Trials@uspto.gov
Tel: 571-272-7822

Paper 144
Entered: December 20, 2018

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.*

HULSE, *Administrative Patent Judge.*

ORDER
Denying Request for Authorization to File Motion to Stay
37 C.F.R § 42.5

---

[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.

A conference call was held on December 13, 2018, among counsel for Petitioners, counsel for the Saint Regis Mohawk Tribe ("the Tribe"), counsel for Allergan, and Judges Paulraj, Snedden, and Hulse. A court reporter was also present.[2]

The Tribe requested the conference call to seek authorization to file a motion to stay these proceedings pending its forthcoming petition for a writ of certiorari from the Federal Circuit's decision on whether tribal immunity applies to these *inter partes* review proceedings (the "tribal immunity appeal"). Additionally, the Tribe requested the conference call to discuss whether to stay these proceedings until the mandate issues in the appeal from the parallel district court proceeding, *Allergan, Inc. v. Teva Pharmaceuticals USA, Inc.*, No. 2018-1130 (Fed. Cir. Nov. 13, 2018) ("the *Allergan* appeal"), where the Federal Circuit affirmed the district court's decision invalidating a subset of claims at issue in these proceedings.

The Tribe made a similar request for a stay in another set of proceedings before the Board in *Microsoft Corp. v. Saint Regis Mohawk Tribe*, Cases IPR2018-01594, -01599, -01600, -01601, -01603, -01604, -01605, -01606, -01607 (collectively, "the *Microsoft* proceedings"). In those proceedings, the panel authorized briefing on the Tribe's motion to extend the deadlines for the preliminary responses until the Supreme Court decides the Tribe's forthcoming petition for a writ of certiorari. Briefing was complete at the time of the conference call in these proceedings. Counsel

[2] Petitioners indicated they would file a transcript when it becomes available. A brief summary of the call is provided in this order, as further details can be ascertained from the transcript.

for the Tribe stated that the arguments it would present in favor of a stay in these proceedings would largely be the same as those presented in the *Microsoft* proceedings. The only additional argument the Tribe made during the conference call relates to the Board's Standard Operating Procedure 9 ("SOP 9"), which governs procedures on remand from the Federal Circuit. The Tribe noted that SOP 9 states that the Board's primary consideration in determining whether to stay the remand proceedings is whether the Supreme Court's judgment would impact the Board's decision on remand. Because the Supreme Court's determination of whether tribal immunity applies to *inter partes* review directly impacts our decision, the Tribe argued we should stay these proceedings.

In response, Petitioners stated they oppose an indefinite stay pending the Supreme Court's decision on the Tribe's petition for a writ of certiorari in the tribal immunity appeal. Petitioners stated it is significant that the Federal Circuit has already considered this issue and denied the Tribe's motion to stay the mandate in that appeal. Petitioners also asserted that SOP 9 does not apply here, as these proceedings are not "on remand," but rather the Federal Circuit affirmed the Board's decision denying the Tribe's motion to terminate based on tribal immunity. Petitioners noted that the Tribe may go to the Supreme Court to seek relief, as the Supreme Court is in a better position to decide that issue. On the other hand, Petitioners stated that they do not oppose a brief stay with a defined end point to allow the Federal Circuit time to enter the mandate in the *Allergan* appeal. Petitioners acknowledged, however, that the mandate is not necessary for the Board to resolve any issue in these proceedings.

After the conference call, the panel in the *Microsoft* proceedings denied the Tribe's motion to stay the proceedings and extend the deadlines for filing the preliminary responses. Case IPR2018-01594, Paper 14. The panel stated the Tribe had not shown good cause to do so, especially given the Federal Circuit's rejection of the Tribe's motion to stay the mandate in the tribal immunity appeal. *Id.* at 5.

Having considered the parties' respective arguments here and taken under advisement the arguments and decision in the *Microsoft* proceedings, we deny the Tribe's request for authorization to file a motion to stay given the circumstances of these proceedings. Petitioner Mylan Pharmaceuticals, Inc. filed its Petition on June 3, 2016. Paper 3.[3] We instituted trial in these proceedings on December 8, 2016. Paper 8. Less than one week before the oral hearing was scheduled to take place, the Tribe entered its appearance as the alleged new patent owner and asserted that tribal immunity prohibits these *inter partes* review proceedings from going forward. Paper 63. We denied the Tribe's motion to terminate on February 23, 2018 (Paper 130), and, after staying the proceedings pending resolution of the tribal immunity appeal, the Federal Circuit affirmed our decision and entered its mandate on November 20, 2018 (Ex. 3004). The Federal Circuit also found the Tribe had not demonstrated that the petition for a writ of certiorari would present a substantial question or that there was good cause to stay the mandate pending the filing and disposition of the Tribe's petition. Ex. 3005; Fed. R.

[3] Paper and exhibit numbers refer to those filed in IPR2016-01127. Similar papers and exhibits were filed in the other proceedings.

App. P. 41(d)(1). Thus, all together, these proceedings have been pending for over two-and-a-half years.

Accordingly, taking into account that the rules for our proceedings "shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding," 37 C.F.R. § 42.1(b), we are not inclined under these circumstances to delay these proceedings any further.[4] The Federal Circuit has already considered and rejected the argument that good cause exists to stay the mandate. Our colleagues in the *Microsoft* proceedings have also considered the issue and reached the same conclusion. We see no reason to deviate from either of those decisions.

Moreover, we see no reason to stay the proceedings until the Federal Circuit enters its mandate, particularly given Petitioners' acknowledgement that there is no legal reason to do so. Thus, unless ordered otherwise by the Supreme Court, we will proceed with the oral hearing as scheduled and issue our Final Written Decisions for these proceedings in due course.

ORDER

Accordingly, based on the foregoing, it is:

ORDERED that the Tribe's request for authorization to file a motion to stay these proceedings pending the filing and disposition of the Tribe's petition for a writ of certiorari in the tribal immunity appeal or the Federal Circuit's mandate in the *Allergan* appeal is *denied*.

---

[4] Although we are not under any statutory deadlines given the joinder of these proceedings under 35 U.S.C. § 315(c) (*see* 37 C.F.R. § 42.100(c)), we are still cognizant of the goal for speedy resolution of the proceedings.

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.