

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

MYLAN PHARMACEUTICALS INC., TEVA PHARMACEUTICALS
USA,
INC., and AKORN INC.¹
Petitioners,

v.

ALLERGAN, INC.,
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)

**PATENT OWNER'S SUPPLEMENTAL BRIEF ON
LITIGATION WAIVER**

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 IPR2017-00601., have respectively been
joined with the captioned proceedings. The word-for-word identical page is filed in
each proceeding identified in the caption pursuant to the Board's Scheduling Order
(Paper 10).

The Board's rulings in *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186 (Paper 14) ("*Ericsson*") and *LSI Corp. v. Regents of the University of Minnesota*, IPR2017-01068 (Paper 19) are wrongly decided. "Immunity encompasses not merely whether [a sovereign] may be sued, but where it may be sued," even when multiple forums are available. *Pennhurst State Sch. & Hosp. v. Halderman*, 465 U.S. 89, 99 (1984).

Mylan contends the IPR is the same as a "mirror-image" counterclaim, which in some circumstances, can be asserted against a tribe. When filing suit, a tribe does not waive immunity, even to compulsory counterclaims. *Okla. Tax Comm'n v. Citizen Band Potawatomi Indian Tribe of Okla.*, 498 U.S. 505, 509 (1991); *United States v. U. S. Fid. & Guar. Co.*, 309 U.S. 506, 513 (1940) ("Possessing ... immunity from direct suit, we are of the opinion [the Indian nations] possess a similar immunity from cross-suit.").

A mirror-image claim means exactly that—matters that must be resolved and are presumed to be at issue in a case based on the claims of the tribe. "Having placed a question before the court, a sovereign acknowledges the court's authority to resolve that question, whether in favor of the sovereign or in favor of a counterclaimant seeking the opposite resolution." *Tohono O'odham Nation v. Ducey*, 174 F.Supp.3d 1194, 1204 (D. Az. 2016). "A tribe's waiver of sovereign immunity may be limited to the issues necessary to decide the action brought by

the tribe; the waiver is not necessarily broad enough to encompass related matters, even if those matters arise from the same set of underlying facts.” *McClendon v. United States*, 885 F.2d 627, 630 (9th Cir. 1989).

This IPR does not fall within the mirror-image counterclaim exception. IPRs are not counterclaims. *Ericsson* at 8 n.4. Resolution of the district court case does not rely upon resolution of the IPR claims. EX. 1165. An IPR is a separate proceeding that can be filed whether or not a district court action is filed, and it presents legal questions that are different than a counterclaim in the district court. *Ericsson* at 11. Thus, waiver cannot extend from one proceeding to another. *Biomedical Patent Management Corp. v. California Dept. of Health Services*, 505 F.3d 1328, 1339-40 (Fed. Cir 2007) (proceeding not continuous so as to apply waiver in each forum). And even if the two proceedings are related, there is a bright-line rule for tribes: “[P]articipation in an administrative proceeding does not waive tribal immunity in an action filed by another party seeking review of the agency’s decision.” *Kescoli v. Babbitt*, 101 F.3d 1304, 1310 (9th Cir. 1996); *Quileute Indian Tribe v. Babbitt*, 18 F.3d 1456, 1459–60 (9th Cir.1994). See also *Contour Spa at the Hard Rock v. Seminole Tribe of Florida*, 692 F.3d 1200, 1208-1209 (11th Cir. 2012) (adhering to *Potowatomi*, rejecting application of *Lapides* to tribes); *Bodi v. Shingle Springs Band of Miwok Indians*, 832 F.3d 1011, 1017 (9th Cir. 2016) (same). Thus, the Board’s *Ericsson* “logic” cannot apply here.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on January 12, 2018, a complete and entire copy of *Patent Owner's Supplemental Brief on Litigation Waiver* was provided, via electronic service, to the Petitioners by serving the correspondence address of record as follows:

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