**IN THE UNITED STATES DISTRICT COURT**
**FOR THE EASTERN DISTRICT OF TEXAS**
**MARSHALL DIVISION**

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| **ALLERGAN, INC.,**<br><br>**Plaintiff,**<br><br>**v.**<br><br>**TEVA PHARMACEUTICALS USA, INC., et al.,**<br><br>**Defendants.** | Civil Action No. 2:15-cv-1455 WCB LEAD |

**PLAINTIFF'S PRODUCTION OF DOCUMENTS IN RESPONSE TO COURT'S OCTOBER 6, 2017 ORDER**

The Court's October 6, 2017 Order (Dkt. 503) directed Allergan to provide the Court with "copies of those documents pertinent to the terms of the assignment of the patents-in-suit to the Tribe, including any information as to payments made or to be made either by the Tribe or by Allergan in connection with the transaction." (Dkt. 503 at 2.) In its filing dated October 9, 2017 (Dkt. 505; Dkt. 508), Allergan provided the Court with the assignment and license documents themselves. (Dkt. 508 *at* Exhibits A-D). Allergan had previously produced those same materials to Defendants on September 8, 2017 and provided them again to Defendants yesterday. Allergan now provides the additional materials requested in the Court's Order, which are attached hereto and described below:

- Exhibit E – Patent assignment as recorded with the PTO (Reel 043532, Frame 0422), dated Sept. 8, 2017;
- Exhibit F – Allergan Press Release dated Sept. 8, 2017;
- Exhibit G – Saint Regis Mohawk Tribe Press Release dated Sept. 8, 2017;
- Exhibit H – Saint Regis Mohawk Tribe Press Release dated Sept. 14, 2017;

- Exhibit I – Saint Regis Mohawk Tribe Press Release dated Oct. 5, 2017;
- Exhibit J – Letter from Allergan to Senators Grassley and Feinstein, dated Oct. 3, 2017;
- Exhibit K – Redacted Allergan Bank Statement, dated Sept. 29, 2017, showing wire transfer on Sept. 8, 2017 to the Trust Account of Shore Chan Depumpo LLP, counsel for the Saint Regis Mohawk Tribe; and
- Exhibit L – Saint Regis Mohawk Tribe's Motion to Dismiss for Lack of Jurisdiction Based on Tribal Sovereign Immunity, filed in the pending IPR proceedings on the patents-in-suit on September 22, 2017.

As provided in the Court's October 10 Order (Dkt. 509), Allergan is also providing these additional materials (Exhibits E-L) to Defendants at the same time. With the simultaneous service of this response, Defendants have all of the same information that has been supplied to the Court. There are no other agreements, side-agreements, or payments between Allergan and the Tribe that are not reflected in the September 8, 2017 documents, *i.e.*, those attached as Exhibits A-D of Allergan's October 9, 2017 filing with the Court.

In its October 10 Order, the Court also directed Allergan to identify what the "good and valuable consideration" referred to in the assignment of the patents-in-suit to the Tribe "consisted of and to provide any documentary evidence confirming the payment by the Tribe of any such consideration for the assignment of the patents." (Dkt. 509 at 2-3.) The promises and commitments made by the Tribe in the simultaneously-executed assignment and license agreements, and the subsequent performance of those promises, provides such consideration. *See United States v. Dreier*, 952 F. Supp. 2d 582, 590 (S.D.N.Y. 2013) ("Black-letter contract law, in turn, provides that 'when a man acts in consideration of a conditional promise, if he gets

the promise he gets all that he is entitled to by his act, and if, as events turn out, the condition is not satisfied, and the promise calls for no performance, there is no failure of consideration.'" (quoting 3 Williston on Contracts § 7:18 (4th ed.)); *Kinley Corp. v. Ancira*, 859 F. Supp. 652, 657 (W.D.N.Y. 1994) ("A benefit to a promisor or a detriment to a promisee is sufficient consideration for a contract. … 'Far from consideration needing to be coextensive or even proportionate, the value or measurability of the thing forborne or promised is not crucial as long as it is acceptable to the promisee.'") (citation omitted); *Bank of Bermuda, Ltd. v. Rosenbloom*, 76 Civ. 1830 (GLG), 1976 U.S. Dist. LEXIS 11648, at *7-8 (S.D.N.Y. Jan. 1, 1976) ("It is hornbook law that in the absence of fraud any benefit conferred upon a promisor in exchange for his promise is sufficient to constitute a valid consideration and the court will not look to the sufficiency or the insufficiency of such benefit conferred."); *see also Memorylink Corp. v. Motorola Sols., Inc., Motorola Mobility, Inc.*, 773 F.3d 1266, 1271 (Fed. Cir. 2014) ("We agree with Motorola that there is no genuine issue of material fact that consideration existed, because the Assignment explicitly acknowledges consideration for the sale, assignment, and transfer of rights relating to the wireless video technology.").

By the terms of the assignment agreement, the Tribe promised that it "will not waive its or any other Tribal Party's sovereign immunity in relation to any *inter partes* review or any other proceeding in the United States Patent and Trademark Office or any administrative proceeding that may be filed for the purpose of invalidating or rendering unenforceable any Assigned Patents." (Dkt. 508, Ex. B (Patent Assignment Agreement) at § 12(i).) The Tribe has performed that promise by asserting its sovereign immunity in the pending IPR proceedings on the patents-in-suit and by filing its Motion to Dismiss for Lack of Jurisdiction Based on Tribal Sovereign Immunity on September 22, 2017. (*See* Ex. L.)

In addition, in the License Agreement by which the Tribe granted a limited field of use exclusive license to Allergan, the Tribe agreed "that it will and shall assert its sovereign immunity in any Contested PTO Proceeding, including in the IPR Proceedings." (Dkt. 508, Ex. C (License) at § 5.3; *see also id.* at § 7.2.12.) The Tribe also agreed that, with respect to proceedings in this Court, it "(i) consents to join as a party and (ii) shall not assert its sovereign immunity." (*Id.* at § 5.2.2.) Further, the Tribe agreed to assist and cooperate with all enforcement proceedings, prosecution, and contested Patent Office proceedings concerning the patents-in-suit, and is doing so. (*Id.* at § 5.2.)

When and how the Tribe asserts its sovereign immunity is an issue of critical importance to the Tribe. The Tribe's promises, agreements, and actions with respect to asserting its sovereign immunity in the IPR proceedings, as well as the Tribe's participation in this proceeding (where the Tribe agreed that it will *not* assert its sovereign immunity), serves as good and valuable consideration under the law, including the law of the State of New York, which governs the assignment and license agreements. *See Dreier*, 952 F. Supp. 2d at 590; *Kinley*, 859 F. Supp. at 657.

Dated: October 10, 2017

Respectfully submitted,

FISH & RICHARDSON P.C.

By: */s/ Susan E. Morrison*

Jonathan E. Singer (CA Bar No. 187908)
LEAD ATTORNEY
singer@fr.com
Juanita R. Brooks (CA Bar No. 75934)
brooks@fr.com
12390 El Camino Real
San Diego, CA 92130
Telephone: 858-678-5070
Facsimile: 858-678-5099

Michael J. Kane (MN Bar No. 0247625)
kane@fr.com
Deanna J. Reichel (MN Bar No. 0326513)
reichel@fr.com
Joseph A. Herriges (MN Bar No. 390350)
herriges@fr.com
60 South Sixth Street, #3200
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696

Douglas E. McCann (DE Bar No. 3852)
dmccann@fr.com
Susan Morrison (DE Bar No. 4690)
morrison@fr.com
Robert M. Oakes (DE Bar No. 5217)
oakes@fr.com
222 Delaware Avenue, 17th Floor
Wilmington, DE 19801
Telephone: (302) 652-5070
Facsimile: (302) 652-0607

J. Wesley Samples (OR Bar No. 121784)
samples@fr.com
901 15th Street, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

T. John Ward, Jr.
State Bar No. 00794818
E-mail: jw@wsfirm.com
Wesley Hill
State Bar No. 24032294
E-mail: wh@wsfirm.com
Claire Abernathy Henry
State Bar No. 24053063
E-mail: claire@wsfirm.com
Andrea L. Fair
State Bar No. 24078488
E-mail: andrea@wsfirm.com
WARD, SMITH & HILL, PLLC
1507 Bill Owens Parkway
Longview, Texas 75604
Telephone: (903) 757-6400
Facsimile: (903) 757-2323

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