

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYLOR COLLEGE OF MEDICINE,
Petitioner,

v.

THE BOARD OF REGENTS OF THE
UNIVERSITY OF TEXAS SYSTEM and GENSETIX, INC.,
Patent Owner.

IPR2018-00948 (Patent 8,728,806 B2)
IPR2018-00949 (Patent 9,333,248 B2)¹

Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and
JOHN E. SCHNEIDER, Administrative Patent Judges.

YANG, *Administrative Patent Judge*.

ORDER

Denying Patent Owner's Motion to Dismiss
37 C.F.R. § 42.5

¹ This Order addresses an issue 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 IPR2018-00948.

IPR2018-00948 (Patent 8,728,806 B2)

IPR2018-00949 (Patent 9,333,248 B2)

Baylor College of Medicine (“Petitioner”) filed a Petition (Paper 1), seeking an *inter partes* review of claims of U.S. Patent Nos. 8,728,806 B2 and 9,333,248 B2. With our authorization (Paper 8), The Board of Regents of the University of Texas System (“Patent Owner”) filed a Motion to Dismiss (Paper 10, “Mot.”), to which Petitioner filed a Response (Paper 11). Thereafter, Patent Owner filed a Reply in support of its Motion. Paper 12. We deny Patent Owner’s Motion to Dismiss.

In its Motion, Patent Owner argues that state sovereign immunity applies in an *inter partes* review. Mot. 3–10. According to Patent Owner, it is “State agency of the State of Texas entitled to sovereign immunity as arms of the State,” and it has not waived such immunity. *Id.* at 13–15. As a result, Patent Owner requests that we dismiss the Petition. *Id.* at 15.

In *Regents of the Univ. of Minn. v. LSI Corp.*, the Federal Circuit held that “state sovereign immunity does not apply to IPR proceedings.” 926 F.3d 1327, 1342 (Fed. Cir. 2019), *cert. denied*, -- U.S.-- (Jan. 13, 2020) (No. 19-337). As such, we deny Patent Owner’s Motion to Dismiss on the basis of state sovereign immunity.

We previously suspended this proceeding in view of the then-pending appellate adjudication of the state-sovereign-immunity issue. Paper 8, 3. We now lift the stay and set the deadline for Patent Owner’s Preliminary Response to 30 days from the date of this Order.

It is:

ORDERED that Patent Owner’s Motion to Dismiss is *denied*, and

FURTHER ORDERED that Patent Owner’s Preliminary Response is due 30 days from the date of this Order.

IPR2018-00948 (Patent 8,728,806 B2)

IPR2018-00949 (Patent 9,333,248 B2)

PETITIONER:

Stephen M. Hash

Paul M. Morico

Jeffrey S. Gritton

BAKER BOTTS, L.L.P.

Stephen.hash@bakerbotts.com

Paul.morico@bakerbotts.com

Jeff.gritton@bakerbotts.com

Baylor0109@bakerbotts.com

PATENT OWNER:

Peter E. Mims

Steve Borgman

VINSON & ELKINS

pmims@velaw.com

sborgman@velaw.com