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Paper No. 27
Entered: February 22, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GILEAD SCIENCES, INC.,
Petitioner,

v.

REGENTS OF THE UNIVERSITY OF MINNESOTA,
Patent Owner.

Cases IPR2017-01712, IPR2017-01753, IPR2017-02004, IPR2017-02005
Patent 8,815,830 B2[1]

Before ERICA A. FRANKLIN, ZHENYU YANG, and
JACQUELINE T. HARLOW, *Administrative Patent Judges.*

YANG, *Administrative Patent Judge.*

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

[1] This order addresses issues that are common to each referenced case. We, therefore, issue a single order to be entered in each case. For convenience, paper numbers refer to those filed in IPR2017-01712.

Petitioner filed a Petition requesting an *inter partes* review of claims of U.S. Patent No. 8,815,830 B2. Paper 1. With our authorization, the parties briefed the issue of whether we should apply the doctrine of sovereign immunity in these proceedings and dismiss the Petition. Papers 14, 17, 18. In view of Patent Owner's pending Motion to Dismiss on sovereign immunity grounds, we extended the deadline for Patent Owner to file its Preliminary Response ("POPR").

Pursuant to our Order of February 5, 2018, the POPR deadline is set for one month after our decision on the Motion to dismiss. Paper 24. In the Order, we addressed Petitioner's opposition to further extending the POPR deadline. *Id.* at 2–3. Specifically, we pointed out that in two other IPRs, a different panel decided to set the POPR date to one month from the decision on the motion to dismiss. *Id.* at 3 (citing *St. Jude Medical, LLC v. The Regents of the University of California*, IPR2017-01338, -01339 ("*St. Jude* IPRs"), Paper 23 (Feb. 5, 2018)).

Petitioner filed a Request for Rehearing of the Order. Paper 25 ("Reh'g Req."). Petitioner's Request is denied.

The Board generally grants a rehearing request if the Board misapprehended or overlooked any matter. 37 C.F.R. § 42.71(d). In its Request, Petitioner alleges that when issuing the Order, we "overlooked key differences between these IPRs and the *St. Jude* IPRs." Reh'g Req. 5. According to Petitioner, "the circumstances underlying the *St. Jude* Order are distinguishable in at least one critical respect: the petitioner there (St. Jude) never moved to stay the district court action pending IPR." Reh'g Req. 6–7. We are not persuaded.

First, it was Petitioner, not this panel, who brought up *St. Jude* as support for its position. Indeed, in its email communication to the Board dated January 28, 2018, Petitioner requested to discuss "[t]he Board's denial of a similar request to suspend a Patent Owner's POPR deadline in the context of a pending motion to dismiss on sovereign immunity grounds in *St. Jude Medical, LLC v. The Regents of the University of California*, IPR2017-01338 and -01339, Paper 20 (Jan. 12, 2018)." Ex. 1032, 1. In the Order, we merely explained that the panel in the *St. Jude* IPRs had reconsidered its January 12 decision and further extended the POPR deadline, the same as we did in these proceedings. Paper 24, 3. Petitioner cannot ask us to follow the panel decision in the *St. Jude* IPRs when it was to Petitioner's advantage, and then urge us to disregard the cases it sought to rely on because later development in those cases no longer supports its argument.

Second, we express no opinion on Petitioner's assertion that "under normal circumstances . . . district courts often do not grant IPR stays until a decision on institution." *See* Reh'g Req. 8. But, we observe that, as Petitioner pointed out, similarly situated petitioners appear to have obtained stays in district courts. *See id.* at 7 n.6. For example, in another IPR, the Board denied Patent Owner's motion to dismiss on sovereign immunity grounds, but suspended the POPR deadline pending the resolution of Patent Owner's appeal of that order. *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186 (PTAB Feb. 9, 2017). According to Petitioner, that suspension does not prejudice Ericsson "because the litigation in district court was stayed last May." Reh'g Req. 7 n.6 (citing Ex. 1034).

Third, Petitioner is correct that the Board strives to secure "just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). It is exactly under this mandate that we further extend the POPR deadline in these proceedings. The Board has denied motions to dismiss based on sovereign immunity in seven other IPRs involving Patent Owner. *LSI Corporation. v. Regents of the University of Minnesota*, IPR2017-01068; *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186, -01197, -01213, -01214, -01200, -01219 (Papers entered on December 19, 2017). On February 12, 2018, Patent Owner filed the Notice of Appeal, seeking immediate review of those decisions by the Federal Circuit. *See, e.g.*, IPR2017-01186, Paper 22. Under the circumstances, it is appropriate to extend the POPR deadline as stated in the Order.

Accordingly, it is

ORDERED that the deadline for Petitioner's Request for Rehearing is *denied*.

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