Filed: December 1, 2017

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

BRIEF OF AMICUS CURIAE U.S. INVENTOR, LLC IN SUPPORT OF PATENT OWNER, THE SAINT REGIS MOHAWK TRIBE

ISSUE OF FIRST IMPRESSION PRESENTED

Whether the Patent Trial and Appeals Board (the "Board") has the authority to decide whether the Saint Regis Mohawk Tribe – which is a federally recognized, sovereign Native American Tribe and which is indisputably a non-consenting sovereign – is subject to the jurisdiction of the Board.

INTERESTS OF AMICUS CURIAE – U.S. INVENTOR, LLC[1]

U.S. Inventor, LLC is a nation-wide inventor advocacy organization which lobbies Capitol Hill, private trade organizations and the public to encourage strong patent protection in order to foster and protect American innovation and American inventors. U.S. Inventor has over 13,000 members including, independent inventors, early-stage businesses, members of the venture capital community, patent holders, research organizations, emerging technology companies, and patent-dependent enterprises. U.S. Inventor has been at the forefront of teaching, promoting and defending the invention processes and business methods used by American inventors and innovators to develop cutting edge products and services which will extend and enhance American global competitiveness in the 21st Century and beyond.

U.S. Inventor has a direct and vital interest in this issue because its members are concerned that the Board may attempt to usurp Congressional authority over Native American tribal sovereign immunity and contravene long-standing, black-letter U.S. Supreme Court precedent by unilaterally and unjustifiably abrogating Congressionally

[1] No counsel for any party to these proceedings participated in or authored this brief in whole or in part. No person or entity other than the *amicus curaie* or their counsels made a monetary contribution to the preparation or submission of this brief. Because this is an issue of first impression, the Board has authorized the filing of briefs in this case by interested *amicus curaie*. *See* e.g. Paper No. 98 in IPR2016-01128.

mandated Native American tribal sovereign immunity. Moreover, the value of intellectual property assets (and the ability of inventors to protect products and services that they have created against unauthorized copying and misappropriation) will be significantly affected by whether such inventors – under the appropriate circumstances – have the ability to partner with groups and organizations that can assert and maintain sovereign immunity in Board proceedings which have been initiated by infringers of intellectual property.

RELEVANT PTAB HISTORY[2]

On June 3, 2016, Mylan Pharmaceuticals Inc. ("Mylan") filed six petitions for *inter partes* review against U.S. Patent Nos. 8,685,930, 8,629,111, 8,642,556, 8,633,162, 8,648,048, and 9,248,191 (collectively, the "Patents-at-Issue") which were then owned by Allergan, Inc. ("Allergan").[3]

On September 8, 2017, Allergan, Inc. assigned the Patents-at-Issue to the Saint Regis Mohawk Tribe (the "Saint Regis Tribe"). Concurrently with this assignment, the Saint Regis Tribe granted back to Allergan an exclusive limited field-of-use license and then notified the Board that it was the new owner of the Patents-In-Issue. On September 22, 2017, the Saint Regis Tribe filed a Motion to Dismiss For Lack of

[2] For purposes of brevity, the history of the District Court proceedings between the parties has been omitted from this brief. Due the Board's familiarity with this case, this Brief also generally omits citations to filings submitted by the parties.

[3] *See* IPR2016-01127; IPR2016-01128; IPR2016-01129; IPR2016-01130; IPR2016-01131; IPR2016-01132. Additional petitions for *inter partes* review of the Patents-In-Issue were then filed by Teva Pharmaceuticals USA, Inc. ("Teva") (IPR2017-00576; IPR2017-00578; IPR2017-00579; IPR2017-00583; IPR2017-00585; IPR2017-00586) and by Akorn Inc. ("Akorn") (IPR2017-00594; IPR2017-00596; IPR2017-00598; IPR2017-00599; IPR2017-00600; IPR2017-00601). Each of the corresponding Mylan, Teva and Akorn petitions for *inter partes* review were subsequently joined *See, e.g.*, Paper Nos. 18 and 19 in IPR2016-01127

Jurisdiction Based on Tribal Sovereign Immunity (the "Motion To Dismiss"). Subsequently, the Board received requests from two organizations (unaffiliated with any of the parties) seeking leave to file briefs as *amicus curiae* on the issues raised by Allergan's assignment of the Patents-In-Issue to the Saint Regis Tribe and by the subsequently filed Motion To Dismiss. On November 3, 2017, the Board granted leave to these organizations as well as to any other interested parties which wanted to file briefs in this case as *amicus curiae*.[4]

ARGUMENTS AND AUTHORITY

A. Only Congress May Limit Tribal Sovereign Immunity.

It is undisputable that as domestic dependent nations, Native American tribes possess and exercise inherent sovereign immunity. It is also undisputable that such power may be abrogated, limited or qualified only by the express and unequivocal action of Congress. In *Kiowa Tribe of Oklahoma v Manufacturing Technologies, Inc.*, the U.S. Supreme Court explicitly affirmed that no court or administrative agency may interfere with that power absent Congressional legislation.[5]

The U.S. Supreme Court has been steadfast in upholding this principle against any challenges to the breadth and scope of Native American tribal sovereign immunity. In *Bay Mills*, which was decided just three years ago, the Court noted that the holding in *Kiowa Tribe* was unambiguous, had been relied on by Native American tribes and by parties in subsequent cases, and had been considered (and left alone) by Congress, making any departure from it unwarranted.[6] The Court reaffirmed that Native

[4] *See* Paper No. 98 in IPR2016-01128
[5] 523 U.S. 751 (1998)
[6] *Michigan v Bay Mills Indian Community, et al*, 134 S. Ct. 2024, 2026 (2014)

American tribes are domestic dependent nations that exercise sovereignty based on the fact that immunity "is 'a necessary corollary to Indian sovereignty and self-governance.'"[7] and that tribal immunity is qualified only to the extent it has been placed "in Congress's hands."[8] The Court also noted that in *Kiowa Tribe*, it had refused to limit tribes' inherent immunity to commercial activities on Indian land, deferring any such action to Congress.[9] And that after the Court's decision in *Kiowa Tribe*, Congress considered legislation specifically meant to proscribe tribal immunity, but tellingly chose not to pass any such limiting legislation.[10] In re-affirming *Kiowa Tribe*, the Court in *Bay Mills* held that "[i]t is fundamentally Congress's job . . . to determine whether and how to limit tribal immunity." and that absent congressional limitations, tribes exercise *unqualified* immunity.[11] The Court even went so far as to note that "a fundamental commitment of Indian law is judicial respect for Congress's primary role in defining the contours of tribal sovereignty."[12]

In *Bay Mills*, the Court, when presented with an opportunity to abrogate, or at least qualify, tribal sovereign immunity, instead chose to unequivocally underscore that the power to qualify or limit tribal immunity is within the sole purview of Congress and that tribal immunity is clearly not subject to judicial review or administrative agency oversight.

B. The Board Should Not Decide The Issue of Sovereign Immunity.

1. Only Congress has the authority to qualify or limit sovereign immunity.

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[7] *Id.* at 2030 (quoting *Three Affiliated Tribes of Fort Berthold Reservation* v. *World Engineering, P. C.*, 476 U.S. 877, 890 (1986))
[8] *Id.*
[9] *Id.* at 2031
[10] *Id.* at 2038
[11] *Id.* at 2037
[12] *Id.* at 2039

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