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)

AMICUS CURIAE BRIEF OF JAMES R. MAJOR, D.PHIL. IN SUPPORT OF PETITIONERS' OPPOSITION TO ST. REGIS MOHAWK TRIBE'S MOTION TO DISMISS

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TREATISE

Amicus Curiae James R. Major, D.Phil. ("Amicus") hereby submits this brief in support of Petitioners' Opposition to St. Regis Mohawk Tribe's Motion to Dismiss (Paper 87) to Corrected Patent Owner's Motion to Dismiss for Lack of Jurisdiction Based on Tribal Sovereign Immunity (Paper 81) (the "Motion").

Amicus takes no position as to the applicability, if any, of tribal sovereign immunity in *inter partes* review proceedings and is submitting this brief to provide arguments that may assist the Board in deciding the Motion. The arguments herein do not necessarily reflect the views of: (i) Major IP Law PLLC or its clients; (ii) Lucas & Mercanti, LLP or its clients; or (iii) any associations of which Amicus is a member. Amicus has no direct financial or controlling interests in any of the parties to the above-identified proceedings.

ARGUMENT

I) The Express Rights that the Tribe Retains Are Illusory

Under the Patent License Agreement between Saint Regis Mohawk Tribe and Allergan, Inc. Dated as of September 8, 2017 (the "Agreement"), Saint Regis Mohawk Tribe (the "Tribe") "retains all rights under the Licensed Patents not expressly granted hereunder . . . ." Agreement (Ex. 2087) ¶ 2.4. The expressly-retained rights "includ[e] the right to use and practice the Licensed Patents for research, scholarly use, teaching, education, patient care incidental to the foregoing, sponsored research for itself and in collaborations with

Non-Commercial Organizations ('Non-Commercial Uses') . . . ." *Id.*

At first blush, the Tribe has apparently retained the right to practice, for example, the method of claim 1 of U.S. Patent No. 8,633,162 B2 (the "'162 Patent") in caring for patients incidental to a research study. *See* '162 Patent cl. 1 ("A method of treating dry eye disease . . . comprising topically administering to the eye of a human in need thereof an emulsion . . . .") *and* Agreement, Schedule 1.32(a) (lising the '162 Patent as a "Licensed Patent[]."). However, if taken at its word, the Tribe *already had* the right to practice the Licensed Patents. This is because, as the Tribe urges, the Tribe has "inherent sovereign immunity." Paper 81, 8. Even when Allergan, Inc. ("Allergan") was the assignee of the Licensed Patents, the Tribe could, if taken at its word, assert sovereign immunity to defeat *any* suit of Allergan's alleging infringement of the Licensed Patents.

Of course, the patent laws do not exist in a vacuum and there may be other laws and regulations that prevent the Tribe from practicing the Licensed Patents. Allergan assigned to the Tribe all rights in the Licensed Patents by way of a Patent Assignment Agreement dated September 8, 2017. Ex. 2086. However, Allergan *could not* exempt the Tribe from any law or regulation at least on the principle of *nemo dat quod non habet*: a party cannot give what it does not have.

Because the Tribe already had the express rights that the Tribe purportedly "retained" in the Agreement, the express rights that the Tribe retains are illusory.

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