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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC., TEVA PHARMACEUTICALS USA, INC., and AKORN INC.
Petitioners,

v.

SAINT REGIS MOHAWK TRIBE,
Patent Owner.

Case IPR2016-01127 (8,685,930 B2); Case IPR2016-01128 (8,629,111 B2); Case IPR2016-01129 (8,642,556 B2); Case IPR2016-01130 (8,633,162 B2); Case IPR2016-01131 (8,648,048 B2); Case IPR2016-01132 (9,248,191 B2)[1]

Before SHERIDAN K. SNEDDEN, TINA E. HULSE, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PER CURIAM.

DECISION
Denying the Tribe's Motion to Terminate
37 C.F.R. §§ 42.5, 42.72

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[1] Cases IPR2017-00576 and IPR2017-00594, IPR2017-00578 and IPR2017-00596, IPR2017-00579 and IPR2017-00598, IPR2017-00583 and IPR2017-00599, IPR2017-00585 and IPR2017-00600, and IPR2017-00586 and IPR2017-00601, have respectively been joined with the captioned proceedings. This Decision addresses issues that are the same in the identified cases. Paper numbers and exhibits cited in this Decision refer to those documents filed in IPR2016-01127. Similar papers and exhibits were filed in the other proceedings.

I. INTRODUCTION

Based on petitions filed by Mylan Pharmaceuticals, Inc. ("Mylan"), we instituted these *inter partes* review proceedings on December 8, 2016. *See, e.g.*, IPR2016-01127, Paper 8 (Decision on Institution). At the time of institution, the undisputed owner of the patents being challenged in these proceedings was Allergan, Inc. ("Allergan"). *Id.* at 1. On March 31, 2017, we granted motions joining Teva Pharmaceuticals USA, Inc. ("Teva") and Akorn Inc. ("Akorn") (collectively with Mylan, "Petitioners") as parties in each of these proceedings. Paper 18 (Teva); Paper 19 (Akorn). In each proceeding, Allergan filed Patent Owner Responses and Petitioners filed Replies. Paper 16; Paper 34. A consolidated oral hearing for these proceedings was scheduled for September 15, 2017. Paper 59.

On September 8, 2017, less than a week before the scheduled hearing, counsel for the Saint Regis Mohawk Tribe ("the Tribe") contacted the Board to inform us that the Tribe acquired the challenged patents and to seek permission to file a motion to dismiss these proceedings based on the Tribe's sovereign immunity. In view of the Tribe's purported ownership and alleged sovereign immunity, we suspended the remainder of the Scheduling Order (Paper 10), authorized the Tribe to file a motion to terminate, and set a briefing schedule for the parties. Paper 74. Pursuant to this authorization, the Tribe filed "Patent Owner's Motion to Dismiss[2] for Lack of

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[2] We note that we authorized the Tribe to file a motion to terminate the proceedings, and not a motion to dismiss. Paper 74, 3. Because the Tribe did not own the patents at issue at the time we instituted *inter partes* review,

Jurisdiction Based on Tribal Sovereign Immunity" on September 22, 2017. Paper 81 ("Motion" or "Mot."). On October 13, 2017, Petitioners filed an opposition to the Tribe's motion to terminate (Paper 86, "Opposition" or "Opp'n"). On October 20, 2017, the Tribe filed a reply to Petitioners' opposition (Paper 14, "Reply").

In view of the public interest and the issue of first impression generated by the Tribe's Motion, we authorized interested third parties to file briefs as *amicus curiae*. Paper 96. We received amicus briefs from the following third parties: The Oglala Sioux Tribe (Paper 104); Public Knowledge and the Electronic Frontier Foundation (Paper 105); Legal Scholars (Paper 106); Askeladden LLC (Paper 107); DEVA Holding A.S. (Paper 108); The High Tech Inventors Alliance (Paper 109); The Seneca Nation (Paper 110); Native American Intellectual Property Enterprise Council, Inc. (Paper 111); Software & Information Industry Association (Paper 112); U.S. Inventor, LLC (Paper 113); The National Congress of American Indians, National Indian Gaming Association, and the United South and Eastern Tribes (Paper 114); Luis Ortiz and Kermit Lopez (Paper 115); The Association for Accessible Medicines (Paper 116); BSA | The Software Alliance (Paper 117); and James R. Major, D.Phil. (Paper 118).

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a motion for termination of these proceedings, rather than dismissal, is the appropriate process under our rules. *See* Paper 63 (Patent Owner's Updated Mandatory Notice, filed September 8, 2017, informing the Board that the Tribe had taken assignment of the patents-in-suit); 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate."); *id.* § 42.2 (defining "trial" as beginning after institution). Thus, notwithstanding the title of the Tribe's paper, we refer to the Tribe's motion as a "motion to terminate" rather than a motion to dismiss.

Further pursuant to our authorization, the Tribe and Petitioners filed responses to the amicus briefs. Paper 119; Paper 121.

Additionally, in light of the Board's recent rulings in *Ericsson Inc. v. Regents of the University of Minnesota*, Case IPR2017-01186 (PTAB Dec. 19, 2017) (Paper 14) ("*Ericsson*"), and *LSI Corp. v. Regents of the University of Minnesota*, Case IPR2017-01068 (PTAB Dec. 19, 2017) (Paper 19) ("*LSI*"), we authorized the Tribe and Petitioners to file supplemental briefs on the applicability of litigation waiver to the Tribe's claim of sovereign immunity. Paper 125; Paper 127.

Upon consideration of the record, and for the reasons discussed below, we determine the Tribe has not established that the doctrine of tribal sovereign immunity should be applied to these proceedings. Furthermore, we determine that these proceedings can continue even without the Tribe's participation in view of Allergan's retained ownership interests in the challenged patents. The Tribe's Motion is therefore *denied*.

II. FACTUAL BACKGROUND

A. The Tribe

The Tribe is a federally recognized Indian tribe with reservation lands in New York. Ex. 2091, 4. According to the Tribe, the current reservation spans 14,000 acres in Franklin and St. Lawrence Counties. Mot. 1–2. The Tribe further states that there are over 15,600 enrolled tribal members, of which approximately 8,000 tribal members live on the reservation. *Id.* at 2.

The Tribe provides services such as education, policing, infrastructure, housing services, social service, and health care for its members. *Id.* But the Tribe notes that its ability to raise revenue through

taxation and to access capital through banking is limited. *Id.* at 2–3. Thus, the Tribe states that "a significant portion of the revenue the Tribe uses to provide basic governmental services must come from economic development and investment rather than taxes or financing." *Id.* at 3.

Accordingly, on June 21, 2017, the Tribe adopted a Tribal Council Resolution endorsing the creation of a "technology and innovation center for the commercialization of existing and emerging technologies," called the Office of Technology, Research, and Patents. Ex. 2094, 1. The Tribal Council Resolution states that the Tribe was approached by the law firm Shore Chan DePumpo LLP "to engage in new business activities related to existing and emerging technologies, which may include the purchase and enforcement of intellectual property rights, known as the 'Intellectual Property Project.'" *Id.* The purpose of the Intellectual Property Project is "to promote the growth and prosperity of the Tribe, the economic development of the Tribe, and to promote furthering the wellbeing of the Tribe and its members." *Id.*

B. The Transactions Between Allergan and the Tribe

Pursuant to its new business venture, the Tribe entered into a Patent Assignment Agreement, effective as of September 8, 2017, with Allergan. Ex. 2086 ("Assignment"). In the Assignment, Allergan assigned to the Tribe a set of U.S. patents and patent applications, including the challenged patents in these proceedings, related to Allergan's "Restasis" drug. Ex. 2086, 13–15 (Exhibit A); Ex. 1157, 1. Aside from a limited waiver of its sovereign immunity for actions brought by Allergan relating to the Assignment, the Tribe represents that "it has not and will not waive its or

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