

Filed: December 15, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MYLAN PHARMACEUTICALS INC.,
TEVA PHARMACEUTICALS USA, INC. and AKORN INC.,¹
Petitioners,

v.

ALLERGAN, INC.,
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)

**PETITIONERS' RESPONSE AFTER
AMICUS BRIEFING**

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. 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

	<u>Page</u>
TABLE OF CONTENTS.....	i
TABLE OF <i>AMICI</i>	ii
TABLE OF AUTHORITIES	v
I. Introduction	1
II. Private Entities Cannot Buy Tribal Sovereign Immunity	2
III. Nonbinding Eleventh Amendment Panel Opinions Do Not Require Dismissal Here.....	4
IV. The Board Has the Authority and Duty to Disregard this Sham Transaction	7
V. The Board Should Reconsider Its Previous Sovereign Immunity Decisions	10
A. IPRs Facilitate Agency Review of Prior Agency Decisions and Do Not Adjudicate Private Rights	11
B. Tribal Immunity Does Not Prevent the PTO from Applying Generally Applicable Federal Law.....	12
C. Tribal Immunity Does Not Affect <i>In Rem</i> Proceedings.....	13
VI. If the Board Lacks Jurisdiction to Consider Tribal Immunity, the Correct Response is to Dismiss, Not Grant, the Tribe’s Motion	14
VII. Conclusion.....	15

TABLE OF AMICI

OST	<i>Amicus Curiae</i> Brief of the Oglala Sioux Tribe in Support of Corrected Patent Owner's Motion to Dismiss Based on Tribal Sovereign Immunity (Paper 104)
PK	Brief of Public Knowledge and the Electronic Frontier Foundation as <i>Amici Collegii</i> in Opposition to the Motion to Terminate (Paper 105)
Scholars	Brief of <i>Amici</i> Scholars in Support of Patent Owner the St. Regis Mohawk Tribe (Paper 106)
Askeladden	Brief of Askeladden LLC as <i>Amicus Curiae</i> in Opposition to St. Regis Mohawk Tribe's Motion to Dismiss (Paper 107)
Deva	Comments of <i>Amici Curiae</i> Deva Holding A.S. in Response to the Board's Invitation for Amicus Briefs Regarding the Tribe's Motion to Terminate (Paper 108)
HTIA	Brief of the High Tech Inventors Alliance, Computer & Communications Industry Association, and Internet Association as <i>Amici Curiae</i> in Support of Petitioners (Paper 109)
Seneca	Brief <i>Amicus Curiae</i> of the Seneca Nation in Support of the Patent Owner, Saint Regis Mohawk Tribe (Paper 110)

NAIPEC	Brief Of <i>Amicus Curiae</i> Native American Intellectual Property Enterprise Council, Inc. Regarding Patent Owner’s Motion to Dismiss (Paper 111)
SIIA	Brief <i>Amicus Curiae</i> of the Software and Information Industry Association in Support of Petitioners (Paper 112)
USI	Brief of <i>Amicus Curiae</i> U.S. Inventor, LLC in Support of Patent Owner, the Saint Regis Mohawk Tribe (Paper 113)
NCAI	Brief <i>Amici Curiae</i> of the National Congress of American Indians, National Indian Gaming Association, and the United South and Eastern Tribes in Support of Patent Holder the St. Regis Mohawk Tribe’s Motion to Dismiss (Paper 114)
Ortiz	Brief of <i>Amicus Curiae</i> Luis Ortiz and Kermit Lopez in Support of Patent Owner’s Motion to Dismiss for Lack of Jurisdiction Based on Tribal Sovereign Immunity (Paper 115)
AAM	Brief of the Association for Accessible Medicines as <i>Amicus Curiae</i> in Support of Petitioners (Paper 116)
BSA	Brief of BSA The Software Alliance as <i>Amicus</i> Regarding Applicability of Tribal Sovereign Immunity in IPR Proceedings (Paper 117)

Major	<i>Amicus Curiae</i> Brief of James R. Major, D.Phil. in Support of Petitioners' Opposition to St. Regis Mohawk Tribe's Motion to Dismiss (Paper 118)
-------	---

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.