UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,

Petitioner,

v.

SAINT REGIS MOHAWK TRIBE,
Patent Owner.

IPR2018-01594 (Patent 6,434,687 B1)
IPR2018-01599 (Patent 6,076,152)
IPR2018-01600 (Patent 6,247,110 B1)
IPR2018-01601 (Patent 7,225,324 B2)
IPR2018-01602 (Patent 7,225,324 B2)
IPR2018-01603 (Patent 7,225,324 B2)
IPR2018-01604 (Patent 7,421,524 B2)
IPR2018-01605 (Patent 7,620,800 B2)
IPR2018-01606 (Patent 7,620,800 B2)
IPR2018-01607 (Patent 7,620,800 B2)

PATENT OWNER SAINT REGIS MOHAWK TRIBE'S MOTION TO EXTEND ITS PRELIMINARY RESPONSE DEADLINE UNTIL AFTER THE RESOLUTION OF ITS PETITION FOR WRIT OF CERTIORARI CONCERNING WHETHER SOVEREIGN IMMUNITY MAY BE ASSERTED IN *INTER PARTES* REVIEWS

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I. SUMMARY OF THE MOTION

Saint Regis Mohawk Tribe ("Tribe") is a federally recognized, American Indian Tribe and owner of all the patents that are the subject of the proceedings listed in the caption. The Tribe, as a sovereign government, is not amenable to suit unless it expressly consents or Congress abrogates its immunity. *See*, *e.g.*, *Michigan v. Bay Mills Indian Cmty.*, 134 S. Ct. 2024, 2030, (2014). In *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322 (Fed. Cir. 2018) ("*Mylan*") the Federal Circuit held that sovereign immunity cannot be asserted in an IPR because an "IPR is more like an agency enforcement action than a civil suit brought by a private party." *Id.* at 1327.

The Tribe believes that case was wrongly decided and intends to file a petition for writ of certiorari that asks the Supreme Court to decide whether sovereign immunity may be asserted in *inter partes* reviews before the Patent Trial and Appeal Board. On average, it takes about six weeks for the Supreme Court to act once a petition has been filed.

As authorized in the Board's Order on the Conduct of Proceedings entered on November 23, 2018, the Tribe respectfully requests that the Board extend the Tribe's Preliminary Response deadlines in all of these proceedings until March 1, 2019 to see if the Supreme Court grants certiorari.

The deadline for a Patent Owner's preliminary response has no effect on any

statutory pendency goal so the Board may grant an extension upon a showing of good cause. 37 C.F.R. § 42.5(c)(2). Good cause exists because the Tribe's sovereign immunity is an immunity from suit rather than a mere defense to liability. So the Tribe would be irreparably harmed if the Board were to deny this motion because its immunity would be lost if these IPRs were to proceed. By contrast, Microsoft would not be harmed in any way because the co-pending District Court litigation was stayed pending the Board's decisions on Microsoft's 10 IPR petitions.

Accordingly, the Board should grant this motion and extend the Tribe's Preliminary Response deadline until March 1, 2019.

II. PROCEDURAL HISTORY

A. The Tribe's forthcoming petition for writ of certiorari may be dispositive of these proceedings because it will determine whether sovereign immunity may be asserted in *inter partes* review.

Last year, the Tribe moved to terminate IPR2016-01127 based on its Tribal Sovereign Immunity. EX. 2001. After copious briefing, the Board denied the Tribe's motion and held that sovereign immunity does not apply to IPR proceedings. EX. 2002 at 11-18 (all EX pin citations refer to the EX pagination).

The Tribe immediately appealed under the collateral order doctrine and sought an emergency stay of the IPR proceeding from the Federal Circuit. EX. 2003; EX. 2004. The Federal Circuit granted the Tribe's motion to stay and held that "the

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