

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)

**BRIEF OF ASKELADDEN LLC AS *AMICUS CURIAE* IN OPPOSITION
TO ST. REGIS MOHAWK TRIBE'S MOTION TO DISMISS**

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I. INTRODUCTION

Pursuant to the Board’s Order of November 3, 2017 (Paper 96),¹ *Amicus Curiae* Askeladden LLC (“Amicus” or “Askeladden”) submits this amicus brief in support of Petitioner’s Opposition (Paper 87) to Corrected Patent Owner’s Motion to Dismiss for Lack of Jurisdiction Based on Tribal Sovereign Immunity (Paper 81) filed by St. Regis Mohawk Tribe (“the Tribe”).

First, *the Tribe’s motion is based on the misplaced theory that Tribal Sovereign Immunity is applicable to administrative proceedings before the PTAB*. While the Supreme Court has repeatedly confirmed that, as a matter of judicial construct, Native American Tribes (like the Tribe) can be immune from “suits” in a court absent abrogation or waiver (*see* Paper 81, at 8), such immunity does not extend to all government action. *See, e.g., Kiowa Tribe of Okla. v. Mfg. Techs., Inc.*, 523 U.S. 751, 755 (1998). In this regard, a PTAB proceeding is not a “suit” in court, but instead an administrative proceeding in which the Office (through the PTAB) takes “a second look at an earlier administrative grant of a patent.” *Cuozzo Speed Techs. v. Lee*, 136 S. Ct. 2131, 2144 (2016) (“*Cuozzo*”). As such, like other administrative actions in which States or Federal Agencies (like the Federal Power Commission) may regulate rights or responsibilities of Tribes with respect to off-reservation activities, a PTAB proceeding is one of the “other

¹ All paper numbers and exhibits cited herein refer to filings in IPR2016-01127.

mechanisms” available to the Government to resolve questions of patent validity as the administrative authority granting the patent in the first instance. *Cf. Michigan v. Bay Mills Indian Cmty.*, 134 S. Ct. 2024, 2028 (2014).

Second, even if the Tribe cannot be compelled to participate in this proceeding, the PTAB retains authority to adjudicate the validity of patents under review. Indeed, ***there is no requirement under the AIA that a patent owner participate in a proceeding in order for it to proceed.*** See 35 U.S.C. §§ 311–319.

Third, there is no dispute that the PTAB has had jurisdiction over the patents-at-issue in, and the parties to, these proceedings from the moment that the Petitions were filed and at the time that the Decisions on Institution issued. Thus, irrespective of whether notions of Tribal Sovereign Immunity are applicable, ***the subsequent transaction by the Patent Owner and the Tribe cannot and should not be entitled to divest the PTAB of its rights and duty to complete these proceedings.*** *Cf. Cuozzo*, 136 S. Ct. at 2144.

Finally, to the extent that the PTAB concludes, like Judge Bryson postulated in the co-pending district court proceeding, that the transaction assigning Allergan’s patents to the Tribe with a license back to the original patent owner is ***nothing more than a sham*** (Ex. 1163, at 4), the motion should be denied. This Office has a duty to “protect the public’s ‘paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.’” *Cuozzo*, 136 S. Ct. at

2144–45 (quoting *Precision Instr. Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806 (1945)), and this inter partes review (“IPR”) is an “efficient system for challenging patents that should not have issued.” *Cuozzo*, 136 S. Ct. at 2144–45 (quoting H.R. Rep. No. 112-98, at 39–40 (2011)). Consistent with the Court’s guidance that collusive agreements cannot (and should not) divest a court of jurisdiction, the agreements here should not divest the PTAB of its jurisdiction to complete the task it has rightfully begun.

II. INTERESTS OF *AMICUS CURIAE*

Amicus Curiae Askeladden is a wholly owned subsidiary of The Clearing Housing Payments Company L.L.C. Askeladden founded the Patent Quality Initiative (“PQI”) as an education, information, and advocacy effort to improve the understanding, use, and reliability of patents in financial services and elsewhere. Askeladden strives to support the patent system by, among other activities, regularly filing amicus briefs in cases presenting important issues of patent law.

The sovereign immunity issue raised by the Tribe in its Motion to Dismiss is one such important issue. Congress established the IPR, as well as the post-grant review, and covered business method patent review, as a way for the Patent Office to review issued patent claims. *Cuozzo*, 136 S. Ct. at 2149 (citing Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011)). Under an IPR, “anyone may file a petition challenging the patentability of an issued patent

claim at almost any time,” regardless of the case-or-controversy requirement for standing in court. *Cuozzo*, 136 S. Ct. at 2149. Askeladden has a strong interest in the proper functioning of such IPR proceedings, as it regularly files IPR petitions at the PTAB to take a second look at patents that it believes are invalid and may be used to inhibit innovation in the financial services industry.

The misplaced notions of Tribal Sovereign Immunity advanced by the Tribe, and the type of late-in-the-game sham transaction that appears to have occurred with respect to the patents-at-issue here, threaten the proper functioning of IPRs. Thus, Askeladden believes that the Tribe’s Motion to Dismiss should be denied.

III. ARGUMENT

A. Notions of Tribal Sovereign Immunity Do Not Apply to Administrative Proceedings Like This One

The Tribe’s motion is premised on the proposition that “The Tribe Possesses Immunity from Suit.” (Paper 81, at 8). However, the Tribe fails to acknowledge that sovereign immunity granted to Native American tribes is limited, and does not always extend to administrative proceedings, like IPRs before the PTAB.

Native American tribes are ““domestic dependent nations”” that exercise “inherent sovereign authority.” *Bay Mills*, 134 S. Ct. at 2030. Among the core aspects of sovereignty that tribes possess—subject to congressional action—is the “common-law immunity from suit traditionally enjoyed by sovereign powers.” *Id.* Such immunity is found “in an agreement, express or implied between the two

sovereigns, or in the voluntary decision of the second [sovereign] to respect the dignity of the first [sovereign] as a matter of comity.” *Nevada v. Hall*, 440 U.S. 410, 416 (1979). The doctrine of Tribal Sovereign Immunity developed on a “slender reed” from a “passing reference to immunity” to become “an explicit holding that tribes had immunity from suit.” *Kiowa*, 523 U.S. at 757. “As sovereigns or quasi sovereigns, the Indian Nations enjoyed immunity ‘from judicial attack’ absent consent to be sued.” *Id.*

As recognized in *Cuozzo*, an IPR is an administrative process held before the U.S. Patent and Trademark Office, an administrative agency, and not a law suit held in a Court. 136 S. Ct. at 2137–38. As such, traditional concerns regarding sovereign immunity, which focus on immunity from suit in a court, do not come into play. *Bay Mills*, 134 S. Ct. at 2030–31 (tribal sovereign immunity applies to “any suit against a tribe absent congressional authorization (or a waiver)”).

In *Kiowa*, the Court explained:

We have recognized that a State may have authority to tax or regulate tribal activities occurring within the State but outside Indian country. . . . however, [that] is not to say that a tribe no longer enjoys immunity from suit. In *Potawatomi*, for example, we reaffirmed that while Oklahoma may tax cigarette sales by a Tribe’s store to nonmembers, the Tribe enjoys immunity from a suit to collect unpaid state taxes. [*Okla. Tax Comm’n v. Citizen Band Potawatomi Indian Tribe*, 498 U.S. 505, 510 (1991)]. There is a difference between the right to

demand compliance with state laws and the means available to enforce them. *See id.*, at 514.

523 U.S. at 755. Thus, *Kiowa* recognizes a distinction between passing a law which may govern off-reservation activities of a tribe (e.g., a tax on the sale of cigarettes or granting or revoking a license or a patent) and the ability to enforce in *courts* those laws. Indeed, this distinction was further recognized in *Michigan v. Bay Mills*, where the Court recognized that even if sovereign immunity barred a lawsuit by the state of Michigan against a tribe, “Michigan must therefore resort to *other mechanisms*, . . . to resolve this dispute.” 134 S. Ct. at 2028 (emphasis added). One such mechanism authorized by the Court was that “Michigan could, in the first instance, deny a license to [the identified tribe] for an off-reservation casino.” *Id.* at 2035.²

² For example, other Federal Agencies, such as the Federal Communications Committee (“FCC”), have exercised their power to regulate the continuation of previously issued licenses, even when the licensee is a tribe. *See, e.g., In re Confederated Tribes and Bands of the Yakama Nation*, 31 FCC Rcd. 8857, 8857 (F.C.C. Aug. 10, 2016), *available at* https://apps.fcc.gov/edocs_public/attachmatch/DA-16-904A1.pdf; *In re Business Council of the N. Arapaho Tribe*, 29 FCC Rcd. 2650, 2650 (F.C.C. Mar. 10, 2014), *available at* https://apps.fcc.gov/edocs_public/attachmatch/DA-14-331A1.pdf.

An IPR—a PTAB proceeding to take a second look at its earlier grant of a patent—is one these “other mechanisms” authorized by *Bay Mills* to be used against Native American Tribes. Specifically, an IPR is more akin to a state imposing a tax or granting or revoking a license, than it is to a lawsuit seeking to enforce those tax laws or impose penalties for unlicensed activities. *Cf. Potawatomi*, 498 U.S. at 512 (“Although the doctrine of tribal sovereign immunity applies to the Potawatomis, that doctrine does not excuse a tribe from all obligations to assist in the collection of validly imposed state sales taxes.”).

Amicus notes that while *Federal Maritime Commission v. S.C. State Ports Authority*, 535 U.S. 743 (2002) (“*FMC*”) is instructive, it is distinguishable. In *FMC*, a State run entity asserted sovereign immunity as a defense against litigation before an independent agency, the Federal Maritime Commission. In finding that Eleventh Amendment State Sovereign Immunity principles were applicable to that proceeding, *FMC* relied upon, *inter alia*, the bargain reached between the States in the constitutional convention to arrive at the Eleventh Amendment (a factor not at play in the case of Tribal Sovereign Immunity, which is merely grounded in comity). *Compare FMC*, 535 U.S. at 751–52, *with Bay Mills*, 134 S. Ct. at 2031.

A factor behind the *FMC* Court’s decision was the “interest in protecting States’ dignity,” explaining that “[p]rivate suits against nonconsenting States . . . present ‘the indignity of subjecting a State to the coercive process of judicial

tribunals at the instance of private parties,’ *regardless of the forum.*” *FMC*, 535 U.S. at 751 (quoting *In re Ayers*, 123 U.S. 443, 505 (1887)) (emphasis in original). The Court noted that—rather than subjecting sovereign states to this indignity of being sued by private parties—private parties could obtain the same relief sought in the FMC proceedings by bringing their complaints to the FMC directly, and urging the FMC to bring a suit in district court. 535 U.S. at 768 & n.19. No similar procedure exists here for patents.

As the Court recognized in *Cuozzo*, an IPR is an administrative proceeding that simply entails “a second look at an earlier administrative grant of a patent.” *Cuozzo*, 136 S. Ct. at 2144. Also unlike *FMC*, a PTAB proceeding does not result in a litigation-like remedy. Rather, it is intended to be an “efficient system for challenging patents that should not have issued.” H.R. Rep. No. 112-98, at 39–40 (2011) (quoted by *Cuozzo*, 136 S. Ct. at 2144 (“the purpose of the proceeding is not quite the same as the purpose of district court litigation”)). As discussed further below, the *Cuozzo* Court explained how, in many ways, “inter partes review is less like a judicial proceeding and more like a specialized agency proceeding.” *Cuozzo*, 136 S. Ct. at 2143. For example, the private parties that initiate IPRs need not stay in the proceedings, and the Patent Office (i.e., the U.S. Government) exercises discretion over institution and is permitted to intervene in any appeal of

an IPR proceeding. *Cuozzo*, 136 S. Ct. at 2140 (citing 35 U.S.C. § 314(a)); 35 U.S.C. § 143.

Furthermore, prior panel decisions holding that *a state* may assert Eleventh Amendment sovereign immunity are inapplicable here. *See, e.g., Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.* No. IPR2016-1914, Paper 36 (P.T.A.B. July 13, 2017). Those decisions turned on the notion that IPRs are the type of proceeding from which the Framers of the Constitution would have thought the states possessed immunity. However, “the immunity possessed by Indian tribes is not coextensive with that of the States,” *Kiowa*, 523 U.S. at 755–56, since it evolved out of judicial doctrine rather than the Eleventh Amendment. Thus, the Board should not extend these prior decisions to include Tribal Sovereign Immunity.

B. The PTAB May Proceed Without a Patent Owner

An IPR proceeding is focused on the *patent*, not the patent owner. Indeed, the patent owner is not required to participate in the proceeding. As such, principles of immunity from suit are simply inapplicable. *Cf. Cty. of Yakima v. Confederated Tribes and Bands of Yakima Nation*, 502 U.S. 251, 264–65 (1992) (recognizing that taxation of fee-patented land under *in rem* jurisdiction could be exercised against land owned by a sovereign Native American tribe).

While the AIA sets forth certain limits on what must be in a Petition (*see, e.g.,* 35 U.S.C. § 312), who may file a Petition (*see, e.g.,* 35 U.S.C. § 315), and

even provides a patent owner a right to respond to the Petition (*see, e.g.*, 35 U.S.C. § 313), it ***does not require participation by a Patent Owner*** (or even the Petitioner) for the PTAB to complete its task (*see, e.g.*, 35 U.S.C. § 317(a)). *See, e.g., Cuozzo*, 136 S. Ct. at 2144 (“challengers need not remain in the proceeding; rather that Patent Office may continue to conduct an inter partes review even after the adverse party has settled. § 317(a.)”); Ex. 2097, *Reactive Surfaces Ltd. v. Toyota Motor Corp.*, IPR2016-01914, slip op. at 17 (PTAB July 13, 2017) (Paper 36) (“We conclude that Patent Owner has not shown sufficiently that dismissal of the Regents from this proceeding requires termination of the proceeding as to the remaining patent owner, Toyota.”).³

³ In *Covidien LP v. University of Florida Research Foundation Inc.*, IPR2016-01274 (PTAB Jan. 25, 2017) (Paper 21) (Ex. 2095), another panel rejected the fact that an IPR is an *in rem* proceeding because the patent owner could be subject to an estoppel from an adverse judgment. However, the Supreme Court rejected that kind of analysis in *Tennessee Student Assistance Corp v. Hood*, 541 U.S. 440 (2004). Specifically, the Court found that sovereign immunity did not apply to a bankruptcy court’s *in rem* jurisdiction because “a nonparticipating creditor cannot be subjected to personal liability.” *Id.* at 447–48. This was true even though a discharge order would apply to a nonparticipating sovereign creditor. Thus, even though estoppel may apply to the patent holder, such estoppel is still not personal

Where, like the AIA, Congress adopts “a general statute in terms applying to all persons [it] includes Indians and their property interests.” *Fed. Power Comm’n v. Tuscarora Indian Nation*, 362 U.S. 99, 116 (1960) (“*FPC*”). *FPC* held “that Congress, by the broad general terms of § 21 of the Federal Power Act, has authorized the Federal Power Commission’s licensees to take lands owned by Indians, as well as those of all other citizens, when needed for a licensed project, upon the payment of just compensation” *Id.* at 123. Similarly, the AIA allows any “person who is not a patent owner” to be a Petitioner (35 U.S.C. § 311(a); *Cuozzo*, 136 S. Ct. at 2150), subject to meeting the other requirements of Sections 311–319, and offers no restriction on which Patent Owners are authorized to respond (35 U.S.C. § 313) or waive a right to respond (*e.g.*, 37 C.F.R. § 42.107(a)). The Petitioner need not even have constitutional standing. *Cuozzo*, 136 S. Ct. at 2143–44; *see also* 35 U.S.C. § 311(a) (“a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of a patent.”).

liability, and thus does not undermine this Board’s *in rem* jurisdiction over a patent.

C. Post-Institution Acts of the Patent Owner Should Not Divest the Office of Jurisdiction to Complete These Proceedings

When these proceedings began there was no concern about participation by any sovereign; Allergan was the patent owner, not the Tribe. Thus, at the time the Petitions were filed, and the time of the Decisions on institution, it was Allergan who owned and continued to own the patents here, and, in fact, participated as the Patent Owner in these proceedings. While a change of a party's ownership mid-proceeding may justify the addition or substitution of a party to a proceeding, it should not entitle a party to usurp the Office's ability to complete a process that was properly commenced. Consistent with the fact that "the Patent Office may continue to conduct an inter partes review even after the adverse party has settled," *Cuozzo*, 136 S. Ct. at 2144 (citing 35 U.S.C. § 317(a)), the Patent Office may continue to conduct an IPR even after the adverse party has attempted to assign the patent in order to assert sovereign immunity.

Allowing the Office to finish a proceeding it properly commenced comports with the way that courts have treated other attempts to retroactively escape jurisdiction. For example, a party cannot defeat diversity jurisdiction by moving, incorporating in another state, or otherwise changing its citizenship after the filing of a complaint. In *Freeport-McMoRan Inc. v. K N Energy, Inc.*, the Supreme Court explained that it has "consistently held that if jurisdiction exists at the time an action is commenced, such jurisdiction may not be divested by subsequent

events.” 498 U.S. 426, 428 (1991). The Supreme Court explained that allowing such subsequent events to defeat diversity jurisdiction “is not in any way required to accomplish the purposes of diversity jurisdiction.” *Id.* at 429.

Likewise, allowing the PTAB to complete a properly instituted IPR does not undermine the purposes of Tribal Sovereign Immunity. The U.S. would not be disrespecting the “dignity” of the Tribe as a sovereign nor subjecting the Tribe to “judicial attack” by continuing an IPR that the Tribe had full notice of prior to acquiring the patents at issue here. *See Hall*, 440 U.S. at 416; *Kiowa*, 523 U.S. at 757; *cf. Lundgren v. Upper Skagit Indian Tribe*, 187 Wn.2d 857, 873 (Wash. 2017) (refusing to allow a tribe to assert Tribal Sovereign Immunity in an *in rem* property dispute where the tribe could have discovered the dispute prior to purchasing the property), *petition for cert. filed*, No. 17-387 (S. Ct. Sept. 11, 2017).

Rather, allowing the Office to finish a proceeding it properly commenced furthers the purpose of IPRs. As *Cuozzo* recently clarified, Congress intended that IPRs would “help[] protect the public’s ‘paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.’” *Cuozzo*, 136 S. Ct. at 2144–45 (quoting *Precision Instr.*, 324 U.S. at 816). If Allergan is allowed to pull its patents from this review at the eleventh hour by purchasing immunity from the Tribe, then every patent owner could safeguard its patents in a similar way, undermining the entire post-grant patent review system.

D. The Transaction Should Be Disregarded As a Sham

Particularly disturbing in these proceedings is the sham-like or collusive nature of the transaction. As Judge Bryson explained in the related litigation, which invalidated the patent claims at issue there, “[t]he Court has serious concerns about the legitimacy of the tactic that Allergan and the Tribe have employed.” Ex. 1163, Memorandum Opinion and Order, *Allergan, Inc. v. Teva Pharms. USA, Inc.*, No. 2:15-cv-1455-WCB, slip op. at 4 (E.D. Tex. Oct. 16, 2017) (ECF No. 522) (Bryson, U.S. Cir. J., sitting by designation). Indeed, Judge Bryson likened the structure of the current transaction to “sham transactions, such as abusive tax shelters.” *Id.* at 5–6.

Assuming the PTAB agrees with Judge Bryson that the transaction is a sham or otherwise collusive, the Supreme Court has recognized collusive activity cannot (and should not) divest a court of jurisdiction. *See, e.g., Kramer v. Caribbean Mills, Inc.*, 394 U.S. 823, 826–30 (1969) (“If federal jurisdiction could be created by assignments of this kind, which are easy to arrange and involve few disadvantages for the assignor, then a vast quantity of ordinary contract and tort litigation could be channeled into the federal courts at the will of one of the parties.”). Likewise, here, a sham or collusive transaction should not derail this Board from arriving at its Final Written Decisions in these administrative proceedings. *Cf. Vas-Cath, Inc. v. Curators of the Univ. of Mo.*, 473 F.3d 1376,

1383 (Fed. Cir. 2007) (“The principles of federalism are not designed for tactical advantage[.]”).

IV. CONCLUSION

Amicus respectfully submit that at least for these reasons, the Tribe’s motion to dismiss should be denied and this administrative agency should complete the second look at the patents it previously granted, with or without the Tribe’s participation.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 1st day of December, 2017, a true copy of the foregoing **BRIEF OF ASKELADDEN LLC AS *AMICUS CURIAE* IN OPPOSITION TO ST. REGIS MOHAWK TRIBE'S MOTION TO DISMISS** was served via electronic mail on the following counsel of record for Petitioners and Patent Owner in these proceedings:

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