

2018-1638, 2018-1639, 2018-1640, 2018-1641, 2018-1642 and 2018-1643

**United States Court of Appeals
for the Federal Circuit**

SAINT REGIS MOHAWK TRIBE, ALLERGAN, INC.,

Appellants,

– v. –

MYLAN PHARMACEUTICALS INC., TEVA PHARMACEUTICALS
USA, INC., AKORN, INC.,

Appellees.

*On Appeal from the United States Patent and Trademark Office, Patent
Trial and Appeal Board in Nos. IPR2016-01127, IPR2016-01128,
IPR2016-01129, IPR2016-01130, IPR2016-01131, IPR2016-01132,
IPR2017-00576, IPR2017-00578, IPR2017-00579, IPR2017-00583,
IPR2017-00585, IPR2017-00586, IPR2017-00594, IPR2017-00596,
IPR2017-00598, IPR2017-00599, IPR2017-00600 and IPR2017-00601*

**BRIEF FOR AMICUS CURIAE PATENTS
COMMITTEE AT THE NEW YORK CITY BAR
ASSOCIATION IN SUPPORT OF NEITHER PARTY**

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APRIL 25, 2018

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals Inc.

Case No. 18-1638

CERTIFICATE OF INTEREST

Counsel for the:

(petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

New York City Bar Association

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
New York City Bar Association	New York City Bar Association	(none)

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

Yin Huang - Zuber Lawler & Del Duca LLP, New York, NY

FORM 9. Certificate of Interest

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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47.4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

To the best of amicus' knowledge, the following cases may be affected by this Court's decision: Mylan Pharm. Inc. v. St. Regis Mohawk Tribe, No. IPR-2016-01127 (Pat. Tr. & App. Bd. filed Mar. 8, 2018) and joined proceedings; Allergan, Inc. v. DEVA Holding A.S., No. 2:16-cv-01447 (E.D. Tex. filed Dec. 22, 2016); Allergan, Inc. v. InnoPharma, Inc., No. 2:15-cv-01504 (E.D. Tex. filed Sep. 8, 2015); and Allergan, Inc. v. Teva Pharm. USA, Inc., No. 2:15-cv-01455 (E.D. Tex. filed Aug. 24, 2015).

4/25/2018

Date

/s/ Yin Huang

Signature of counsel

Please Note: All questions must be answered

Yin Huang

Printed name of counsel

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I. Statements by *Amicus Curiae*

A. Statement under Federal Rule of Appellate Procedure 29(a)(4)(D)

The New York City Bar Association (the “Association”) is a private, non-profit organization of more than 24,000 members who are professionally involved in a broad range of law-related activities. Founded in 1870, the Association is one of the oldest bar associations in the United States. The Association seeks to promote reform in the law and to improve the administration of justice at the local, state, federal, and international levels through its more than 150 standing and special committees. The Committee on Patents (“Committee”) is a long-established standing committee of the Association, and its membership reflects a wide range of corporate, private-practice, and academic experience in patent law. The participating members of the Committee are dedicated to promoting the Association’s objective of improving the administration of the patent laws.

B. Statement under Federal Rule of Appellate Procedure 29(a)(4)(E)

No part of this brief was authored by counsel for any party to the this case. No party in this case or counsel for a party in this case contributed money that was intended to fund preparing or submitting this brief. No person other than the Association, its members, or its counsel contributed money that was intended to fund preparing or submitting this brief. All parties have consented to the filing of this brief.

II. Summary of the Argument

While the parties and *amici* have focused on the question of whether sovereign immunity precludes challenges against a patent through *inter partes* review, sovereign immunity is not the only factor that is relevant to this Court's resolution of the current dispute. Several decisions of the Patent Trial and Appeal Board (the "Board") suggest that the reviewability of patent claims in *inter partes* review is an intrinsic property of patents that cannot be affected by the identity of a patent's current owner. Those decisions are consistent with the Supreme Court's recent decision in the *Oil States* case. *Oil States Energy Serv., LLC v. Greene's Energy Group, LLC*, No. 16-712, 2018 WL 1914662 (Sup. Ct. Apr. 24, 2018).

III. Argument

As this Court is aware, appellants Allergan, Inc. ("Allergan") and Saint Regis Mohawk Tribe (the "Tribe") entered into a business arrangement for the purpose of using the Tribe's sovereign immunity to insulate the Restasis[®] patents from legal challenge. *See generally Mylan Pharm. Inc. v. St. Regis Mohawk Tribe*, No. IPR2016-01127, 2018 WL 1100950 (Pat. Tr. & App. Bd. Feb. 23, 2018).

Accordingly, the parties and *amici* have amply addressed whether that sovereign immunity precludes challenges against the Restasis[®] patents through *inter partes* review. The applicability of sovereign immunity, however, is not the only factor that should be considered by this Court. Specifically, statutory language and case

law suggest that the Board has the authority to modify the scope of a patent by issuing a final written decision under 35 U.S.C. § 318(a) even if: (a) the owner of a challenged cannot be identified; or (b) a known patent owner fails to participate in an *inter partes* review proceeding.

A. The Board has issued final written decisions even when no patent owner appears in *inter partes* review.

The current case is not the first time the Board has handled an *inter partes* review in which the ownership of a challenged patent was called into question midway through the proceeding. As the Board noted in its opinion below, there have been at least two instances in which the Board proceeded to a final written decision without the participation of a patent owner. *Mylan*, 2018 WL 1100950 at *6.

1. Issuance of Final Written Decision without a Cognizable Patent Owner

In *Microsoft Corp. v. Global Technologies, Inc.*, Nos. IPR2016-00663 and IPR2016-00669, 2017 WL 2417332 (Pat. Tr. & App. Bd. Jun. 2, 2017), the Board issued a final written decision canceling multiple claims in each of two challenged patents even though the dissolution of a prior corporate assignee of those patents left no clear owner at the time of an *inter partes* review proceeding. *Id.* at *4. The patents challenged in *Global Technologies* had initially been assigned by four joint inventors to a first assignee, Global Technologies, Inc. (“GTI”). Subsequently, the

patents were assigned by GTI back to one of those inventors, Keith Raniere (“Raniere”). The two successive assignments were separated by more than nineteen years, with the first assignment occurring on March 23, 1995, and the second assignment occurring on December 26, 2014.

Following the execution of the second assignment, Raniere sued two corporate defendants for infringement, including *inter partes* review petitioner Microsoft Corporation.¹ The infringement lawsuits, however, uncovered a serious defect in the chain of title through which Raniere owned—or purported to own—the asserted patents. Specifically, GTI, from which Raniere had supposedly received the patents, had been “administratively dissolved” on May 20, 1996—approximately one year after the execution of the first assignment agreement. *Global Technologies*, 2017 WL 2417332 at *2. In practice, dissolution meant that GTI ceased to have the authority to “carry on any business except that appropriate to wind up and liquidate its business and affairs” under state law. *Id.* at *2.

Since the record contained no indication that any effort was taken to prevent the dissolution from creating a legal irregularity in the ownership of the patents, the ownership status of the patents entered a legal “limbo.” Despite Raniere’s insistence that he had properly obtained those patents from GTI, Raniere was

¹ *Raniere v. Microsoft Corp.* No. 3:15-CV-0540-M (N.D. Tex. filed Feb. 16, 2015); *Raniere v. AT&T Corp.*, No. 3:15-CV-2298-M (N.D. Tex. filed Jul. 10, 2015).

ultimately unable to produce documentation sufficient to prove that GTI legitimately assigned the patents to him. *Id.* at *2. When subsequent efforts by the Board failed to uncover a true owner eligible to appear in the proceeding, the Board entered a judgment against GTI on the basis of abandonment of the proceeding under 37 C.F.R. § 42.73(b)(4), which canceled multiple patent claims. *Id.* at *4.

2. Issuance of Final Written Decision Without the Participation of Known Patent Owner

In *Old Republic General Insurance Group, Inc. v. Owner of U.S. Patent No. 6,519,581*, No. IPR2015-01956 (Pat. Tr. & App. Bd. Apr. 18, 2017) (unpublished decision), the Board proceeded to a final written decision on *inter partes* review even though a known patent owner never appeared in the proceeding. In *Old Republic*, Intellectual Ventures I LLC (“IV”) was the named owner of a patent being challenged in *inter partes* review. In concurrent litigation² by IV against accused infringers of the patent, it was discovered that IV did not actually own the patent. Specifically, a defective assignment agreement earlier in the chain of title had effectively invalidated the assignment by which IV had purportedly received

² *Intellectual Ventures I LLC v. Old Republic Gen. Ins. Group, Inc.*, No. 2:14-cv-01130 (W.D. Pa. filed Aug. 22, 2014); *Intellectual Ventures I LLC v. Highmark, Inc.*, No. 2:14-cv-01131 (W.D. Pa. filed Aug. 22, 2014); *Intellectual Ventures I LLC v. Erie Indem. Co.*, No. 1:14-cv-00220 (W.D. Pa. filed Aug. 21, 2014).

the patent—a finding which this Court affirmed. *Intellectual Ventures I LLC v. Erie Indem. Co.*, 850 F.3d 1315, 1321 (Fed. Cir. 2017). As a result, the ownership of the patent devolved to the last party that owned the patent before the defective assignment—an entity called AllAdvantage.com. *Id.* at 1320. Despite that the true owner of the patent was known and served with notice, that entity never appeared in the proceeding. As a result, the Board proceeded without a “substitute patent owner” (*i.e.*, a party other than the initially named owner IV) and issued a final written decision invalidating multiple claims. *Old Republic*, No. IPR2015-01956 at 35.

3. Issuance of a Final Written Decision Following Settlement by All Parties

It is important to note that the Board is statutorily authorized to issue a final written decision even if the parties involved in *inter partes* review settle with each other. Specifically, 35 U.S.C. § 317(a) provides:

If no petitioner remains in the inter partes review, the Office may terminate the review **or** [emphasis added] proceed to a final written decision under section 318(a).

See also Oil States, 2018 WL 1914662, at *4 (Sup. Ct. Apr. 24, 2018)

(noting the Board’s authority to proceed to a final written decision at its discretion). Thus, in *Yahoo! Inc. v. CreateAds LLC*, No. IPR2014-00200, 2015 WL 1967349 (Pat. Tr. & App. Bd. Apr. 29, 2015), the Board invalidated multiple claims in a challenged patent despite that a settlement agreement had removed all

parties from the dispute. *Id.* at *17. The Board noted in the final written decision, “Although the proceeding thus was terminated *with respect to all petitioners*, the proceeding *itself* was not terminated.” *Id.* at *1 (emphasis added).

IV. Conclusion

The foregoing decisions strongly suggest that the reviewability of patent claims under *inter partes* review is an intrinsic property of patents—as opposed to a function of a patent owner’s identity. The Supreme Court’s recent decision in *Oil States* is consistent with this view. Specifically, the *Oil States* Court noted: (a) “it was well understood at the founding that . . . a patent system could include a practice of granting patents subject to potential cancellation”; (b) that “[p]atent claims are granted subject to the qualification that the PTO has the authority to reexamine—and perhaps cancel—a patent claim in an *inter partes* review”; and (c) that *inter partes* review is one of the “conditions and tests for patentability” in the current patent system. *Oil States*, at *7, *10 (internal quotation marks omitted). In light of the case law, this Court should consider whether the Board may proceed to a final written decision in the current case notwithstanding an assertion of sovereign immunity by the Tribe.

Dated: April 25, 2018

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**United States Court of Appeals
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CERTIFICATE OF SERVICE

Saint Regis Mohawk Tribe v. Mylan Pharmaceuticals Inc., No. 18-1638

I, Simone Cintron, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel Press has been retained by Counsel for the Amicus to print this document. I am an employee of Counsel Press.

On April 25, 2018, Counsel for the Amicus authorized me to electronically file the foregoing **BRIEF FOR AMICUS CURIAE PATENTS COMMITTEE AT THE NEW YORK CITY BAR ASSOCIATION IN SUPPORT OF NEITHER PARTY** with the Clerk of Court using the CM/ECF System, which will send notice of such filing to all registered CM/ECF users.

Upon acceptance by the Court of the e-filed document, six paper copies will be filed with the Court, via Federal Express, within the time provided in the Court's rules.

/s/ Simone Cintron
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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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