

CONTAINS PROTECTIVE ORDER MATERIAL

Paper No. ____
Filed: October 13, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC., TEVA PHARMACEUTICALS
USA, INC. and AKORN INC.,¹
Petitioners,

v.

ALLERGAN, INC.,
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)

**PETITIONERS' OPPOSITION TO
ST. REGIS MOHAWK TRIBE'S MOTION TO DISMISS**

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. The word-for-word identical paper is filed in each proceeding identified in the caption pursuant to the Board's Scheduling Order (Paper 10).

TABLE OF CONTENTS

I. INTRODUCTION1

II. ALLERGAN REMAINS THE PATENT OWNER3

 A. The Tribe Never Held All Substantial Rights.....3

 B. The Sham Agreement Is No Barrier to *Inter Partes* Review10

III. EVEN IF THE TRIBE WERE THE SOLE OR JOINT PATENT OWNER IT IS NOT AN INDISPENSABLE PARTY13

 A. Allergan Adequately Represents All Interests in the Patents14

 B. Even Under Federal Rule of Civil Procedure 19, the Tribe Is Not Required or “Indispensable”16

 C. *Pimentel* and Its Progeny Do Not Require Dismissal21

IV. IPRS ARE NOT SUBJECT TO TRIBAL IMMUNITY22

V. THE TRIBE FAILS TO JUSTIFY DISMISSAL24

VI. CONCLUSION25

TABLE OF AUTHORITIES

Page

CASES

Airlines Reporting Corp. v. S & N Travel, Inc., 58 F.3d 857 (2d Cir. 1995)12

Alfred E. Mann Found. for Sci. Research v. Cochlear Corp., 604 F.3d 1354 (Fed. Cir. 2010).....4, 6

Anderson & Middleton Lumber Co. v. Quinault Indian Nation, 929 P.2d 379 (Wash. 1996).....23

Aspex Eyewear Inc. v. Miracle Optics Inc., 434 F.3d 1336 (Fed. Cir. 2006)18

Attorneys Trust v. Videotape Computer Prods., Inc., 93 F.3d 593 (9th Cir. 1996)..... 11, 12

Azure Networks, LLC v. CSR plc, 771 F.3d 1336 (Fed. Cir. 2014)6, 7

Barona Band of Mission Indians v. Yee, 528 F.3d 1184 (9th Cir. 2008)..... 1, 10, 11

Calgon Corp. v. Nalco Chem. Co., 726 F. Supp. 983 (D. Del. 1989)9

Cass Cnty. Joint Water Res. Dist. v. 1.43 Acres of Land, 643 N.W.2d 685 (N.D. 2002)..... 10, 23

City of Lincoln City v. U.S. Dep’t of Interior, 229 F. Supp. 2d 1109 (D. Or. 2002)17

Civil Aeronautics Bd. v. Delta Air Lines, Inc., 367 U.S. 316 (1961).....24

Cnty. of Yakima v. Yakima Indian Nation, 502 U.S. 251 (1992).....22

Commander Oil Corp. v. Advance Food Serv. Equip., 991 F.2d 49 (2d Cir. 1993).....4

Commonwealth v. Think Finance, Inc., No. 14-cv-7139, 2016 WL 183289 (E.D. Pa. Jan. 14, 2016).....18

CONTAINS PROTECTIVE ORDER MATERIAL

CSR plc. v. Azure Networks LLC, 135 S. Ct. 1845 (2015) 135 S. Ct. 1845 (2015)6

Cuozzo Speed Techs., LLC v. Lee, 136 S. Ct. 2131 (2016)2, 12

Dep’t of Tax. & Fin. of N.Y. v. Milhelm Attea & Bros., 512 U.S. 61 (1994)10

Diné Citizens Against Ruining Our Env’t. v. U.S. Office of Surface Mining Reclamation & Enf’t, No. 12-cv-1275-AP, 2013 WL 68701 (D. Colo. Jan. 4, 2013)22

EEOC v. Karuk Tribe Hous. Auth., 260 F.3d 1071 (9th Cir. 2001)23

FlowRider Surf, Ltd. v. Pac. Surf Designs, Inc., 2017 WL 2349031 (S.D. Cal. May 26, 2017)4, 8

Gingras v. Rosette, Case No. 5:15-cv-101, 2016 WL 2932163 (D. Vt. May 18, 2016).....10

Idaho Potato Comm’n v. M & M Produce Farm & Sales, 335 F.3d 130 (2d Cir. 2003).....12

Intellectual Prop. Dev., Inc. v. TCI Cablevision of Cal., Inc., 248 F.3d 1333 (Fed. Cir. 2001).....9

Kramer v. Caribbean Mills, Inc., 394 U.S. 823 (1969)11

Lewis v. Clark, 127 S. Ct. 1285 (2017)19

Luminara Worldwide, LLC v. Liown Elecs. Co., 814 F.3d 1343 (Fed. Cir. 2016).....8, 20

Lundgren v. Upper Skagit Indian Tribe, 389 P.3d 569 (Wash. 2017), *modified*, 2017 Wash. LEXIS 619 (Wash. June 8, 2017).....23

Mich. v. Bay Mills Indian Cmty, 134 S. Ct. 2024 (2014).....13

Michigan v. EPA, 268 F.3d 1075 (D.C. Cir. 2001).....25

Otoe-Missouria Tribe v. NY DFS, 769 F.3d 105 (2d Cir. 2014) 11, 12, 19

Philippines v. Pimentel, 553 U.S. 851 (2008).....21

CONTAINS PROTECTIVE ORDER MATERIAL

Rates Tech. Inc. v. Speakeasy, Inc., 685 F.3d 163 (2d Cir. 2012).....13

SourceOne Global Partners, LLC v. KGK Synergize, Inc., No. 08-C-7403, 2009 WL 1346250 (N.D. Ill. May 13, 2009)20

Speedplay, Inc. v. Bebop, Inc., 211 F.3d 1245 (Fed. Cir. 2000).....5, 7

Steel Co. v. Citizens for a Better Env't, 523 U.S. 83 (1998)24

Univ. of Utah v. Max-Planck-Gesellschaft zur Forderung der Wissenschaften E.V., 734 F.3d 1315 (Fed. Cir. 2013) 19, 20

Vastfame Camera, Ltd. v. ITC, 386 F.3d 1108 (Fed. Cir. 2004)24

Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA, 944 F.2d 870 (Fed. Cir. 1991).....3, 4, 5
8, 9

Wash. v. Confed. Tribes of Colville Indian Reservation, 447 U.S. 134 (1980) 11, 22, 23

STATUTES

35 U.S.C. §6(a).....20

35 U.S.C. §26123

35 U.S.C. §311(b).....22

35 U.S.C. §312(a)(5).....16

35 U.S.C. §31316

35 U.S.C. §314(c)16

35 U.S.C. §315 16, 24

35 U.S.C. §316 1, 16, 25

35 U.S.C. §317 22, 24

35 U.S.C. §318 22, 24, 25

RULES

37 C.F.R. 42.9(b)15

37 C.F.R. 42.73(d)(3).....23

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.