

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

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

v.

SAINT REGIS MOHAWK TRIBE,  
*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)

---

**BRIEF OF THE HIGH TECH INVENTORS ALLIANCE, COMPUTER &  
COMMUNICATIONS INDUSTRY ASSOCIATION, AND INTERNET  
ASSOCIATION AS *AMICI CURIAE* IN SUPPORT OF PETITIONERS**

---

<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).

## TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES .....	ii
INTEREST OF <i>AMICI CURIAE</i> .....	1
INTRODUCTION AND SUMMARY .....	1
ARGUMENT .....	3
I. Tribal Sovereign Immunity Cannot Bar Inter Partes Review .....	3
A. Tribes Are Not Immune from Federal Enforcement Proceedings or Exempt from Generally Applicable Federal Laws .....	3
B. Tribes Are Not Immune from the Federal Government’s Discretionary Review of Patent Validity .....	5
1. Inter Partes Review Is a Proceeding in the Sole Discretion of the Patent Office To Enforce the Novelty and Nonobviousness Requirements of the Patent Act.....	6
2. The Patent Act and the America Invents Act Are Laws of General Applicability That Apply to Tribes .....	10
II. Inter Partes Review Is Akin to an <i>In Rem</i> Proceeding in Which Sovereign Immunity Does Not Apply .....	12
CONCLUSION .....	15

## TABLE OF AUTHORITIES

Page

### CASES

<i>Ager v. Murray</i> , 105 U.S. 126 (1881) .....	13
<i>California v. Deep Sea Research, Inc.</i> , 523 U.S. 491 (1998) .....	13
<i>Central Va. Cmty. Coll. v. Katz</i> , 546 U.S. 356 (2006) .....	13, 15
<i>Cherokee Nation v. Georgia</i> , 30 U.S. (5 Pet.) 1 (1831) .....	3
<i>County of Yakima v. Confederated Tribes &amp; Bands of Yakima Indian Nation</i> , 502 U.S. 251 (1992) .....	14
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016) .....	6, 7
<i>Donovan v. Coeur d'Alene Tribal Farm</i> , 751 F.2d 1113 (9th Cir. 1985) .....	4, 10
<i>EEOC v. Karuk Tribe Hous. Auth.</i> , 260 F.3d 1071 (9th Cir. 2001) .....	10
<i>Federal Mar. Comm'n v. South Carolina State Ports Auth.</i> , 535 U.S. 743 (2002) .....	8, 9, 15
<i>Federal Power Comm'n v. Tuscarora Indian Nation</i> , 362 U.S. 99 (1960) .....	4, 10
<i>Florida Dep't of State v. Treasure Salvors, Inc.</i> , 458 U.S. 670 (1982) .....	13
<i>Florida Paraplegic Ass'n, Inc. v. Miccosukee Tribe of Indians of Fla.</i> , 166 F.3d 1126 (11th Cir. 1999) .....	8
<i>Gayler v. Wilder</i> , 51 U.S. (10 How.) 477 (1850) .....	11
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966) .....	11
<i>Kiowa Tribe of Okla. v. Manufacturing Techs., Inc.</i> , 523 U.S. 751 (1998) .....	4
<i>Magoun v. Illinois Trust &amp; Sav. Bank</i> , 170 U.S. 283 (1898) .....	11, 12

<i>Menominee Tribal Enters. v. Solis</i> , 601 F.3d 669 (7th Cir. 2010) .....	5
<i>Michigan v. Bay Mills Indian Cmty.</i> , 134 S. Ct. 2024 (2014) .....	4
<i>NLRB v. Little River Band of Ottawa Indians Tribal Gov't</i> , 788 F.3d 537 (6th Cir. 2015), <i>cert. denied</i> , 136 S. Ct. 2508 (2016).....	5
<i>Precision Instrument Mfg. Co. v. Automotive Maint. Mach. Co.</i> , 324 U.S. 806 (1945).....	6
<i>Reich v. Mashantucket Sand &amp; Gravel</i> , 95 F.3d 174 (2d Cir. 1996).....	4, 5
<i>San Manuel Indian Bingo &amp; Casino v. NLRB</i> , 475 F.3d 1306 (D.C. Cir. 2007) .....	5
<i>Santa Clara Pueblo v. Martinez</i> , 436 U.S. 49 (1978).....	3
<i>Tennessee Student Assistance Corp. v. Hood</i> , 541 U.S. 440 (2004) .....	13, 14, 15
<i>Teva Pharm. USA, Inc. v. Sandoz, Inc.</i> , 135 S. Ct. 831 (2015) .....	11
<i>United States v. American Bell Tel. Co.</i> , 128 U.S. 315 (1888) .....	15
<i>United States v. Kagama</i> , 118 U.S. 375 (1886).....	3
<i>United States v. Red Lake Band of Chippewa Indians</i> , 827 F.2d 380 (8th Cir. 1987) .....	4
<i>Washington v. Confederated Tribes</i> , 447 U.S. 134 (1980).....	3
<i>Worcester v. Georgia</i> , 31 U.S. (6 Pet.) 515 (1832) .....	3

## CONSTITUTION AND STATUTES

U.S. Const. art. I, § 8, cl. 8.....	6
Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) .....	7
35 U.S.C. § 41(b) .....	12
35 U.S.C. § 301 .....	7

35 U.S.C. § 303 .....	7
35 U.S.C. § 311 .....	7
35 U.S.C. § 311(a) .....	14
35 U.S.C. § 314(a) .....	7
35 U.S.C. § 314(d) .....	7
35 U.S.C. § 317(a) .....	7
46 U.S.C. app. § 1701 <i>et seq.</i> .....	8

## PTAB DECISIONS

<i>Covidien LP v. University of Fla. Research Found. Inc.</i> , Case IPR 2016-01274, Paper 21 (Jan. 25, 2017).....	9
<i>Neochord, Inc. v. University of Md., et al.</i> , Case IPR2016-00208, Paper 28 (May 23, 2017) .....	9
<i>Reactive Surfaces Ltd. v. Toyota Motor Corp.</i> , Case IPR2016- 01914, Paper 36 (July 13, 2017).....	9

## OTHER MATERIALS

Br. for Federal Resp't, <i>Oil States Energy Servs., Inc. v. Greene's Energy Grp., LLC</i> , No. 16-712 (U.S. filed Oct. 23, 2017).....	6, 7, 10, 11, 15
Richard A. Epstein, <i>No New Property</i> , 56 Brook. L. Rev. 747 (1990) .....	12
16 James W. Moore et al., <i>Moore's Federal Practice</i> (3d ed. 2004) .....	13
Edward C. Walterscheid, <i>The Early Evolution of the United States Patent Law: Antecedents (Part 2)</i> , 76 J. Pat. & Trademark Off. Soc'y 849 (1994).....	11-12

# 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.