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.

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)

BRIEF *AMICI CURIAE* OF THE NATIONAL CONGRESS OF AMERICAN INDIANS, NATIONAL INDIAN GAMING ASSOCIATION, AND THE UNITED SOUTH AND EASTERN TRIBES IN SUPPORT OF PATENT HOLDER THE ST. REGIS MOHAWK TRIBE'S MOTION TO DISMISS

---

[1] Cases IPR2017-00576 and IPR2017-00594, IPR2017-00578 and IPR 2017-00596, IPR2017-00579 and IPR2017-00598, IPR2017-00583 and IPR2017-00599, IPR2017-00585 and IPR 2017-00600, and IPR2017-00586 and IPR2017-00601 have respectively been joined with the captioned proceedings. The word-for-word identical paper is filed in each proceeding identified in the caption pursuant to the Board's Scheduling Order.

TABLE OF CONTENTS

TABLE OF AUTHORITIES

CASES

CONSTITUTIONS

STATUTES

LEGISLATIVE MATERIALS

OTHER AUTHORITIES

INTEREST OF *AMICI CURIAE*

The National Congress of American Indians (NCAI), National Indian Gaming Association (NIGA), and the United South and Eastern Tribes (USET) are leading Native American organizations that share an interest in protecting Tribal self-government and self-sufficiency. NCAI is the oldest and largest American Indian organization in the United States, representing more than 250 Indian Tribes and Alaska Native villages. NCAI's mission includes informing the public and all branches of the federal government about tribal self-government, treaty rights, and a broad range of federal policy issues affecting Tribal governments. NIGA is a non-profit organization with 168 member Tribes that authorize and operate Tribal casinos. NIGA endeavors to assist Tribes in their efforts to build and maintain strong and self-sufficient Tribal governments, and to support Tribal governments in pursuing all forms of economic opportunity to provide a better quality of life for their citizens. USET is an intertribal organization comprised of 27 federally-recognized Indian Tribes in the southern and eastern United States. USET works to educate federal, state, and local governments about the unique historical and political status of its member Tribes.

Pursuant to the Patent Trial and Appeal Board's Order, 2017 WL 5067421 (P.T.A.B. Nov. 3, 2017), *amici* submit this brief to assist the Board in understanding the doctrine of tribal sovereign immunity from suit, and that

doctrine's commonalities with the immunity from suit of the federal, state and foreign governments. Absent contrary direction from Congress, the doctrine and its concomitant principles and rules should govern the Board's analysis of tribal sovereign immunity in this *inter partes* review (IPR) proceeding; however, because new guidance on IPR likely is forthcoming from the Supreme Court, and possibly from Congress, the Board should strongly consider awaiting that guidance before addressing the issue of tribal sovereign immunity in this proceeding

ARGUMENT

I. FEDERAL, STATE, TRIBAL, AND FOREIGN SOVEREIGN IMMUNITY FROM SUIT SHARE THE SAME COMMON LAW ORIGIN AND GENERAL RULES OF INTERPRETATION

A. The Shared Common Law Origin

Neither federal nor state sovereign immunity from suit is derived from the U.S. Constitution. Such sovereign immunity is rooted in the English common law of the Middle Ages, which recognized as settled doctrine that the King could not be sued *eo nomine* in his own courts. *See* Louis L. Jaffee, *Suits Against Governments and Officers: Sovereign Immunity*, 77 HARV. L. REV. 1, 2 (1963).

Although the United States' Founders rejected the King, they nevertheless considered immunity from suit without consent to be "inherent in the nature of sovereignty." ALEXANDER HAMILTON, THE FEDERALIST NO. 81, 548-49 (Jacob E. Cooke ed., 1961). This axiomatic understanding – not the Constitution – guided the

Supreme Court's earliest sovereign immunity cases, forming the common law in this country applicable to all sovereigns: federal, state, tribal, and foreign.

An early announcement of federal sovereign immunity by the Court was in *United States v. McLemore*, which held – as a fundamental principle, without citation to any authority – that "[t]here was no jurisdiction of this case in the Circuit Court, as the government is not liable to be sued, except with its own consent, given by law." 45 U.S. 286, 288 (1846). Four years later, the Court again cited no authority when it announced, "No maxim is thought to be better established, or more universally assented to, than that which ordains that a sovereign, or a government representing the sovereign, cannot *ex delicto* be amenable to its own creatures or agents employed under its own authority for the fulfillment merely of its own legitimate ends." *Hill v. United States*, 50 U.S. 386, 389 (1850). Thereafter, the Court routinely has treated sovereign immunity as an established doctrine. *E.g.*, *United States v. Mitchell*, 463 U.S. 206, 212 (1983) ("It is axiomatic that the United States may not be sued without its consent and that the existence of consent is a prerequisite for jurisdiction").

Likewise, early articulations of state sovereign immunity by the Court treated it as an accepted legal principle, not one derived from the Constitution. The first time the Court relied on state sovereign immunity to dismiss a suit, it did not find it necessary to identify any authority for the doctrine. "The … general

proposition [is] that a sovereign independent State is not suable, except by its own consent. This general proposition will not be controverted." *Cohens v. Virginia*, 19 U.S. 264, 380 (1821) (Marshall, C.J. delivering the opinion of the Court). Thus, immunity from suit for federal and state governments is an underlying legal assumption – a recognition that it is a fundamental, inherent aspect of sovereignty. *See Alden v. Maine*, 527 U.S. 706, 713 (1999).

Foreign governments also generally possess common law immunity in the United States (although Congress can and has acted to abrogate it in particular circumstances). The Court recognized this rule in *The Schooner Exchange v. McFadden*, and relied on principles for diplomatic immunity and national dignity, holding simply that "the whole civilized world concurred" in these principles. 11 U.S. 116, 137 (1812) (Marshall, C.J. delivering the opinion of the Court). The Court "offered no explanation for these principles beyond the 'perfect equality and absolute independence of sovereigns' and a 'common interest impelling them to mutual intercourse.'" William Wood, *It Wasn't an Accident: the Tribal Sovereign Immunity Story*, 62 AM. U. L. REV. 1587, 1612 (2013).

Tribal sovereign immunity from suit shares these same common law origins. As "separate sovereigns pre-existing the Constitution," *Michigan v. Bay Mills Indian Cmty.*, 134 S. Ct. 2024, 2030 (2014) (Kagan, J., delivering the opinion of the Court) (citation omitted), and expressly recognized in the Constitution, Indian

tribes were understood to be "among the family of sovereigns" – nations with their own governments and laws, capable of entering into treaties with the United States. Wood, *supra*, at 1611. "Indian tribes are domestic dependent nations that exercise inherent sovereign authority." *Michigan*, 134 S. Ct. at 2030 (internal quotations and citations omitted). A core aspect of this sovereignty is the "common-law immunity from suit traditionally enjoyed by sovereign powers." *Id.* (citation omitted). Although at times it has voiced policy concerns, the Court has recognized and upheld tribal sovereign immunity for "well over a century," *Michigan*, 345 S. Ct. at 2040 (Sotomayor, J., concurring), *citing*, *inter alia*, *Parks v. Ross*, 52 U.S. 362 (1850), as "a necessary corollary to Indian sovereignty and self-governance." 345 S. Ct. at 2030 (citations omitted).[2]

[2] The Court's observation that tribal sovereign immunity from suit arose "almost by accident," *Kiowa Tribe of Okla. v. Mfg. Technologies, Inc.*, 523 U.S. 751, 756 (1998), echoes the Court's earlier observation about federal and state sovereign immunity. "[W]hile the exemption of the United States and of the several states from being subjected as defendants to ordinary actions in the courts has . . . been repeatedly asserted here, the principle has never been discussed or the reasons for it given, but it has always been treated as established doctrine." *United States v. Lee*, 106 U.S. 196, 207 (1882) (citations omitted). Thus, any possible arguments against sovereign immunity's origins are applicable equally to all governments.

Nor does the Eleventh Amendment elevate state sovereign immunity over tribal sovereign immunity. The Court has made clear that state sovereign immunity does not derive from the Eleventh Amendment, but is a fundamental aspect of sovereignty that states enjoyed before ratification of the Constitution. *Alden*, 527 U.S. at 713. The Court's observation regarding tribal sovereign immunity is similar: "As separate powers pre-existing the Constitution, tribes have historically been regarded as unconstrained by those constitutional provisions framed specifically as limitations on federal or state authority … [and] tribes have long been recognized as possessing the common-law immunity from suit traditionally enjoyed by sovereign powers." *Santa Clara Pueblo v. Martinez*, 436 U.S. 49, 56, 58 (1978); *see also Blatchford v. Native Village of Noatak*, 501 U.S. 775, 782 (1991) ("We have repeatedly held that Indian tribes enjoy immunity against suits by States as it would be absurd to suggest that the tribes surrendered immunity in a convention to which they were not even parties") (citation omitted).[3]

In sum, tribal sovereign immunity from suit stands on an equal footing with the immunity from suit of other sovereigns. The law long ago recognized immunity

[3] Further, the Constitution does not mention the Federal government's immunity from suit. Thus, any reliance on the Eleventh Amendment to buttress a perceived weakness in authority for tribal sovereign immunity also undermines federal sovereign immunity and elevates State sovereignty above the federal government.

from suit as a fundamental aspect of sovereignty. Our domestic law recognizes federal, state, and tribal governments as sovereigns, and our courts likewise acknowledge their immunity from suit relying on commonly understood legal principles applicable equally to all sovereigns.

B. The General Rules Of Interpretation

Just as the doctrinal origins of sovereign immunity from suit are the same for federal, state, tribal and foreign governments, absent contrary direction from Congress, the general rules for interpreting such immunity are the same for all governments. These rules include those for determining the immunity's scope, and whether the immunity has been waived or abrogated.

1. Scope of Immunity

Sovereign immunity from suit applies not just to a government itself, but also to arms of the government. *See F.D.I.C. v. Meyer*, 510 U.S. 471, 475 (1994) (federal agencies are entitled to sovereign immunity unless waived by Congress); *see also Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 630-635 (1999) (state instrumentalities are entitled to sovereign immunity unless such immunity is waived or abrogated); *Allen v. Gold Country Casino*, 464 F.3d 1044, 1046 (9th Cir. 2006) (tribal sovereign immunity extends to arms, agencies, and subdivisions of the tribe) (citations omitted).

Sovereign immunity from suit applies to a government's commercial entities and conduct. This is true for the federal government, *see, e.g., Larson v. Domestic & Foreign Commerce Corp.*, 337 U.S. 682, 704 (1949); states, *see, e.g.*, *Parden v. Terminal Ry. of the Ala. State Docks Dep't*, 377 U.S. 184, 185-188 (1964), *overruled on other grounds*, *Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. at 680; tribes, *see e.g., Kiowa Tribe*, 523 U.S. at 754-55, 760; and, foreign governments, *see, e.g.*, *Berizzi Bros. Co. v. The Pesaro*, 271 U.S. 562, 569-70, 574 (1926).

Sovereign immunity from suit applies not only in courts, but also in federal administrative fora at least with respect to claims brought by private parties. *See Fed. Maritime Comm'n v. S.C. State Ports Auth.*, 535 U.S. 743, 760 (2002) ("state sovereign immunity bars the [Commission] from adjudicating complaints filed by a private party against a nonconsenting State"); *accord Vas-Cath, Inc. v. Curators of the Univ. of Mo.*, 473 F.3d 1376, 1380-1384 (Fed. Cir. 2007) (state's entitlement to sovereign immunity waived by state with regard to patent at issue by initiating an action before the Patent and Trademark Office); *see also Nat'l Labor Relations Bd. v. Fortune Bay Resort Casino*, 688 F. Supp. 2d 858, 871 (D. Minn. 2010) (in federal agency proceeding, distinguishing tribal sovereign immunity from suit *vis-à-vis* claims by the federal government from claims by private litigants).

2. Immunity Waivers and Abrogation

"A waiver of the Federal Government's sovereign immunity must be unequivocally expressed in statutory text and will not be implied." *Lane v. Pena*, 518 U.S. 187, 192 (1996) (citations omitted). "Moreover, a waiver of the Government's sovereign immunity will be strictly construed, in terms of its scope, in favor of the sovereign." *Id.* (citation omitted). These rules apply equally to waivers of state and tribal sovereign immunity. *Sossamon v. Texas*, 563 U.S. 277, 285 (2011) (state sovereign immunity); *C & L Enterprises v. Citizen Band Potawatomi Tribe of Okla.*, 532 U.S. 411, 418 (2001) (tribal sovereign immunity).

A common way that all three governments waive their immunity in a general fashion is through torts claims acts. *See, e.g.*, Federal Tort Claims Act, 28 U.S.C. §§ 2671-2680; National Conference of State Legislatures, *State Legislation Concerning State Liability and Sovereign Immunity* (2010), http://www.ncsl.org/documents/transportation/StateImmunityLeg0810.pdf (summary of state tort claims acts); *Wilson v. Umpqua Indian Dev't Corp.*, 2017 WL 2838463 (D. Or. June 29, 2017) (discussing tribal tort claims code); *accord Sault Ste. Marie Tribe of Chippewa Indians*, 2017 WL 1505329 (W.D. Mich. Apr. 27, 2017). Governments also routinely waive immunity in specific contracts and business transactions. *See, e.g., C & L Enters.*, 532 U.S. at 418-19 (tribal immunity waived in construction contract).

In addition to immunity waivers, Congress possesses the authority to abrogate tribal, state, and foreign sovereign immunity. For example, Congress has abrogated foreign sovereign immunity for suits arising from specific types of activity in the Foreign Sovereign Immunities Act of 1976. 28 U.S.C. §§ 1330, 1332, 1391(f), 1441(d), 1602-1611.

In limited circumstances, Congress may abrogate state sovereign immunity, but it must state its intention to do so expressly and unambiguously. *See Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 238, 242 (1985) (Congress may abrogate state sovereign immunity pursuant to Section 5 of the Fourteenth Amendment, "only by making its intention unmistakably clear in the language of the statute"). Similarly, Congress may abrogate tribal sovereign immunity; however, such abrogation "cannot be implied, but must be unequivocally expressed." *Santa Clara Pueblo*, 436 U.S. at 58; *accord C & L Enters.*, 532 U.S. at 418.

Importantly, because abrogation of tribal sovereign immunity from suit involves a careful balancing of interests and policy, the Court consistently has left such balancing to Congress. *See Kiowa Tribe*, 523 U.S. at 760. Equally important, overall, Congress has taken a careful and considered approach to this task. Since at least 1891, Congress has enacted specific abrogations of tribal sovereign immunity in a variety of contexts, including certain property claims, specific types

of Indian gaming disputes, and particular federal environmental laws. *See* COHEN'S HANDBOOK OF FEDERAL INDIAN LAW §7.05(1)(b) (Nell Jessup Newton ed., 2012). But sweeping abrogations of tribal sovereign immunity, *e.g.*, S. 2299, 105th Cong., 2nd Sess. (1998); S. 2302, 105th Cong., 2nd Sess. (1998), have been rejected in favor of more measured and specific decisions which "reflect Congress' desire to promote the goal of Indian self-government, including its overriding goal of encouraging tribal self-sufficiency and economic development." *Okla. Tax Comm'n v. Citizen Band Potawatomi Indian Tribe of Okla.*, 498 U.S. 505, 510 (1991) (citations and internal quotations omitted). The fact that Congress repeatedly has chosen not to enact a general tribal sovereign immunity from suit waiver shows Congress' consistent treatment of that immunity on a par with such immunity of other governments.

II. BECAUSE THERE IS NO WAIVER OR ABROGATION APPLICABLE HERE, THE TRIBE IS IMMUNE FROM SUIT

Under the well-established parity of tribes with other governments regarding the origin of and rules of interpretation for immunity from suit, the Tribe here is immune from suit. Essentially, the analysis of an assertion of sovereign immunity by a tribe in an IPR is no different than for such an assertion by a state. As one U.S. Court of Appeals recently aptly and succinctly held, in determining questions of sovereign immunity, "Indian tribes as sovereign entities …are entitled to the

same interpretive presumption[s] as States." *United States ex rel. Cain v. Salish Kootenai College, Inc.*, 862 F.3d 939, 942-943 (9th Cir. 2017).

Thus, the Tribe's immunity here is presumed, based on its sovereignty. *See Seminole Tribe of Fla. v. Florida*, 517 U.S. 44, 85 (2006) (Stevens, J, dissenting) (discussing "the common-law presumption of sovereign immunity" as set forth in *Hans v. Louisiana*, 134 U.S. 1 (1890)). The burden is on the party challenging the immunity to show either a waiver or an abrogation by Congress or the tribe, and such waiver or abrogation must be express and unequivocal. *Amerind Risk Mgmt Corp. v. Malaterre*, 633 F.3d 680, 685-686 (8th Cir. 2011). Absent the requisite express and unequivocal waiver, the tribe is immune from suit. *Dawavendewa v. Salt River Project Ag. Improvement and Power Dist*., 276 F.3d 1150, 1159 (9th Cir. 2002).

While an assertion of immunity from suit by a tribe in an IPR may be a novel issue, it is in accord with the natural course of events in the larger picture. Absent prohibition by Congress, tribes, like other governments, have ventured into the intellectual property arena for many of the same political, social and economic reasons as other governments. *See generally* Sharon K. Sandeen, *Preserving the Public Trust in State-Owned Intellectual Property: A Recommendation for Legislative Action*, 32 McGeorge L. Rev. 385, 395 (2001) ("states can and do own intellectual property rights in various forms"). States "enjoy the benefits of

[intellectual property] laws … and have a strong public policy interest in preventing" infringement, dilution, and other violations of the rights they hold under such laws. *Id*. at 389.

Tribal governments today hold trademarks as do the federal, state and foreign governments. *See Shingle Springs Band of Miwok Indians v. Caballero*, 630 Fed. App'x. 708 (9th Cir. 2015) (tribe owns trademarks registered under the Lanham Act, 15 U.S.C. §§ 1051-1141n); s*ee generally* Joseph A. Larson, *Taming the Wild West: An Examination of Private Student Consolidated Companies' Violations of § 43(A) of the Lanham Act by Using Trade Names and Logos that Closely Resemble Those Used by the United States Department of Education*, 41 Creighton L. Rev. 515 (2008); Sandeen, *supra*, at 410 (discussing state-owned trademarks); *Fed. Treasury Enter. Sojuzplodoimport v. SPI Spirits Ltd.*, 726 F.3d 62 (2nd Cir. 2013) (Russian government chartered entity holds Lanham Act registered trademark for vodka).

Tribal governments hold copyrights, as do other governments. *See Tuolumne Band of Me-Wuk Indians v. Baca*, No. 03-6363 (E.D. Cal. Feb. 14, 2005) (stipulation and order entering a permanent injunction against defendant based on tribe's copyright claims under federal and state law to its traditional songs and dances); *United States v. Washington Mint, LLC*, 115 F.Supp.2d 1089 (D. Minn. 2000) (under the Copyright Act, 17 U.S.C. §§ 101-1332, federal government

held valid copyright in coin design assigned to it by private citizen who created it); *Cty. of Suffolk v. First Am. Real Estate Solutions*, 261 F.3d 179, 187 (2nd Cir. 2001) (states may hold copyrights under the Copyright Act).

While patent holdings by tribes may be relatively more recent, they are preceded by considerable and increasing holdings of patents by states and their entities. *See generally* Tejas N. Narechania, *An Offensive Weapon?: An Empirical Analysis of the "Sword" of State Sovereign Immunity in State-Owned Patents*, 110 Colum. L. Rev. 1574 (2010). They also post-date uniform decisions by lower courts that, under the typical rules of sovereign immunity interpretation applicable to all governments, tribes are immune from suit in claims of patent infringement. *See, e.g.*, *Microlog Corp. v. Cont'l Airlines*, 2011 WL 13141413 (E.D. Tex. July 22, 2011); *Specialty House of Creation, Inc. v. Quapaw Tribe of Okla.*, 2011 WL 308903 (N.D. Okla. Jan. 27, 2011); *The Home Bingo Network v. Multimedia Games, Inc.*, 2005 WL 2098056 (N.D.N.Y. Aug. 30, 2005); *see also* Robert A. Matthews, Jr., 5 *Annotated Patent Digest* § 36:192 (2017) (immunity recognized for Indian tribes); Eric M. Dobrusin and Katherine E. White, *Intell. Prop. Litig.: Pretrial Prac*. § 2.05[A] at n.258 (3rd ed. 2017) (patent infringement claim defenses include tribal sovereign immunity from suit).

III. ALTERNATIVELY, BEFORE DECIDING THE TRIBAL SOVEREIGN IMMUNITY ISSUE IN THIS IPR, THE BOARD SHOULD AWAIT FORTHCOMING GUIDANCE FROM THE SUPREME COURT AND CONGRESS

Beyond the issue of the Tribe's immunity from suit in this IPR, IPRs generally are under active scrutiny by the Supreme Court and Congress. On November 27, 2017, the Court heard oral argument in *Oil States Energy Serv. v. Greene's Energy Grp.*, 639 Fed. App'x. 639 (Fed. Cir. 2016), *cert. granted*, 85 U.S.L.W. 3575 (U.S. June 12, 2017) (No. 16-712), on the issue of the Constitutional validity of IPRs. A decision from the Court is expected by the end of the Court's current term, *i.e.*, June 2018.

In addition, in June 2017, S. 1390, the STRONGER Patents Act of 2017, was introduced in Congress. 115th Cong., 1st Sess. (2017). This bill, which has been referred to the Senate Committee on the Judiciary, proposes, *inter alia*, reform of IPRs.[4] Presumably, further action on S. 1390 awaits the Court's decision in *Oil States Energy Serv*. The Board here should strongly consider adjusting its schedule so it can obtain guidance from the Court and possibly Congress on IPRs generally.

[4] In October 2017, S. 1948, "[a] bill to abrogate the sovereign immunity of Indian tribes as a defense in *inter partes* review of patents," also was introduced. 115th Cong., 1st Sess. (2017). While *amici* oppose S. 1948, it nevertheless supports *amici's* position that, absent the requisite abrogation or waiver, the Tribe here is immune from suit.

Dated: December 1, 2017

Respectfully submitted,

/Melody L. McCoy/
Melody L. McCoy
CO Bar No. 016960
NATIVE AMERICAN RIGHTS FUND
1506 Broadway
Boulder, CO 80302
Phone: (303) 447-8760
Fax: (303) 443-7776
mmccoy@narf.org

Joel West Williams
DC Bar No. 1023016
Daniel David Lewerenz
Wisconsin Bar No. 1069385
NATIVE AMERICAN RIGHTS FUND
1514 P Street, NW (Rear) Suite D
Washington, D.C. 20005
Phone: (202) 785-4166
Fax: (202) 822-0068
williams@narf.org
lewerenz@narf.org

Attorneys for Amici Curiae

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on December 1, 2017, a complete and entire copy in pdf version of *Brief of Amici Curiae of the National Congress of American Indians, National Indian Gaming Association, and the United South and Eastern Tribes in Support of Patent Holder the St. Regis Mohawk Tribe's Motion to Dismiss* was submitted, via electronic mail, to the Patent and Trademark Board for filing and service in the above referenced proceedings.

/Melody L. McCoy/

Melody L. McCoy
CO Bar No. 016960
NATIVE AMERICAN RIGHTS FUND
1506 Broadway
Boulder, CO 80302
Phone: (303) 447-8760
Fax: (303) 443-7776
mmccoy@narf.org

Council for Amici Curiae