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.
ALLERGAN, INC.,
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]

BRIEF OF AMICI SCHOLARS IN SUPPORT OF PATENT OWNER THE ST. REGIS MOHAWK TRIBE

[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.

INTRODUCTION AND INTEREST OF AMICI

Pursuant to the Board's Order of November 3, 2017, the undersigned scholars submit this brief amici curiae in support of the St. Regis Mohawk Tribe, the Patent Owner in this proceeding. Amici are legal scholars with expertise in the U.S. Constitution, the separation of powers, and the proper role of governmental agencies such as the Patent Trial and Appeal Board ("PTAB").

Amici submit that, where a patent owner establishes a prima facie showing of tribal sovereign immunity, the Board should accept that showing at face value and decline to entertain the kind of arguments against tribal sovereign immunity that Petitioners seek to raise here. Congress, not the Board (nor Article III courts), is the arbiter of tribal immunity and the proper forum for considering the policy arguments and objections raised by Petitioners.

ARGUMENT

Petitioners Mylan Pharmaceuticals, Inc. *et al*. contend that "[c]ourts and agencies have the power and duty" to deny assertions of tribal sovereign immunity to prevent what they call "abuses." Petrs. Opp. to Motion to Dismiss, Paper 87, IPR2016-01127 (Oct. 13, 2017), at 10. Petitioners maintain that "[s]overeign immunity does not require respect for an agreement designed to protect patents from review." *Id*. at 13. They describe the Tribe's assertion of immunity as being part of a "sham" (*id*. at 2, 10, 11, 12, 13), a "contrivance" (*id*. at 3), a "manipulation" (*id*. at

15), and a "rent-a-tribe" scheme. *Id.* at 10 (internal quotation marks and citation omitted). They urge the Board to withhold tribal immunity to protect "the integrity of the patent system" (*id.* at 13) and to prevent patent owners from "reap[ing] a windfall at the public's expense." *Id.* at 11 (citation and internal quotation marks omitted); *id.* at 12 ("private gain at public expense . . . is no justification for extending tribal immunity").

Petitioners' contentions miss the mark. Tribal sovereignty is not a "sham" or a "contrivance," even when it produces results Petitioners do not like. There is no dispute that the St. Regis Mohawk Tribe is what the Supreme Court has termed a "domestic dependent nation[]" (*Cherokee Nation v. Georgia*, 30 U.S. 1, 17 (1831) (Marshall, C.J.)) entitled to tribal sovereign immunity and that its agreement with Allergan is a legitimate contract. Further, the Tribe has explained that the contract serves its sovereign interests and represents an important part of its technology development plan, a project that is saturated with sovereign importance, in part because it complements the Tribe's modest tax base. *See Michigan v. Bay Mills Indian Community*, 134 S. Ct. 2024, 2043-45 (2014) (Sotomayor, J., concurring).

Moreover, Petitioners' objections are being raised in the wrong forum. Congress – rather than the Board, the Article II executive, or even the Article III courts – controls the availability of tribal sovereign immunity. As the Supreme Court has explained, "it is fundamentally Congress's job, not ours, to determine

whether or how to limit tribal immunity. The special brand of sovereignty the tribes retain—both its nature and its extent—rests in the hands of Congress." *Bay Mills Indian Community*, 134 S. Ct. at 2037. Congress has not withdrawn tribal immunity in patent cases. Where a patent owner makes a prima facie showing of tribal sovereign immunity, the Board should recognize that showing and decline to consider the kind of challenges to immunity that Petitioners seek to raise. There is no warrant for the Board to entertain Petitioners' policy objections to the Tribe's assertion of sovereign immunity, and doing so would interfere with Congress's plenary and exclusive responsibility for setting the boundaries of tribal immunity.

The Board has already adopted a similar approach in recognizing the sovereign immunity of three state universities. *See Covidien LP v. Univ. of Fla. Research Found. Inc.*, IPR2016-01274, Paper 21 at 39 (Jan. 25, 2017); *Neochord, Inc. v. Univ. of Md., et al.*, IPR2016- 00208, Paper 28 at 20 (May 23, 2017); *Reactive Surface Ltd., LLP v. Toyota Motor Corp.*, IPR2016-01914, Paper 36 at 17 (July 13, 2017). The Board should follow the same approach with respect to tribal sovereign immunity.

The Supreme Court's decision in *Republic of Philippines v. Pimentel*, 553 U.S. 851 (2008), provides instruction for the proper resolution of this proceeding. In *Pimental*, the Supreme Court held that an interpleader action could not proceed in the absence of the Republic of the Philippines and a government-created

commission, which were protected by sovereign immunity. The Court explained that, once a tribunal recognizes that an assertion of sovereign immunity is "not frivolous," it is "error" for the tribunal to proceed further to address the merits. *Id.* at 864. "[W]here sovereign immunity is asserted, and the claims of the sovereign are not frivolous," the tribunal should accept those claims. *Id.* at 867. The Board should follow that approach here and decline to consider Petitioners' policy objections to tribal sovereign immunity.

I. Congress, Not The Board, is the Arbiter of Tribal Sovereign Immunity.

"Indian tribes are 'domestic dependent nations' that exercise 'inherent sovereign authority.'" *Michigan v. Bay Mills Indian Community*, 134 S. Ct. 2024, 2030 (2014) (citations omitted). "As dependents, the tribes are subject to plenary control by Congress," although "they remain 'separate sovereigns pre-existing the Constitution.'" *Id.* (citation omitted). "Thus, unless and 'until Congress acts, the tribes retain' their historic sovereign authority." *Id.* (citation omitted). The Supreme Court has "time and again treated the 'doctrine of tribal immunity [as] settled law' and dismissed any suit against a tribe absent congressional authorization (or a waiver)." *Id.* at 2030-31 (quoting and following *Kiowa Tribe of Okla. v. Manufacturing Technologies, Inc.*, 523 U.S. 751, 756 (1998)).

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.