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Paper No. 159
Entered: September 27, 2019

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 and ALLERGAN, INC.,
Patent Owners.

Case IPR2016-01127 (8,685,930 B2)
Case IPR2016-01128 (8,629,111 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*.

HULSE, *Administrative Patent Judge*.

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[1] Cases IPR2017-00576 and IPR2017-00594, IPR2017-00578 and IPR2017-00596, IPR2017-00585 and IPR2017-00600, and IPR2017-00586 and IPR2017-00601, have respectively been joined with the captioned proceedings.

This decision addresses issues common to each of the above proceedings. We, therefore, enter one decision to be entered in each proceeding. For convenience, citations to papers and exhibits refer to those filed in IPR2016-01127. Similar papers and exhibits were filed in the other proceedings.

TERMINATION
Dismissal After Institution of Trial
37 C.F.R. § 42.72

Mylan Pharmaceuticals Inc. ("Mylan") filed Petitions requesting an *inter partes* review of all claims of U.S. Patent No. 8,685,930 B2 ("the '930 patent") in IPR2016-00127; U.S. Patent No. 8,629,111 B2 ("the '111 patent") in IPR2016-01128; U.S. Patent No. 8,648,048 B2 ("the '048 patent") in IPR2016-01131; and U.S. Patent No. 9,248,191 B2 ("the '191 patent") in IPR2016-01132 (collectively, "the Challenged Patents"). Allergan, Inc. ("Patent Owner") filed a Preliminary Response to the Petition in each proceeding. We instituted trial for all of the challenged claims in each proceeding. Teva Pharmaceuticals USA, Inc. ("Teva") and Akorn Inc. ("Akorn") (collectively with Mylan herein, "Petitioners") also filed Petitions for *inter partes* review challenging the same claims of the same patents on the same grounds. We instituted trial and joined those proceedings with these proceedings. *See supra* n.1.

In a separate, copending district court proceeding, *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc.*, Case No. 2:15-cv-1455-WCB (E.D. Tex.), the district court found thirteen representative claims of the Challenged Patents invalid as obvious. *Id.*, 2017 WL 4803941 (E.D. Tex. Oct. 16, 2017) (Ex. 1164). The Federal Circuit affirmed the district court's decision by Rule 36 judgment. *Allergan, Inc. v. Teva Pharms. USA, Inc.*, 742 F. App'x 511 (Mem.) (Fed. Cir. Nov. 13, 2018) (Ex. 1172). Patent Owner's petition

for a writ of certiorari was denied. *Allergan, Inc. v. Teva Pharms. USA, Inc.*, 139 S. Ct. 2674 (Mem.) (2019).

In light of the parallel proceeding and the finding of obviousness of the representative claims, we authorized supplemental briefing on the impact of the Federal Circuit's Rule 36 affirmance on the patentability issues in these proceedings. Paper 139, 3. Pursuant to our order, Petitioners filed their Supplemental Briefing (Paper 143) and Patent Owner filed its response ("PO Supp. Br.," Paper 145).

During the district court litigation, Patent Owner agreed to treat the thirteen litigated claims as representative of all claims of the Challenged Patents and states that "judgment as to those thirteen claims can be properly applied to all claims of those four patents." PO Supp. Br. 9. Because the Federal Circuit's judgment is now final, Patent Owner concedes that there is "nothing left for the Board to do on those patents, rendering the IPRs on those patents moot." *Id.*

Pursuant to 37 C.F.R. § 42.72, we have authority to terminate a trial without rendering a final written decision, where appropriate. Given the claims of the Challenged Patents have been found unpatentable in the parallel district court proceeding with finality, we agree with Patent Owner that the instant proceedings are moot. *See Facebook, Inc. v. EveryMD.com*, IPR2017-02027, Paper 24 at 4 (PTAB Oct. 9, 2018) (finding petition moot where the courts had finally adjudicated all claims of the challenged patent).

We, therefore, dismiss the Petition in each proceeding as moot and terminate the proceedings without rendering a final written decision.[2]

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petitions in IPR2016-01127, IPR2016-01128, IPR2016-01131, and IPR2016-01132 are *dismissed as moot*; and

FURTHER ORDERED that the proceedings in IPR2016-01127, IPR2016-01128, IPR2016-01131, and IPR2016-01132 are *terminated*.

[2] Mylan also filed Petitions challenging U.S. Patent No. 8,642,556 B2 in IPR2016-01129 and U.S. Patent No. 8,633,162 B2 in IPR2016-01130. Neither of those patents were explicitly addressed in the district court's decision. We, therefore, address those Petitions in separate decisions.

IPR2016-01127 (8,685,930 B2); IPR2016-01128 (8,629,111 B2);
IPR2016-01131 (8,648,048 B2); IPR2016-01132 (9,248,191 B2)

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