

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

Denying Request for Oral Hearing and Denying Renewed Request for
Authorization to File Motion for Additional Discovery
37 C.F.R §§ 42.5, 42.70(a), 42.51

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)

On January 2, 2018—without authorization—the Saint Regis Mohawk Tribe (“the Tribe”) filed a Request for Oral Hearing purportedly pursuant to 37 C.F.R. § 42.70(a) in each of the above-identified proceedings “regarding [the Tribe’s] request for discovery into the identity and impartiality of the merits panel assigned to this case.” Paper 122 (“Request”).² Because the Tribe’s request is improper for a number of reasons, the Tribe’s request is denied.

37 C.F.R. § 42.70(a) states “[a] party may request oral argument on an issue raised in a paper at a time set by the Board.” The Tribe’s request for discovery has not been raised in any paper filed with the Board. It is, therefore, not an issue that can be addressed at oral argument under this rule.

Moreover, the Scheduling Order in these proceedings states: “Each party must file any request for oral argument (37 C.F.R. § 42.70(a)) by DUE DATE 4.” Paper 10, 3. Due Date 4 occurred on July 20, 2017, at which time both parties filed a request for oral argument. Paper 47 (Patent Owner); Paper 48 (Petitioners). The panel granted the parties’ requests on August 1, 2017. Paper 56. Thus, even if the Tribe’s request were proper, the time for requesting an oral argument pursuant to the Scheduling Order has passed.

Given its request is not contemplated by our rules or our Scheduling Order, the Tribe was required to seek prior authorization to file its paper. *See* 37 C.F.R. § 42.20(a), (b). Although the Tribe had an outstanding request for a telephone conference this week to discuss the issues raised in

² Paper numbers and exhibits 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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IPR2016-01131 (8,648,048 B2); IPR2016-01132 (9,248,191 B2)

its Request (Ex. 2116), counsel for the Tribe ignored our rules (once again³) and preemptively filed its paper. To assist the Tribe in complying with our rules, the Tribe shall not file any further papers in these proceedings without prior authorization from the Board.

Although we may expunge the Tribe’s Request as unauthorized (*see* 37 C.F.R. § 42.7(a)), we decline to do so to ensure the record is clear regarding why we deny not only the Request for Oral Hearing, but the Tribe’s request for authorization to file a motion for additional discovery, as well. We deny the Tribe’s latter request, because it far exceeds the scope of permissible discovery in these proceedings.

The Tribe relies on 37 C.F.R. § 42.51 to seek additional discovery. But that rule is limited to additional discovery between the parties. 37 C.F.R. § 42.51 (“Where the *parties* fail to agree, a party may move for additional discovery.”) (emphasis added). As is evident from its list of proposed discovery topics (Request 4–6), the Tribe seeks discovery from the Board, not from Petitioners. The Board, however, is not a “party” to these proceedings. *See* 37 C.F.R. § 42.2 (defining “party” to include petitioner and patent owner). Discovery from the Board is, therefore, not contemplated by our rules for *inter partes* review proceedings, and the Tribe has not pointed us to any legal authority that suggests otherwise. Accordingly, the Tribe’s request for authorization to file a motion for additional discovery can be denied for this reason alone.

³ As counsel for the Tribe admits, the Board “has previously admonished the Tribe’s counsel for including legal arguments in its communications with the Board.” Ex. 2116.

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Nevertheless, the Tribe asserts that such discovery is in the “interests of justice” because it “concerns due process, the impartiality of the merits panel in this case, and whether political or third-party pressure has been asserted to reach an outcome inconsistent with the binding Supreme Court and Federal Circuit precedents.” *Id.* at 2. But nowhere has the Tribe offered anything other than gross speculation as to any of its assertions of alleged impartiality.⁴ See *Garmin Int’l, Inc. v. Cuzzo Speed Techs. LLC*, Case IPR2012-00001, Paper No. 26, slip op. at 6 (PTAB Mar. 5, 2013) (precedential) (“The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice.”). Seeking, for example, “[t]he methodology used to determine the annual bonuses (or other merits based compensation) for each member of our merits panel” and “[t]he annual reviews of all members of our merits panel” (*id.* at 6) serves no purpose in these proceedings and amounts to a fishing expedition that is a waste of our time and resources.

In light of the foregoing, the panel—whose identities have always been listed on the cover page of our decisions—denies the Tribe’s renewed request for authorization to file a motion for additional discovery. Having

⁴ We note the USPTO Rules of Professional Conduct state that “[a] practitioner shall not make a statement that a practitioner knows to be false or with reckless disregard as to its truth or falsity concerning the qualifications or integrity of a judge.” 37 C.F.R. § 11.802(a). Failure to abide by those rules amounts to professional misconduct and may justify disciplinary proceedings. 37 C.F.R. §§ 11.804, 11.901.

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considered this issue twice now, the Tribe shall not make any further requests for additional discovery directed to the Board in these proceedings.

As a final note, we caution counsel for the Tribe that failure to comply with an applicable rule or order, abuse of discovery, and abuse of process are all grounds for sanctions. 37 C.F.R. § 42.12(a)(1), (5), (6). We strongly advise counsel for the Tribe to review our rules and caution that any further actions that demonstrate a disregard for our process will not be tolerated. *See* 37 C.F.R. § 42.12(b).

ORDER

Accordingly, based on the foregoing, it is:

ORDERED that the Tribe's request for oral hearing is *denied*;

FURTHER ORDERED that the Tribe's renewed request for authorization to file a motion for additional discovery is *denied*;

FURTHER ORDERED that the Tribe shall not make any further requests for additional discovery directed to the Board in these proceedings;

FURTHER ORDERED that the Tribe shall not file any further papers in these proceedings without prior authorization from the Board.

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