioner’s Opposition to Motion to Dismiss” (Paper 13, “the Opposition” or “Opp.”). On August 8, 2017, The Regents filed “Patent Owner’s Reply to Opposition to Motion to Dismiss” (Paper 14, “the Reply” or “Rep.”).

St. Jude subsequently requested a conference call to seek authorization to file a sur-reply. This conference call was held on August 15, 2017, between Judges Scanlon, Worth, and Woods and counsel for St. Jude and The Regents. On the conference call, St. Jude stated that it wished to address certain factors in a five-factor test from the U.S. Court of Appeals for the Ninth Circuit. The panel observed that St. Jude already relies on the five-factor test in its Opposition and inquired whether the additional information could have been addressed previously. *See* Opp. 1–4 (citing *Beentjes v. Placer Cty. Air Poll. Control Dist.*, 397 F.3d 775, 778 (9th Cir. 2005)). St. Jude stated, *inter alia*, that it disagreed with The Regents’ use of case law in the Reply.

The Regents opposed authorization for a sur-reply but conditionally requested the opportunity for further briefing as well if a sur-reply were granted.

After considering St. Jude’s request, we find that St. Jude has not provided good cause for additional briefing. Accordingly, having heard from the parties, it is

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ORDERED that no other filings are authorized at this time.

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