

**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**

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

ARGUMENT 1

 I) The Express Rights that the Tribe Retains Are Illusory 1

 II) The Right of the Tribe to Enforce the Licensed Patents in
 Infringement Suits Unrelated to a Generic Equivalent Is
 Nugatory 3

 III) The Rights that the Tribe Do Retain Are Insufficient to Support
 a Holding that the Tribe Retains All Substantial Rights in the
 Licensed Patents 6

CONCLUSION 7

TABLE OF AUTHORITIES

CASES

Apple Inc. v. Motorola, Inc., 757 F.3d 1286 (Fed. Cir. 2014).....4

eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388 (2006)5

STATUTES

35 U.S.C. § 2834

35 U.S.C. § 2844

TREATISE

7 DONALD S. CHISUM, CHISUM ON PATENTS § 20.07[3][a] (2011)..... 4-5

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) (listing 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.

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.