

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)¹

Before SHERIDAN K. SNEDDEN, TINA E. HULSE, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Conduct of the Proceedings
37 C.F.R § 42.5

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.

IPR2016-01127 (8,685,930 B2); IPR2016-01128 (8,629,111 B2);
IPR2016-01129 (8,642,556 B2); IPR2016-01130 (8,633,162 B2);
IPR2016-01131 (8,648,048 B2); IPR2016-01132 (9,248,191 B2)

Over the past two weeks, we have received several requests via email regarding various issues. We address each issue below.

1. *Request for Briefing from Amicus Curiae*

On October 25, 2017, the Board received an e-mail from High Tech Inventors Alliance (HTIA) requesting leave to file a brief as an *amicus curiae* on the question presented in the Tribe’s motion to terminate. Ex. 3002.² HTIA is a nonprofit corporation whose members are Adobe Systems, Inc.; Amazon.com, Inc.; Cisco Systems, Inc.; Dell Inc.; Google Inc.; Intel Corporation; Oracle Corporation; and salesforce.com, inc. *Id.* According to HTIA, its members are “frequent users of the Patent and Trademark Office’s *inter partes* review process [who] are also keenly interested in ensuring that the IPR process remains available to resolve questions of patentability in an efficient and timely manner.” *Id.* HTIA stated that the Tribe does not consent to its request. In a subsequent email, Petitioners indicated that they do not object to HTIA’s request.

We recognize that we previously denied a request to file an amicus brief from the Association for Accessible Medicines (AAM). Paper 85, 5. At that time, the Tribe’s counsel stated that if AAM is permitted to file an amicus brief, then other tribes should be permitted to file amicus briefs in support of the Tribe’s motion. *Id.* Moreover, Petitioners stated that they did not support the filings if they would result in further delay of these

² All exhibits and paper numbers cited in this Order refer to those documents filed in IPR2016-01127. Similar papers and exhibits were filed in the other proceedings.

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proceedings. *Id.* Now, however, Petitioners indicate that they do not object to HTIA's briefing request.

Given that the Tribe's motion presents an issue of first impression for the Board and that the parties' briefing on the motion is complete, we are persuaded that briefing from interested *amici curiae* is now warranted in these proceedings. Accordingly, we grant HTIA's request to file an amicus brief of no more than 15 pages by December 1, 2017. Furthermore, we authorize briefing from any other *amici curiae*, which shall also be no more than 15 pages by December 1, 2017. To the extent possible, to avoid redundancy and in the interests of efficiency, we direct any interested *amici* who wish to present similar arguments to the Board to coordinate in their filing of a joint *amicus* brief. Arguments redundant to those already presented by the parties or other *amici* may not be considered.

Petitioners and the Tribe are each authorized to file a single response to any amicus briefing by December 15, 2017. The responses shall be no longer than 15 pages.

No further briefing is authorized at this time.

2. *Petitioners' Request for a Surreply*

On October 25, 2017, we received a request from Petitioners for authorization to file a surreply in response to the Tribe's reply in support of the motion to terminate. The Tribe opposes Petitioners' request.

In light of our authorization for the parties to file responses to the amicus briefs, we believe a surreply is unnecessary. Petitioners' request for a surreply is therefore denied.

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3. *Allergan's Renewed Request to Withdraw as Counsel*

During a prior conference call, Allergan's counsel sought leave to file a motion to withdraw as counsel in these proceedings. Paper 85, 4. We denied that request, but stated that Allergan's counsel may renew its request after briefing on the Tribe's motion is complete. *Id.* On October 31, 2017, the Board received an email from Allergan's counsel renewing its request for leave to file a motion to withdraw as counsel.

Given the outstanding issue presented in the parties' briefs as to whether Allergan retains an ownership interest in the challenged patents and in light of our decision to allow additional briefing from *amici curiae*, we again deny Allergan's counsel's request to file a motion to withdraw without prejudice. Allergan's counsel may renew the request once all briefing is complete. At that time, Allergan's counsel should confer with Petitioners and indicate in its request whether Petitioners oppose the motion to withdraw.

4. *Statutory Deadline*

We instituted *inter partes* review in each of these proceedings on December 8, 2017. Paper 8. According to 35 U.S.C. § 316(a)(11), we must issue a final written decision in an *inter partes* review no later than one year after institution, except that the Director "may adjust the time periods in this paragraph in the case of joinder under section 315(c)." *See also* 37 C.F.R. § 42.100(c) ("The time [for entering a final written decision] can be . . . adjusted by the Board in the case of joinder."). Because these proceedings were joined with the proceedings filed by Teva Pharmaceuticals USA, Inc.

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and Akorn Inc. under 35 U.S.C. § 315(c) (Papers 18 and 19), we adjust the deadline to enter a final written decision to April 6, 2018.

Accordingly, based on the foregoing, it is:

ORDERED that High Tech Inventors Alliance's request for authorization to file a brief as *amicus curiae* on the issues presented in the Tribe's motion to terminate is *granted*;

FURTHER ORDERED that any other *amicus curiae* who wishes to file a brief related to the Tribe's motion to terminate is authorized to do so;

FURTHER ORDERED that any amicus brief shall be no longer than 15 pages and shall be filed no later than December 1, 2017;

FURTHER ORDERED that the parties may each file a single response to the amicus briefs;

FURTHER ORDERED that the parties' responses to the amicus briefs shall be limited to 15 pages and filed by December 15, 2017;

FURTHER ORDERED that Petitioners' request for a surreply to the Tribe's motion to terminate is *denied*;

FURTHER ORDERED that Allergan's counsel's request for authorization to file a motion to withdraw as counsel is *denied* without prejudice;

FURTHER ORDERED that Allergan's counsel may renew the request to withdraw after amicus briefing and the parties' responses are complete; and

FURTHER ORDERED that the time to enter a final written decision in these proceedings is adjusted to April 6, 2018.

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