

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,
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

**BRIEF OF BSA | THE SOFTWARE ALLIANCE AS *AMICUS*²
REGARDING APPLICABILITY OF TRIBAL SOVEREIGN IMMUNITY
IN IPR PROCEEDINGS**

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 been joined with the captioned proceedings.

² See IPR2016-01127, Paper No. 96, at 3, 5 (Nov. 3, 2017) (authorizing *amicus* briefs “related to the Tribe’s motion to terminate” of no more than 15 pages by December 1, 2017 because “we are persuaded that briefing from interested *amici* is now warranted in these proceedings”).

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I. INTEREST OF THE *AMICUS*

BSA | The Software Alliance is an association of the world's leading software and hardware technology companies. On behalf of its members, BSA promotes policies that foster innovation, growth, and a competitive marketplace for commercial software and related technologies. Because patent policy is vitally important to promoting the innovation that has kept the United States at the forefront of software and hardware development, BSA members have a strong stake in the proper functioning of the U.S. patent system.

BSA members are among the nation's leading technology companies, producing much of the hardware and software that power computer and telecommunication networks. The complexity and commercial success of their products make these companies frequent targets of patent infringement claims.³

At the same time, by virtue of their inventions, BSA members hold tens of thousands of patents. Because they are both innovators as well as substantial patent holders, BSA members have a particularly acute interest in properly calibrated mechanisms for ensuring patent quality.

³ BSA members have been sued for infringement on patents transferred to tribes, including patents transferred to the Saint Regis Mohawk Tribe, and therefore are adverse to the Tribe in pending litigation.

II. INTRODUCTION AND SUMMARY

That tribes have a form of sovereign status and a form of sovereign immunity is well settled. Equally well settled is the principle that tribal sovereignty and immunity is not without bounds and, in particular, that they are necessarily subordinate to national interests. Such interests are present where Congress determines that an activity or area of commerce should be governed by a statute of general applicability—where Congress makes that choice, tribal sovereignty and immunity, creatures of judge-made rather than constitutional law, must give way.

The Patent Act and the America Invents Act (“AIA”) reflect just such a Congressional choice. The statute applies on its face to all patent owners, and includes no exception for tribes. Nor do any of the recognized exceptions to the principle that such statutes presumptively govern tribes to the same extent as all others apply here. Nothing about patents or patent law has any connection to the core concerns of tribal immunity—preserving tribal sovereignty in matters of self-governance and internal tribal affairs—and no legitimate tribal interests are implicated or impaired by applying the generally-applicable provisions of the AIA to a situation in which, by mere happenstance (or, in this case, calculated tactical ploy) patent ownership is assigned to a tribe.

That is particularly true here because the *inter partes* review (“IPR”) process is just that—a *process* designed to allow the federal agency charged with responsibility for patent issuance to fulfill its statutory mandate by correcting its own prior mistakes. Although this particular part of the U.S. Patent and Trademark Office’s (“PTO”) process of reviewing patents and applications for patents is initiated by a third party, it is nonetheless agency review and wholly unlike the kinds of proceedings to which sovereign immunity, even when not overridden by paramount federal interests, applies. The IPR process subjects patent owners, tribes and non-tribes alike, to no claims for damages, no injunctions, and no other form of liability to another party. Rather, the IPR process serves to advance the important public policy—rooted in the Constitution’s Patent and Copyright Clause—of ensuring that the American public and economy are not burdened by unwarranted monopolies.

III. TRIBES ARE SUBJECT TO THE AMERICA INVENTS ACT.

It has long been recognized that tribes, while “under the sovereignty and dominion of the United States,” *Cherokee Nation v. State of Ga.*, 30 U.S. 1, 17 (1831) (Marshall, C.J.), nevertheless possess sovereign authority in specific spheres, in particular, with respect to matters of tribal self-government and other matters internal to the tribe, *Santa Clara Pueblo v. Martinez*, 436 U.S. 134, 153 (1980). This sovereign authority, and the immunity associated with it, however,

must yield to the overriding “interests of the National government.” *Washington v. Confederated Tribes*, 447 U.S. 134, 153 (1980). Those federal interests can be manifested in a variety of ways, and one such way is by the enactment of statutes of general applicability that apply to all persons subject to the “sovereignty and dominion of the United States.” *Cherokee Nation*, 30 U.S. at 17. Where such a statute is at issue, and the conduct relates to commercial activity that is not purely intramural, tribal sovereignty and immunity are at their narrowest. *San Manuel Indian Bingo & Casino v. NLRB*, 475 F.3d 1306, 1312–13 (D.C. Cir. 2007) (citing *Mescalero Apache Tribe v. Jones*, 411 U.S. 145, 148–49 (1973)).

The Patent Act, including the AIA, is such a statute of general applicability affecting general commercial activity non-tribe members. It is a statute that applies on its face to all patent owners, including tribes. *See Fed. Power Comm’n v. Tuscarora Indian Nation*, 362 U.S. 99, 116 (1960). The Supreme Court in *Tuscarora* articulated the governing principle “now well settled by many decisions of this Court that a general statute in terms applying to all persons includes Indians and their property interests.” *Id.* This governing principle applies here and dictates that the Patent Trial and Appeal Board (“PTAB” or the “Board”) should conclude that patents owned by tribes, including the Saint Regis Mohawk Tribe in this proceeding, are subject to the AIA and its *inter partes* review (“IPR”) process to the same extent and on the same terms as patents owned by others.

A. Other Federal Agencies Operating Under Similar Statutory Schemes Have Jurisdiction over Tribes.

Courts have consistently held that federal agencies have jurisdiction to apply statutes of general applicability to tribes in cases involving statutory regimes and factual circumstances comparable to those presented here. For example, the National Labor Relations Board has applied the National Labor Relations Act (“NLRA”) to a tribe’s operation of a casino. That exercise of agency authority was upheld, because application of the NLRA, a statute of general applicability, “does not undermine the [tribe’s] right of self-governance in purely intramural matters.” *NLRB v. Little River Band of Ottawa Indians Tribal Gov’t*, 788 F.3d 537, 555–56 (6th Cir. 2015).

This recent decision reflects the settled principle that aspects of tribal sovereignty can be superseded by comprehensive federal regulatory schemes even when the statutes are silent as to tribes. *See, e.g., Menominee Tribal Enters. v. Solis*, 601 F.3d 669, 674 (7th Cir. 2010) (Occupational Safety and Health Act (“OSHA”) applied to tribe’s operation of a sawmill and related commercial activities); *Reich v. Mashantucket Sand & Gravel*, 95 F.3d 174, 177–82 (2d Cir. 1996) (OSHA applied to tribe’s construction business operated only within confines of reservation); *Smart v. State Farm Ins. Co.*, 868 F.2d 929, 932–36 (7th Cir. 1989) (Employee Retirement Income Security Act applied to tribal employee benefits plan because statute did not affect tribe’s ability to govern itself in

intramural matters); *Navajo Tribe v. NLRB*, 288 F.2d 162, 165 (D.C. Cir. 1961) (NLRA applied to employers located on reservation lands). Courts also have held that when a tribal activity affects commerce within the scope of Congress's authority under the Commerce Clause, it falls within agencies' statutory jurisdiction. *See NLRB v. Fainblatt*, 306 U.S. 601, 607–08 (1939) (NLRA applied to tribe's manufacturing business because it regularly affected interstate commerce).

These cases recognize that although federal statutes of general applicability may not apply where a tribe acts purely in its sovereign capacity, “[t]he tribes’ retained sovereignty reaches only that power ‘needed to control . . . internal relations[,] . . . preserve their own unique customs and social order[, and] . . . prescribe and enforce rules of conduct for [their] own members.’” *Little River Band*, 788 F.3d at 550 (quoting *Duro v. Reina*, 495 U.S. 676, 685–86 (1990)). Tribal immunity extends no farther than to such “purely intramural matters.” *Id.* at 555; *cf. EEOC v. Fond du Lac Heavy Equip. & Constr. Co.*, 986 F.2d 246, 249 (8th Cir. 1993) (although Age Discrimination in Employment Act is generally applicable to tribes, it does not apply to a member of a tribe, the tribe as employer, and reservation employment because such a “dispute involves a strictly internal matter” and application would affect “tribe’s specific right of self-government”).

B. PTAB Agency Action in IPRs Implicates None of the Exceptions to the *Tuscarora* Rule.

Like other statutes of general applicability, the Patent Act and the AIA implement a broad federal regulatory regime. There is no basis for exempting tribes from compliance with this regulatory scheme. The Patent Act does not expressly exempt tribes.⁴ Nor does Board action pursuant to the AIA fall within the ambit of any *Tuscarora* exception that would call for immunity. There has been no showing that “(1) the law touches ‘exclusive rights of self-governance in purely intramural matters’; (2) the application of the law to the tribe would ‘abrogate rights guaranteed by Indian treaties’; or (3) there is proof ‘by legislative history or some other means that Congress intended [the law] not to apply to Indians on their reservations’” *Donovan v. Coeur d’Alene Tribal Farm*, 751 F.2d 1113, 1116 (9th Cir. 1985) (quoting *U.S. v. Farris*, 624 F.2d 890, 893–94 (9th Cir. 1980).

To the contrary, application of such a general regulatory regime to patents that happen to be owned by a tribe has nothing to do with tribal self-governance—the existence and enforcement of patent rights are matters completely independent of the internal affairs of a tribe and the relationship between a tribe and its

⁴ Contrast other statutes in which tribes are expressly excluded, *e.g.*, from definitions of “employer,” in Title VII of the Civil Rights Act of 1964, 42 U.S.C. 2000e(b)(1), and Title I of the Americans with Disabilities Act of 1990, 42 U.S.C. 12111(5)(B)(i).

members. Patent rights, and the law that governs them, are manifestly not an area that intrudes upon or implicates a tribe's internal affairs or right of self-government. There is no tribal analog to patent rights, nor could there be consistent with the Constitution's Patent and Copyright Clause, U.S. CONST. art. I, § 8, cl. 8, which vests exclusive authority for such matters in the national government. Nor does application of the AIA regime abrogate or impair any rights granted under treaties. And nothing in the legislative history of the Patent Act or the AIA in any way suggests that Congress intended these laws not to apply to tribes like the Saint Regis Mohawk Tribe.

The Patent Act and the IPR process established in the AIA affect a tribe's ability to enforce government-granted rights—rights held by tribes on the same terms as all others who hold them. Nothing about the AIA and its IPR process even arguably implicates a tribe's "exclusive rights of self-governance in purely intramural matters." *Coeur D'Alene*, 751 F.2d at 1116. Even if a tribe's effort to enforce patent rights could somehow be characterized as acting in a sovereign capacity—and it cannot—"when a tribal government goes beyond matters of internal self-governance and enters into an off-reservation business transaction with non-Indians, its claim of sovereignty is at its weakest." *San Manuel*, 475 F.3d at 1312–13. Patent rights simply have nothing to do with "matters of internal self-governance" and manifestly affect off-reservation activities of non-Indians. *See id.*

IV. THE PTO CAN REVIEW TRIBE-OWNED PATENTS IN IPR PROCEEDINGS.

IPRs under the AIA are fundamentally federal government action directed to government-issued rights. The Patent and Trademark Office is authorized to investigate and re-assess the validity of the patent rights it is charged to administer, either upon its own initiative or based upon information supplied by a third party.

Action by the PTO, including through the PTAB in an IPR, implicates none of the concerns driving the proper application of tribal sovereign immunity. The IPR process exists to allow a federal agency to reconsider a prior decision. It subjects tribes to no private claims for relief, exposes them to no potential monetary liability, and will not result in any injunction or other order constraining their sovereign activities. The AIA created no private right of action that the PTO adjudicates. *Cf. Fla. Paraplegic Ass'n v. Miccosukee Tribe of Indians*, 166 F.3d 1126, 1128–30 (11th Cir. 1999) (holding Title III of the Americans with Disabilities Act applied to tribe's restaurant and gaming facility, but tribe was not amenable to private suit). The AIA, solely and in its entirety, established a new chapter in PTO procedures directed to review of earlier patent grants. No aspect of a tribe's status or ability to act as a sovereign is affected in any way by subjecting patents it may own to the same PTO proceedings to which other patents are subject, proceedings directed solely to whether a patent was properly issued by the PTO in the first instance.

The PTO’s statutory mandate reflects its “obligation to protect the public” from improperly issued patents, *U.S. v. Am. Bell Tel. Co.*, 128 U.S. 315, 367 (1888), which impose high social costs, *see Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1930 (2015) (meritless patents “can impose a ‘harmful tax on innovation’”) (citation omitted); *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 396 (2006) (Kennedy, J., concurring); *Cardinal Chem. Co. v. Morton Int’l, Inc.*, 508 U.S. 83, 100–01 (1993). Congress has chosen to authorize post-grant review of patents, no matter the owner, through the IPR process. IPRs serve the same important public purpose as initial examination, namely the protection of the public from private monopolies that exceed the bounds authorized by Congress. *See* H.R. Rep. No. 98, 112th Cong., 1st Sess. Pt. 1, at 39–40 (2011) (“House Report”).

Congress through the AIA has given the PTAB broad authority to determine the patentability of issued patents without regard to participation of patent owners or third parties. *See* 35 U.S.C. §§ 311–17. Petitioners in IPRs are limited to advancing evidence and arguments regarding the patentability of the patent claim at issue. *See* 35 U.S.C. § 311(b). A petitioner does not need to have a concrete dispute with the patent holder and in fact “may lack constitutional standing.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2143–44 (2016). Consistent with its mandate, the PTAB can pursue an IPR without the petitioner, who “need

not remain in the proceeding; rather, [the PTO] may continue to conduct an inter partes review even after the adverse party has settled.” *Id.* at 2144; *see* 35 U.S.C. § 317(a). A patentability determination in this posture and on this record is an extension of the initial agency examination. Indeed, party-specific issues are not relevant to Board’s determination. *See* 35 U.S.C. § 314(a) (authorizing institution only upon a determination “that the information presented in the petition filed under section 311 [*i.e.*, “only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications”] . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the [challenged] claims . . .”). “Very seldom do IPR proceedings have the hallmarks of what is typically thought of as a trial.” *See Ultratec, Inc. v. Captioncall, LLC*, 872 F.3d 1267, 1270 n.2 (Fed. Cir. 2017) (proceedings are limited in scope and in contrast to district court litigation). Indeed, the PTO need not institute a review in response to every, or even any, petition. *Cf. Fed. Maritime Comm’n v. S.C. State Ports Auth.*, 535 U.S. 743, 764 (2002) (noting, in a case involving constitutionally-based state immunity, “[T]he FMC does not even have the discretion to refuse to adjudicate complaints brought by private parties.”).

IPRs allow the PTO to make use of third parties’ knowledge and to correct prior mistakes by canceling claims that never should have been granted. When the

PTO does so, no private party receives any benefit that it would not have received if the examiner had denied the patent application in the first instance, as should have been done, or if the PTO Director had reexamined and cancelled the claims *sua sponte*. Agencies' use of such administrative processes to correct their own mistakes is commonplace.⁵

By enabling the PTO to take “a second look at an earlier administrative grant of a patent” based on new information or arguments, *Cuozzo*, 136 S. Ct. at 2144, IPRs help to ensure that unpatentable inventions do not continue to receive unwarranted monopoly protection, thereby addressing what Congress determined was a substantial problem of erroneous grants under the preexisting system. House Report at 39–40. In enacting the AIA, Congress established a *process* by which any party can petition the PTO to reconsider its decision to grant a specific patent, including provisions covering how the PTO should determine whether to review a patent and how to go about that review.

⁵ See, e.g., 5 U.S.C. § 8470 (authorizing agency to recoup erroneously issued federal employee benefits); 38 U.S.C. § 5302 (authorizing agency to recoup erroneously issued veterans' benefits); 42 U.S.C. § 404 (authorizing agency to recoup erroneously issued social security benefits); 47 U.S.C. § 312 (authorizing agency to revoke radio station licenses); 49 U.S.C. § 13905(d)(2) (authorizing agency to revoke erroneously issued federal motor carrier registrations); 49 U.S.C. § 41110 (authorizing agency to revoke erroneously issued air carrier certificates); 49 U.S.C. § 4709 (authorizing agency to revoke erroneously issued airman certificates).

Indeed, IPRs fall squarely into the continuum of the PTO's consideration of the patentability question by way of original examination and re-examination. The Patent Act does not provide different patentability tests for different classes of patent applicants. Likewise, the Patent Act does not define different standards for assessing patentability over prior art patents and publications based on how those patents or publications come to the PTO's attention. Instead, Congress directed that all patents, regardless of owner, issued by the PTO (after a specific date) are potentially subject to subsequent review by the PTO. Tribes have no claim to immunity from this generally-applicable process.

V. PTAB STATE IMMUNITY RULINGS ARE NOT CONTROLLING.

Prior cases addressing state immunity do not change the conclusion that tribes are subject to the AIA and that the PTO therefore is authorized to review tribe-owned patents in the AIA's IPR process. *See generally Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.*, IPR2016-01914, Paper No. 36 (PTAB July 13, 2017); *NeoChord Inc. v. Univ. of Md.*, IPR2016-00208, Paper No. 28 (PTAB May 23, 2017); *Covidien LP v. Univ. of Fla. Res. Foundation Inc.*, IPR2016-01274, Paper No. 21 (PTAB Jan. 25, 2017).

Unlike tribes, states enjoy constitutional immunity. Whatever may be said about state sovereign immunity in an IPR, tribal immunity is a judge-made doctrine that Congress is free to abrogate without concern with constitutional

limits, and it can and does do so by enacting statutes of general applicability. *See Tuscarora*, 362 U.S. at 556; *Plains Commerce Bank v. Long Family Land*, 554 U.S. 316, 337 (2008). As explained above, Congress did just that in the case of the AIA.

VI. BY PARTICIPATING IN DISTRICT COURT LITIGATION, A TRIBE WAIVES ANY CONCEIVABLE IMMUNITY.

Although the Saint Regis Mohawk Tribe did not initiate the pending infringement litigation concerning the patents at issue in this IPR, it has joined that litigation and as such is pursuing infringement claims.⁶ The Tribe cannot have it both ways. By enforcing patent rights in federal district court, a tribe necessarily accepts the legal framework governing patents—including all defenses and related procedures that might result in the cancellation of patent rights.

Tribal efforts to restrict non-member activities using the federal patent right subjects the tribe to the same laws as any other entity attempting to impose such restrictions. Although a waiver of tribal immunity—if any exists—must be clear and unambiguous, purposely seeking recovery of damages or an injunction on a patent under the Patent Act in federal district court manifests just such a waiver. *See Vas-Cath, Inc. v. Curators of Univ. of Mo.*, 473 F.3d 1376, 1383–84 (Fed. Cir. 2007) (“The University’s recourse to the PTO tribunal for adjudication of its claim

⁶ *Allergan, Inc. v. Teva Pharm. USA, Inc.*, 2017 WL 4619790 (E.D. Tex. Oct. 16, 2017) (Bryson, J., by designation).

of prior inventorship and thus of patent ownership negates the assertion of immunity to bar appeal of that adjudication. Principles of fairness and consistency prohibit selective assertion of immunity to avoid appeal by the loser after the University won the first round.”).⁷

VII. CONCLUSION

For the foregoing reasons, BSA respectfully requests that the PTAB determine that patents owned by tribes are subject to the IPR process established in the AIA to the same extent as patents owned by other parties.

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⁷ Those principles of fairness apply with special force where purported tribal immunity is, in effect, being leased out as part of a litigation strategy. “Sovereign immunity should not be treated as a monetizable commodity that can be purchased by private entities as part of a scheme to evade their legal responsibilities.” *Allergan*, 2017 WL 4619790, at *3.

CERTIFICATE OF SERVICE

I hereby certify that on this 1st day of December, 2017, a copy of the foregoing **Brief Of BSA | The Software Alliance As *Amicus* Regarding Applicability Of Tribal Sovereign Immunity In IPR Proceedings**, has been served by electronic mail on the following counsel of record:

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