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

Paper 134
Entered: March 22, 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 and ALLERGAN, INC.,
Patent Owners.

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*.

PER CURIAM.

ORDER
Denying Patent Owners' Motion Concerning Board's Divested Jurisdiction or, in the Alternative, for a Stay Pending the Appeal
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. This Order addresses issues that are the same in the identified cases. Paper numbers and exhibits cited in this Order refer to those documents filed in IPR2016-01127.

I. INTRODUCTION

Pursuant to our authorization, Patent Owners Saint Regis Mohawk Tribe ("Tribe") and Allergan, Inc. ("Allergan") filed a "Joint Motion by [Patent Owners] Concerning Board's Divested Jurisdiction or, in the Alternative, for a Stay Pending the Appeal." Paper 134 ("Joint Motion" or "Joint Mot."). Petitioners filed an opposition to Patent Owners' Joint Motion. Paper 136 ("Opposition" or "Opp'n").

After considering the respective positions of the parties, and for the reasons discussed below, we determine that the collateral order doctrine does not apply to our findings regarding patent ownership and denial of Allergan's motion to withdraw. Furthermore, for the reasons discussed below, we deny Patent Owners' request for a stay.

II. BACKGROUND

On February 28, 2018, Allergan and the Tribe filed a combined notice of appeal to the United States Court of Appeals for the Federal Circuit. Paper 133 ("Combined Notice"). The Tribe appeals our Decision Denying the Tribe's Motion to Terminate (Paper 130; "Decision") and "any other orders factually intertwined with the Order denying the Tribe's Motion to Dismiss." *Id.* at 2. Allergan appeals our order denying Allergan's Motion to Withdraw (Paper 126) and "any other orders factually intertwined with the Order denying Allergan's Motion to Withdraw, including but not limited to the Orders appealed by the Tribe." *Id.* As stated in the Combined Notice, Allergan anticipates that the issues on appeal may include the following:

- Whether the Board erred in finding that Allergan obtained all substantial rights in the patents at issue in these Proceedings.

> • Whether the Board erred in finding that Allergan "remains an effective 'patent owner' of the challenged patents in these proceedings" and erred in denying Allergan's requests and motion to withdraw from the Proceedings.

Combined Notice, 6.

In its Joint Motion, Patent Owners argue that the Tribe is entitled to immediate appellate review under the collateral order doctrine of our Decision denying its assertion that tribal sovereign immunity should be applied to *inter partes* review. Joint Mot. 1–3. Patent Owners further argue that the Combined Notice divests the Board of jurisdiction in these proceedings. *Id.* at 3–6. In the alternative, Patent Owners request that we stay these proceedings pending the appeal. *Id.* at 7–10.

In its Opposition, Petitioners assert "Movants forfeited any claim to collateral order review through their ongoing 'sham,' 'dilatory,' and 'manipulative' immunity claims." Opp'n 3. Moreover, Petitioners argue "the [Joint Motion] never explains how Allergan's appeal could independently qualify for collateral order review." *Id.* Petitioners further note, "the Board has [] determined that the Tribe is not an indispensable party and that Allergan can sufficiently represent patent owner interests." *Id.* at 4. Addressing Patent Owners' alternative request for a stay, Petitioners argue that a "stay would [] significantly undermine the public's interest in the orderly conduct of these proceedings." *Id.* at 9 (noting the strong public interest in securing just and speedy resolution of *inter partes* reviews (citing H.R. REP. 112-98, 45, 47 (2011) (stating *inter partes* review statutory deadline is an improvement over *inter partes* reexaminations that can last "several years")).

III. ANALYSIS

A. Application of the Collateral Order Doctrine

We recognize the possibility that the Tribe may be entitled under the collateral order doctrine to immediate appellate review of our decision denying its assertion that tribal sovereign immunity applies to *inter partes* review. *See* Joint Mot. 1–3 (citing *Osage Tribal Council ex rel. Osage Tribe of Indians v. U.S. Dep't of Labor*, 187 F.3d 1174, 1179 (10th Cir. 1999)). Ultimately, that is a question for the Federal Circuit to decide. Given the facts of these cases, however, we are not persuaded that the interlocutory appeal of our Decision necessarily divests the Board of jurisdiction to continue to final written decision with Allergan, as Patent Owners assert. *See id.* at 3–7. We have previously determined that the Tribe is not an indispensable party and that Allergan is a true owner of the challenged patents in these proceedings. Decision 35–40; *see also id.* at 32–33 (recognizing that the Tribe can only participate if permitted by Allergan (citing Ex. 2087 § 5.3 ("Allergan shall retain control of the defense . . . ."))). The issues raised in the Combined Notice by the Tribe concerning tribal immunity are collateral issues separate from the merits of these *inter partes* reviews. As set forth in our prior Decision Denying the Tribe's Motion to Terminate, we have already determined that these proceedings sensibly can proceed without the Tribe. *Id.* at 35–39; Opp'n 7–8; *see Bradford-Scott Data Corp. v. Physician Comput. Network, Inc.*, 128 F.3d 504, 506–07 (7th Cir. 1997) (acknowledging that a collateral order appeal by some parties does not stop the tribunal from continuing if the case "sensibly can proceed without" the absent parties).

We are not persuaded by Patent Owners that the issues raised by Allergan in the Combined Notice—that is, our findings regarding patent ownership and denial of Allergan's motion to withdraw—fall into any recognized exception to normal finality rules. A collateral order amounts to an immediately appealable final decision if "the order '[1] conclusively determine[s] the disputed question, [2] resolve[s] an important issue completely separate from the merits of the action, and [3] [will] be effectively unreviewable on appeal from the final judgment.'" *Johnson v. Jones*, 515 U.S. 304, 310–11 (1995) (quoting *Puerto Rico Aqueduct & Sewer Auth. V. Metcalf & Eddy, Inc.*, 506 U.S. 139, 144 (1993) (numbered brackets in original)). The requirement that the issue underlying the order be "'effectively unreviewable' . . . means that failure to review immediately may well cause significant harm." *Id.* at 311 (citing 15A C. Wright, A. Miller, & E. Cooper, Federal Practice and Procedure § 3911, pp. 334–335 (1992)).

With regard to Allergan's appeal, Patent Owners have not established that our findings regarding patent ownership and denial of Allergan's motion to withdraw will cause immediate significant harm. Proceeding to final written decision in these proceedings can only affect the status of the challenged patent claims and, if we determine certain claims are unpatentable, no claims are cancelled until after any appellate review of our final written decisions. 35 U.S.C. § 318(b); *cf. Mitchell v. Forsyth*, 472 U.S. 511, 525–26 (1985) (stating "the 'consequences' with which we were concerned . . . are not limited to liability for money damages; they also include 'the general costs of subjecting officials to the risks of trial—

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.