

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 and ALLERGAN, INC.,
Patent Owners.

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*.

PAULRAJ, *Administrative Patent Judge*.

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. This Order addresses issues that are the same in the identified cases. Paper numbers and exhibits cited in this Order refer to those documents filed in IPR2016-01127.

IPR2016-01127 (8,685,930 B2); IPR2016-01128 (8,629,111 B2);
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Allergan's Motion to Withdraw

Pursuant to our authorization, Allergan, Inc. (“Allergan”) filed a motion to withdraw from these proceedings. Paper 126 (“Motion” or “Mot.”). Petitioners filed an opposition to Allergan’s Motion. Paper 128 (“Opposition” or “Opp’n”).

Allergan seeks to withdraw from these proceedings on the grounds that it has ceased to be an owner of the six patents involved in these proceedings in view of its agreements with the Saint Regis Mohawk Tribe (“the Tribe”). Mot. 4–5. Petitioners contend that the “ownership question, however, is a fundamental dispute that has been extensively briefed in connection with the Tribe’s pending Motion to Dismiss.” Opp’n 1. Petitioners further contend that Allergan is at least a joint owner as a result of the agreements with the Tribe, and that Allergan has already taken all actions authorized to be taken by the patent owner under our rules and governing statute. *Id.* at 2–3. Additionally, Petitioners contend that Allergan’s request to withdraw should be construed as an abandonment of these proceedings, and thus a request for adverse judgement under 37 C.F.R. § 42.73(b)(4). *Id.* at 4–5.

As set forth in our Decision Denying the Tribe’s Motion to Terminate, we determine that Allergan remains an effective “patent owner” of the challenged patents in these proceedings based on the terms of its License Agreement with the Tribe. Paper , 18–34. Accordingly, we find that the basis for Allergan’s request to withdraw does not hold true. We decline, however, to construe the request to withdraw as a request for adverse judgment insofar as the ownership question was not settled at the time

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Allergan filed its Motion. In this regard, we recognize that the Tribe may still claim an ownership interest in the challenged patents in a subsequent appeal to the Federal Circuit. In order to allow the Tribe to represent its interests in these proceedings before the Board and in any appeals, we will allow the Tribe to continue participating as a patent owner along with Allergan. Allergan and the Tribe shall coordinate their efforts going forward, and shall file joint papers in these proceedings unless otherwise authorized by the Board. The caption for this Order and subsequent orders and decisions in these proceedings will reflect both Allergan's and the Tribe's status as the named "Patent Owners."

Remaining Schedule

In view of our Decision Denying the Tribe's Motion to Terminate, we will resume the schedule for these proceedings and proceed to a final written decision. The parties had previously submitted requests for oral hearing pursuant to 37 C.F.R. § 42.70(a). Papers 47 and 48. Accordingly, an oral hearing has been tentatively scheduled for April 3, 2018. Within five (5) business days after entry of this Order, the parties shall meet and confer and notify the Board via email whether this hearing date is acceptable to the parties or, if not, the parties shall provide the Board with several mutually acceptable dates for a hearing. Any proposed hearing dates shall be no later than April 6, 2018. We will consider the proposed hearing dates and enter a revised Hearing Order with the new date for the hearing, subject to the availability of hearing rooms at the Board.

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In order to provide ourselves with sufficient time to consider the arguments presented, we will also adjust the time to enter our final written decisions in these proceedings to June 6, 2018.

ORDER

Accordingly, based on the foregoing, it is:

ORDERED that Allergan's Motion to Withdraw is *denied*;

FURTHER ORDERED that the Tribe may continue participating as a patent owner along with Allergan. Allergan and the Tribe shall coordinate their efforts going forward, and shall file joint papers in these proceedings unless otherwise authorized by the Board. The caption for these proceedings shall reflect both Allergan's and the Tribe's status as "Patent Owners";

FURTHER ORDERED that an oral hearing has been tentatively scheduled for April 3, 2018;

FURTHER ORDERED that within five (5) business days after entry of this Order, the parties shall meet and confer and notify the Board via email whether April 3, 2018, is acceptable to the parties for a hearing, or, if not, the parties shall provide the Board with several mutually acceptable dates for a hearing no later than April 6, 2018; and

FURTHER ORDERED that the time to enter final written decisions in these proceedings is adjusted to June 6, 2018.

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