

## Christopher Evans

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**From:** Christopher Evans  
**Sent:** Wednesday, December 27, 2017 9:32 AM  
**To:** Trials; Michael Shore; Torczon, Richard  
**Cc:** Parmelee, Steve; Rosato, Michael; gspeier@carlsoncaspers.com; mschuman@carlsoncaspers.com; mdzwonczyk@sughrue.com; akokabi@sughrue.com; tribar@sughrue.com; Devine, Wendy; Carsten, Douglas; Phillips, Anna; SBloodworth@perkinscoie.com; BMWhite@perkinscoie.com; Mills, Jad; IPR13351-0008IP1@fr.com; IPR13351-0008IP2@fr.com; IPR13351-0008IP3@fr.com; IPR13351-0008IP4@fr.com; IPR13351-0008IP5@fr.com; IPR13351-0008IP6@fr.com; PTABInbound@fr.com; Alfonso G Chan; Joseph DePumpo; marsha@mkschmidtlaw.com; whelan@fr.com; coletti@fr.com; oakes@fr.com; singer@fr.com  
**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Your Honors,

The Tribe respectfully renews its request for a telephone conference next week to request permission to file a discovery motion. The Tribe will explain why it believes its motion for discovery is authorized by 37 C.F.R. § 42.51 under the "interests of justice" category. The Board has previously admonished the Tribe's counsel for including legal arguments in its communications with the Board so the Tribe has not included any here. Accordingly, the Tribe requests that the Board schedule a call to allow the Tribe to fully explain its legal position so that the Board can make an informed ruling.

The Tribe also requests that the Board identify the administrative patent judges currently assigned to these proceedings or explain why the current merits panel cannot be publicly disclosed. The Tribe is prepared to provide legal arguments concerning this request on the telephone conference.

Sincerely,

Chris Evans

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**From:** Trials <Trials@USPTO.GOV>  
**Sent:** Wednesday, December 27, 2017 8:55 AM  
**To:** Christopher Evans; Michael Shore; Torczon, Richard  
**Cc:** Parmelee, Steve; Rosato, Michael; gspeier@carlsoncaspers.com; mschuman@carlsoncaspers.com; mdzwonczyk@sughrue.com; akokabi@sughrue.com; tribar@sughrue.com; Devine, Wendy; Carsten, Douglas; Phillips, Anna; SBloodworth@perkinscoie.com; BMWhite@perkinscoie.com; Mills, Jad; IPR13351-0008IP1@fr.com; IPR13351-0008IP2@fr.com; IPR13351-0008IP3@fr.com; IPR13351-0008IP4@fr.com; IPR13351-0008IP5@fr.com; IPR13351-0008IP6@fr.com; PTABInbound@fr.com; Alfonso G Chan; Joseph DePumpo; marsha@mkschmidtlaw.com; whelan@fr.com; coletti@fr.com; oakes@fr.com; singer@fr.com  
**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Counsel:

The Tribe's request to amend the briefing schedule regarding litigation waiver is granted. Petitioners' brief shall be due on January 5, 2018. The Tribe's response shall be due on January 12, 2018.

The Tribe's request for authorization to file a motion for additional discovery is denied as the information sought is not within the scope of allowable discovery under 37 C.F.R. § 42.51.

No conference call is necessary at this time.

Regards,  
Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

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**From:** Christopher Evans [mailto:cevans@ShoreChan.com]  
**Sent:** Friday, December 22, 2017 12:28 PM  
**To:** Trials <Trials@USPTO.GOV>; Michael Shore <mshore@ShoreChan.com>; Torczon, Richard <rtorczon@wsgr.com>  
**Cc:** Parmelee, Steve <sparmelee@wsgr.com>; Rosato, Michael <mrosato@wsgr.com>; gspeier@carlsoncaspers.com; mschuman@carlsoncaspers.com; mdzwonczyk@sughrue.com; akokabi@sughrue.com; tribar@sughrue.com; Devine, Wendy <wdevine@wsgr.com>; Carsten, Douglas <dcarsten@wsgr.com>; Phillips, Anna <anphillips@wsgr.com>; SBloodworth@perkinscoie.com; BMWWhite@perkinscoie.com; Mills, Jad <jmills@wsgr.com>; IPR13351-0008IP1@fr.com; IPR13351-0008IP2@fr.com; IPR13351-0008IP3@fr.com; IPR13351-0008IP4@fr.com; IPR13351-0008IP5@fr.com; IPR13351-0008IP6@fr.com; PTABInbound@fr.com; Alfonso G Chan <achan@ShoreChan.com>; Joseph DePumpo <jdepumpo@ShoreChan.com>; marsha@mkschmidtlaw.com; whelan@fr.com; coletti@fr.com; oakes@fr.com; singer@fr.com  
**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Your Honors,

The Tribe requests a telephone conference to discuss two topics.

First, the Tribe asks that the briefing deadline be pushed back because of the holidays. The Tribe also requests that it be allowed to file its response 7 days after Petitioners file their brief, since the Tribe has never seen Petitioners waiver arguments. Thus, the Tribe proposes that Petitioner's brief to be due on January 5, 2018 and the Tribe's response be due on January 12, 2018.

Second, the Tribe would like to request permission to file a motion seeking additional discovery on (i) the process used by the PTAB to determine the makeup of the panels in the LSI and Ericsson decisions, (ii) identification of the judges on the panel who supported the decisions issued in those cases, (iii) how different judges filed identical dissents in the two cases, (iv) any policy decisions made by USPTO that may have influenced the outcome of those cases, (v) an identification of the Judge's currently sitting on this panel, (vi) the process used to choose those Judges, and (vii) any policy decisions made by USPTO that may influence the outcome of this case. The Tribe believes this discovery is authorized by 5 U.S.C.A. § 552(a)(2)(A) and required for the Tribe to be able to adequately address any due process concerns.

The Petitioners have indicated that they take no position on either of these requests.

Sincerely,

Chris Evans



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**From:** Trials [<mailto:Trials@USPTO.GOV>]  
**Sent:** Friday, December 22, 2017 8:04 AM  
**To:** Michael Shore <[mshore@ShoreChan.com](mailto:mshore@ShoreChan.com)>; Torczon, Richard <[rtorczon@wsgr.com](mailto:rtorczon@wsgr.com)>  
**Cc:** Parmelee, Steve <[sparmelee@wsgr.com](mailto:sparmelee@wsgr.com)>; Christopher Evans <[cevans@ShoreChan.com](mailto:cevans@ShoreChan.com)>; Rosato, Michael <[mrosato@wsgr.com](mailto:mrosato@wsgr.com)>; [gspeier@carlsoncaspers.com](mailto:gspeier@carlsoncaspers.com); [mschuman@carlsoncaspers.com](mailto:mschuman@carlsoncaspers.com); [mdzwonczyk@sughrue.com](mailto:mdzwonczyk@sughrue.com); [akokabi@sughrue.com](mailto:akokabi@sughrue.com); [tribar@sughrue.com](mailto:tribar@sughrue.com); Devine, Wendy <[wdevine@wsgr.com](mailto:wdevine@wsgr.com)>; Carsten, Douglas <[dcarsten@wsgr.com](mailto:dcarsten@wsgr.com)>; Phillips, Anna <[anphillips@wsgr.com](mailto:anphillips@wsgr.com)>; [SBloodworth@perkinscoie.com](mailto:SBloodworth@perkinscoie.com); [BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com); Mills, Jad <[jmills@wsgr.com](mailto:jmills@wsgr.com)>; [IPR13351-0008IP1@fr.com](mailto:IPR13351-0008IP1@fr.com); [IPR13351-0008IP2@fr.com](mailto:IPR13351-0008IP2@fr.com); [IPR13351-0008IP3@fr.com](mailto:IPR13351-0008IP3@fr.com); [IPR13351-0008IP4@fr.com](mailto:IPR13351-0008IP4@fr.com); [IPR13351-0008IP5@fr.com](mailto:IPR13351-0008IP5@fr.com); [IPR13351-0008IP6@fr.com](mailto:IPR13351-0008IP6@fr.com); [PTABInbound@fr.com](mailto:PTABInbound@fr.com); Alfonso G Chan <[achan@ShoreChan.com](mailto:achan@ShoreChan.com)>; Joseph DePumpo <[jdepumpo@ShoreChan.com](mailto:jdepumpo@ShoreChan.com)>; [marsha@mkschmidtllaw.com](mailto:marsha@mkschmidtllaw.com); [whelan@fr.com](mailto:whelan@fr.com); [coletti@fr.com](mailto:coletti@fr.com); [oakes@fr.com](mailto:oakes@fr.com); [singer@fr.com](mailto:singer@fr.com)  
**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Counsel:

Petitioners' request to file the *LSI* and *Ericsson* decisions in these proceedings is denied, as the Board is aware of these decisions.

Regarding Petitioners' request for briefing, we authorize both parties to file a 2-page paper limited to addressing the issue of litigation waiver discussed in the *LSI* and *Ericsson* decisions. To facilitate simultaneous filing, the papers should be filed no later than 5 pm ET on December 29.

Regards,

Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

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**From:** Michael Shore [<mailto:mshore@ShoreChan.com>]  
**Sent:** Thursday, December 21, 2017 10:53 AM  
**To:** Torczon, Richard <[rtorczon@wsgr.com](mailto:rtorczon@wsgr.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Parmelee, Steve <[sparmelee@wsgr.com](mailto:sparmelee@wsgr.com)>; Christopher Evans <[cevans@ShoreChan.com](mailto:cevans@ShoreChan.com)>; Rosato, Michael

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**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Your Honors,

If the Panel is going to consider the issue of litigation waivers, the SRMT thinks a one page brief is enough. In fact, a one sentence brief is enough because litigation waivers do not apply to sovereign tribes, even for compulsory counterclaims related to the same transaction. So unless the board is going to overrule – without the issue even being raised by a party -- multiple federal circuit courts and the United States Supreme Court's *McClendon* decision on tribal immunity from counterclaims, the analysis begins and ends with the latest pronouncement on the doctrine in *Bodi v Shingle Springs Band of Miwok Indians*, 832 F3d 1011, 1018 (9<sup>th</sup> Cir. 2016).

To be clear, waiver was never raised by a party, and even if it had been, it does not apply and cannot apply to sovereign tribes as a matter of well-settled law. The briefing needs to end, a decision needs to be issued and this process needs to conclude.

Regards,

Michael W. Shore

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**From:** Torczon, Richard [<mailto:rtorczon@wsgr.com>]

**Sent:** Thursday, December 21, 2017 6:56 AM

**To:** Trials

**Cc:** Parmelee, Steve; Michael Shore; Christopher Evans; Rosato, Michael; [gspeier@carlsoncaspers.com](mailto:gspeier@carlsoncaspers.com); [mschuman@carlsoncaspers.com](mailto:mschuman@carlsoncaspers.com); [mdzwonczyk@sughrue.com](mailto:mdzwonczyk@sughrue.com); [akokabi@sughrue.com](mailto:akokabi@sughrue.com); [tribar@sughrue.com](mailto:tribar@sughrue.com); Devine, Wendy; Carsten, Douglas; Phillips, Anna; [SBloodworth@perkinscoie.com](mailto:SBloodworth@perkinscoie.com); [BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com); Mills, Jad; [IPR13351-0008IP1@fr.com](mailto:IPR13351-0008IP1@fr.com); [IPR13351-0008IP2@fr.com](mailto:IPR13351-0008IP2@fr.com); [IPR13351-0008IP3@fr.com](mailto:IPR13351-0008IP3@fr.com); [IPR13351-0008IP4@fr.com](mailto:IPR13351-0008IP4@fr.com); [IPR13351-0008IP5@fr.com](mailto:IPR13351-0008IP5@fr.com); [IPR13351-0008IP6@fr.com](mailto:IPR13351-0008IP6@fr.com); [PTABInbound@fr.com](mailto:PTABInbound@fr.com); Alfonso G Chan; Joseph DePumpo; [marsha@mkschmidtlaw.com](mailto:marsha@mkschmidtlaw.com); [whelan@fr.com](mailto:whelan@fr.com); [coletti@fr.com](mailto:coletti@fr.com); [oakes@fr.com](mailto:oakes@fr.com); [singer@fr.com](mailto:singer@fr.com)

**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Your Honors:

Contrary to the Tribe's assertion below, Petitioner Mylan, as well as the BSA amicus, argued that the Tribe's willing participation in the parallel district court proceedings was a waiver of its immunity. See Paper 121 at 7 (Mylan) and Paper 117 at 14-15 (BSA), respectively, both citing *Vas-Cath* 473 F.3d at 1383. In light of the Tribe's waiver assertion below, Mylan requests leave to submit a two-page brief to address the intervening decisions noted below.

The Tribe opposes this request. Allergan did not respond.

Respectfully,

Richard Torczon

Reg. No. 34,448  
For Petitioner Mylan

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**From:** Michael Shore [<mailto:mshore@ShoreChan.com>]  
**Sent:** Wednesday, 20 December, 2017 14.14  
**To:** Torczon, Richard; Trials  
**Cc:** Parmelee, Steve; Christopher Evans; Rosato, Michael; [gspeier@carlsoncaspers.com](mailto:gspeier@carlsoncaspers.com); [mschuman@carlsoncaspers.com](mailto:mschuman@carlsoncaspers.com); [mdzwonczyk@sughrue.com](mailto:mdzwonczyk@sughrue.com); [akokabi@sughrue.com](mailto:akokabi@sughrue.com); [tribar@sughrue.com](mailto:tribar@sughrue.com); Devine, Wendy; Carsten, Douglas; Phillips, Anna; [SBloodworth@perkinscoie.com](mailto:SBloodworth@perkinscoie.com); [BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com); Mills, Jad; [IPR13351-0008IP1@fr.com](mailto:IPR13351-0008IP1@fr.com); [IPR13351-0008IP2@fr.com](mailto:IPR13351-0008IP2@fr.com); [IPR13351-0008IP3@fr.com](mailto:IPR13351-0008IP3@fr.com); [IPR13351-0008IP4@fr.com](mailto:IPR13351-0008IP4@fr.com); [IPR13351-0008IP5@fr.com](mailto:IPR13351-0008IP5@fr.com); [IPR13351-0008IP6@fr.com](mailto:IPR13351-0008IP6@fr.com); [PTABInbound@fr.com](mailto:PTABInbound@fr.com); Alfonso G Chan; Joseph DePumpo; [marsha@mkschmidtlaw.com](mailto:marsha@mkschmidtlaw.com); [whelan@fr.com](mailto:whelan@fr.com); [coletti@fr.com](mailto:coletti@fr.com); [oakes@fr.com](mailto:oakes@fr.com); [singer@fr.com](mailto:singer@fr.com)  
**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Your Honors,

To respond to the inappropriate “Mylan notes” argument in Mr. Torczon’s email, the SRMT “notes” that the opinions found a “litigation waiver” that has not been alleged or argued by Requesters, and was therefore waived as a ground for maintaining the action and cannot be considered or relied upon by this panel to sustain jurisdiction.

Michael W. Shore

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**From:** Torczon, Richard [<mailto:rtorczon@wsgr.com>]  
**Sent:** Wednesday, December 20, 2017 1:09 PM  
**To:** Trials  
**Cc:** Parmelee, Steve; Christopher Evans; Rosato, Michael; [gspeier@carlsoncaspers.com](mailto:gspeier@carlsoncaspers.com); [mschuman@carlsoncaspers.com](mailto:mschuman@carlsoncaspers.com); [mdzwonczyk@sughrue.com](mailto:mdzwonczyk@sughrue.com); [akokabi@sughrue.com](mailto:akokabi@sughrue.com); [tribar@sughrue.com](mailto:tribar@sughrue.com); Devine, Wendy; Carsten, Douglas; Phillips, Anna; [SBloodworth@perkinscoie.com](mailto:SBloodworth@perkinscoie.com); [BMWhite@perkinscoie.com](mailto:BMWhite@perkinscoie.com); Mills, Jad; [IPR13351-0008IP1@fr.com](mailto:IPR13351-0008IP1@fr.com); [IPR13351-0008IP2@fr.com](mailto:IPR13351-0008IP2@fr.com); [IPR13351-0008IP3@fr.com](mailto:IPR13351-0008IP3@fr.com); [IPR13351-0008IP4@fr.com](mailto:IPR13351-0008IP4@fr.com); [IPR13351-0008IP5@fr.com](mailto:IPR13351-0008IP5@fr.com); [IPR13351-0008IP6@fr.com](mailto:IPR13351-0008IP6@fr.com); [PTABInbound@fr.com](mailto:PTABInbound@fr.com); Alfonso G Chan; Joseph DePumpo; Michael Shore; [marsha@mkschmidtlaw.com](mailto:marsha@mkschmidtlaw.com); [whelan@fr.com](mailto:whelan@fr.com); [coletti@fr.com](mailto:coletti@fr.com); [oakes@fr.com](mailto:oakes@fr.com); [singer@fr.com](mailto:singer@fr.com)  
**Subject:** RE: IPR2016-01127, -01128, -01129, -01130, -01131, -01132

Your Honors,

Petitioner Mylan Pharmaceuticals Inc. requests authorization to submit to the panel copies of yesterday’s expanded-panel decisions on State sovereign immunity. *LSI Corp. v. Regents of the University of Minnesota*, IPR2017-01068, Paper 19; and *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186, Paper 16. Mylan notes these opinions, including the concurrences, as well as the arguments put forth by Mylan and the amicus briefs, provide many alternative and non-exclusive bases for maintaining jurisdiction. Mylan does not believe additional briefing is needed.

The Tribe has indicated that it does not oppose filing these opinions.

Respectfully submitted,  
Richard Torczon  
Reg. No. 34,448  
*For Petitioner Mylan*

*Richard Torczon | Wilson Sonsini Goodrich & Rosati | 1700 K Street NW, Fifth Floor | Washington, D.C. 20006  
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