

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MYLAN PHARMACEUTICALS INC.,  
TEVA PHARMACEUTICALS USA, INC., and AKORN INC.,<sup>1</sup>  
Petitioners,

v.

SAINT REGIS MOHAWK TRIBE and ALLERGAN, INC.,  
Patent Owners.

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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)

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**PETITIONERS' SUPPLEMENTAL BRIEFING  
AUTHORIZED BY PAPER 142**

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<sup>1</sup> 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).

## **I. INTRODUCTION**

On October 16, 2017, the district court issued a final judgment invalidating the claims of four of the six patents in these IPRs. EX1165. The Court issued detailed Findings of Facts and Conclusions of Law (EX1164) addressing 13 representative claims and explaining that this analysis served to invalidate all claims of the four patents. On November 13, 2018, the Federal Circuit summarily affirmed the district court's findings of invalidity. EX1172. Consistent with the district court's holding, and with the way the Patent Owner elected to argue the patentability of all involved claims of all six patents, the Board should hold the claims of all patents unpatentable.

## **II. BACKGROUND**

In the district court, Patent Owner originally asserted all six involved patents: U.S. Patent Nos. 8,629,111 (“the ’111 patent”), 8,633,162 (“the ’162 patent”), 8,642,556 (“the ’556 patent”), 8,648,048 (“the ’048 patent”), 8,685,930 (“the ’930 patent”), and 9,248,191 (“the ’191 patent”). During the course of that litigation and prior to trial, Patent Owner agreed to use thirteen claims from four of these patents as representative claims, as set forth below (collectively, the “Representative Claims”):

’111 patent - claims 26 and 27;

’048 patent - claims 1, 11, 13, 14, and 23;

'930 patent - claim 35; and

'191 patent - claims 13, 16, 22, 26, and 27.

In the district court proceedings, the Patent Owner explicitly confirmed that the above Representative Claims were “representative claims of **all** of the claims in the various patents [Patents-in-Suit], including the unasserted claims.” Pretrial Hearing Transcript, EX1173, at 7:25-8:2 (emphasis added). Indeed, Patent Owner agreed that “any remedy that [Judge Bryson] might enter as to the representative claims would apply equally to the unasserted claims.” *Id.* at 8:2-4; *see also* Findings of Fact and Conclusions of Law, EX1164 at 29-30.

Following a bench trial, the district court issued a Final Judgment on October 16, 2017, holding each of the Representative Claims invalid as obvious. EX1165. After briefing and oral argument, the Federal Circuit summarily affirmed. EX1172.

### **III. ALL CLAIMS OF ALL INVOLVED PATENTS ARE UNPATENTABLE**

Collateral estoppel precludes Patent Owner<sup>2</sup> from contesting in these IPR proceedings the unpatentability of the Representative Claims. *See, e.g., MaxLinear,*

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<sup>2</sup> After executing assignment and license agreements regarding the involved patents (EX2086, EX2087), St. Regis Mohawk Tribe consented to join Allergan’s

*Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) (holding that issue preclusion applies equally where a single issue is before a court and an administrative agency). Notably, although the district court’s final judgment specifically addressed the thirteen Representative Claims, Doc. No. 524 (“Final Judgment”) at 1, the collateral estoppel effect is not limited to the claims of the Representative Claims. The district court’s judgment extends to all the claims of the Patents-in-Suit in the district court, as well as the two other patents originally asserted by Patent Owner in the district court proceedings: the ’556 patent and ’162 patents.

“Precedent does not limit collateral estoppel to patent claims that are identical...If the differences between the unadjudicated patent claims and the adjudicated patent claims do not materially alter the question of invalidity, collateral estoppel applies.” *MaxLinear*, 880 F.3d at 1377 (citing *Ohio Willow*, 735 F.3d at 1342). When certain claims of one patent have been adjudicated invalid, the question then becomes “whether the unadjudicated claims present materially different issues that alter the question of patentability, making them patentably distinct from [the adjudicated claims].” *MaxLinear*, 880 F.3d at 1377.

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infringement lawsuit in the district court and was a party when Judge Bryson entered final judgment. EX1163 (decision granting joinder) at 10.

In these proceedings, Patent Owner presented the same patentability arguments for all claims of all six patents at issue in these IPRs and did not separately argue the patentability of any dependent claims of any of the patents. *See* Patent Owner Responses. Because Patent Owner presented no materially different patentability issues for any claims of the '556 patent or the '162 patent as compared to the Representative Claims, the claims of the '556 patent and the '162 patent all fall together with those Representative Claims. *See MaxLinear*, 880 F.3d at 1377.

Because the Representative Claims are invalid as obvious under the district court's higher invalidity standard of clear and convincing evidence, it follows that the claims at issue here are certainly unpatentable under the lower preponderance of the evidence standard applicable in IPRs. *Microsoft Corp. v. i4i Ltd. Partnership*, 131 S. Ct. 2238, 2253 text & n.11 (2011) (noting lower evidentiary standard in USPTO proceedings).

#### **IV. THE CLAIMS OF THE '556 AND '162 PATENTS ARE NOT PATENTABLY DISTINCT FROM THE INVALID CLAIMS**

Even if Patent Owner had presented patentability arguments regarding any claims of the '556 or '162 patents different than what it argued for the Representative Claims, the '556 and '162 patents are nonetheless unpatentable because they are not patentably distinct from the claims invalidated by the district court. Patent Owner is thus precluded from contesting their unpatentability. *See MaxLinear*, 880 F.3d at 1377 (“If the differences between the unadjudicated patent

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