

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,
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)^{1,2}

Before SHERIDAN K. SNEDDEN, TINA E. HULSE, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

¹ This order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case.

² 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.

IPR2016-01127 (8,685,930 B2); IPR2016-01128 (8,629,111 B2);
IPR2016-01129 (8,642,556 B2); IPR2016-01130 (8,633,162 B2);
IPR2016-01131 (8,648,048 B2); IPR2016-01132 (9,248,191 B2).

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

In an email correspondence sent to the Board September 8, 2017, Alfonso G. Chan, counsel for the Saint Regis Mohawk Tribe (“Tribe”), requested a conference call to notify the Board of Tribe’s acquisition of all the patents at issue in these proceedings and to discuss the application of Tribe’s alleged tribal sovereign immunity from *inter partes* review proceedings. The relevant portion of the email reads as follows:

The Saint Regis Mohawk Tribe (“Tribe”), whom my firm independently represents in this matter, now owns all the patents at issue in the above proceedings. A few moments ago, the Tribe filed Updated Mandatory Notices under 37 C.F.R. § 42.8(a)(3) to inform the Board of this change and my addition to the case as counsel for the Tribe. Paper No. 63 in IPR2016-01127; EX. 2085 (Assignment).

Because of these changes, the Tribe respectfully requests a telephone conference to discuss two topics: (1) permission to file a motion to dismiss based on the Tribe’s sovereign immunity and (2) a continuance of the hearing scheduled for September 15, 2017 to allow for briefing and the Board’s consideration of the motion to dismiss.

A conference call was held on September 11, 2017 between respective counsel for Petitioners, Allergan, Tribe, and Judges Snedden, Hulse, and Paulraj. On the call, Tribe requested authorization to file a motion to dismiss on the basis of Tribe’s alleged tribal sovereign immunity. Tribe also requested that the hearing for these cases, scheduled for September 15, 2017, be postponed, because tribal sovereign immunity is a jurisdictional issue and must be decided before these cases may proceed. Petitioners opposed both

IPR2016-01127 (8,685,930 B2); IPR2016-01128 (8,629,111 B2);
IPR2016-01129 (8,642,556 B2); IPR2016-01130 (8,633,162 B2);
IPR2016-01131 (8,648,048 B2); IPR2016-01132 (9,248,191 B2).

requests. A full transcript of the conference call was entered by Tribe and Petitioners. Ex. 2090 (Tribe); Ex. 1137 (Petitioners).³

After hearing the respective positions of the parties, the panel conferred and concluded that briefing on the issue of Tribe's alleged tribal sovereign immunity from these proceedings is warranted. Accordingly, the panel authorized Tribe to file a motion to terminate on the basis of tribal sovereign immunity of no more than 25 pages due by September 22, 2017. 37 C.F.R. § 42.72. The panel authorized Petitioners to file an opposition to the motion, also of no more than 25 pages due by October 13, 2017. Tribe is authorized to file a reply to the opposition of no more than 15 pages due by October 20, 2017. Evidence relevant to the tribal sovereign immunity issue may be filed as exhibits accompanying the papers.

In order to permit the parties time to brief this issue, Tribe's request to postpone the hearing in these cases is granted. If any party has concerns or questions regarding the schedule, the parties may contact the Board to request a conference call.

Accordingly, it is:

ORDERED, that Tribe is authorized to file a motion to terminate these proceedings. The motion shall be no more than 25 pages, and is due no later than September 22, 2017;

FURTHER ORDERED, that Petitioners may file an opposition to the motion to terminate. The opposition shall be no more than 25 pages, and is due no later than October 13, 2017;

³ Paper numbers and exhibits refer to those filed in IPR2016-01127. Similar papers and exhibits were filed in each of the other cases.

IPR2016-01127 (8,685,930 B2); IPR2016-01128 (8,629,111 B2);
IPR2016-01129 (8,642,556 B2); IPR2016-01130 (8,633,162 B2);
IPR2016-01131 (8,648,048 B2); IPR2016-01132 (9,248,191 B2).

FURTHER ORDERED, that Tribe is authorized to file a reply to the opposition. The reply shall be no more than 15 pages, and is due no later than October 20, 2017; and

FURTHER ORDERED, that Tribe's request to postpone the oral hearing scheduled for September 15, 2017 is *granted*.

PETITIONER MYLAN:

Steven W. Parmelee
Michael T. Rosato
Jad A. Mills
WILSON SONSINI GOODRICH & ROSATI

sparmelee@wsgr.com
mrosato@wsgr.com
jmills@wsgr.com

PATENT OWNER:

Dorothy P. Whelan
Michael Kane
FISH & RICHARDSON P.C.
whelan@fr.com
PTABInbound@fr.com

Alfonso Chan
Joseph DePumpo
SHORE CHAN DEPUMPO LLP
achan@shorechan.com
jdepumpo@shorechan.com