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)

PATENT OWNER'S REQUEST FOR ORAL HEARING

[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. The word-for-word identical paper is filed in each proceeding identified in the caption pursuant to the Board's Scheduling Order (Paper 10).

Pursuant to 37 C.F.R. § 42.70(a), the Saint Regis Mohawk Tribe ("Patent Owner") requests an opportunity to present oral argument regarding Patent Owner's request for discovery into the identity and impartiality of the merits panel assigned to this case. EX. 2116.

Additional discovery is available under 37 C.F.R. § 42.51 if the moving party can show that it is "in the interests of justice." Here, the discovery sought by the Patent Owner 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. Due process concerns are by definition "in the interests of justice."

As the Federal Circuit has stated: "The indispensable ingredients of due process are notice and an opportunity to be heard by a disinterested decision-maker." *Abbott Labs. v. Cordis Corp.*, 710 F.3d 1318, 1328 (Fed. Cir. 2013). To that end, the Administrative Procedures Act, 5 U.S.C. § 554(d), prohibits members of a PTAB merits panel from being "subject to the supervision or direction of an employee or agent engaged in the performance of investigative or prosecuting functions for an agency." An Administrative Judge must have decisional independence that is "free from pressures by the parties or other officials within the agency." *Abrams v. Soc. Sec. Admin.*, 703 F.3d 538, 545 (Fed. Cir. 2012).

The Administrative Procedures Act also prohibits *ex parte* communications

with any member of a PTAB merits panel that is relevant to the merits of a proceeding. 5 U.S.C.A. § 557. If any such communications have occurred, they must be included in the public record of the administrative proceeding. This requires publication of all written communications, summaries of oral communications, and any internal memorandum concerning such communications.

Due process violations have been found (i) when an adjudicator has either a direct or indirect pecuniary interest in the outcome of the proceedings and (ii) when an administrative adjudication's outcome is influenced by political pressure. *Caperton v. A.T. Massey Coal Co.*, 556 U.S. 868, 878 (2009); *ATX, Inc. v. U.S. Dep't of Transp.*, 41 F.3d 1522, 1527 (D.C. Cir. 1994); *Pillsbury Co. v. F.T.C.*, 354 F.2d 952, 963–64 (5th Cir. 1966).

Both concerns are present here. Congress has expressed an interest in this specific case and held hearings concerning the proceedings. There is also a strong possibility that the merits panel has been expanded to include USPTO executives, including Chief Judge David Ruschke, a person who has made prior public comments on the issue of sovereign immunity and this case. EX. 2113. The USPTO, and its executive leadership, has a direct pecuniary interest in the outcome of this case because the Patent Owner's motion could have a non-trivial impact on the fees collected by PTAB for IPRs. There is also a strong possibility of interested parties (both political and private) that may be seeking to influence the outcome of

this case. If Chief Judge Ruschke has added himself to the merits panel as he did in the recent University of Minnesota decisions, any communications with Chief Judge Ruschke (or any other member of the merits panel) regarding sovereign immunity, the Patent Owner's relationship with Allergan, or efforts in Congress concerning the application of sovereign immunity in this case are prohibited by the Administrative Procedures Act and must be immediately disclosed. 5 U.S.C.A. § 557.

To address the Patent Owner's concerns about the impartiality of the merits panel, the Patent Owner requests discovery into the following topics:

- The makeup of the merits panel in these proceedings,
- The date each APJ was added to the panel in these proceedings,
- How the makeup of our merits panel was decided,
- Who determined the makeup of our merits panel,
- When that decision was made,
- The disclosure of all *ex parte* communications concerning our case, the Allergan/Tribe transactions, or sovereign immunity with any member of our merits panel, both before and after they were added to our merits panel,
- All communications members of our merits panel have had with Congress or the Executive Branch concerning our case or sovereign immunity,

- Communications our merits panel members have had with anyone concerning sovereign immunity or this proceeding prior to their addition to the panel,
- The assignment of Tina H. Hulse, Christopher Paulraj, Sheridan Snedden, David Ruschke, Scott Boalick, Jacqueline Bonilla, and Scott Weidenfeller to other IPR proceedings involving the Petitioners,
- The dates David Rushcke, Scott Boalick, Jacqueline Bonilla, and Scott Wedenfeller were added to the panels of IPR2017-01068 and IPR2017-01186,
- Ex parte communications with the merits panel in IPR2017-01068 and IPR2017-01186 concerning sovereign immunity or those proceedings,
- Communications David Ruschke, Scott Boalick, Jacqueline Bonilla, and Scott Weidenfeller had prior to joining the merits panel in IPR2017-01068 and IPR2017-01186 concerning sovereign immunity or that proceeding,
- Any communications concerning the opinions filed in IPR2017-01068 and IPR2017-01186, including the concurrence,
- Communications between Jacqueline Harlow and Jennifer Bisk concerning sovereign immunity or the motions to dismiss based on sovereign immunity in IPR2017-01068 and IPR2017-01186,

- Any policy determinations made by the USPTO or PTAB concerning sovereign immunity,
- The methodology used to determine the annual bonuses (or other merits based compensation) for each member of our merits panel,
- The annual reviews of all members of our merits panel, including the identification of the person who performs the review, the criteria used for the review, and the outcome of the review, and
- Materials related to any PTAB projections or predictions for IPR fees in 2018, including any potential for reductions in fee income if sovereign immunity were respected by PTAB or upheld on appeal.

The Patent Owner respectfully requests that this oral hearing take place prior to any decision on the Patent Owner's pending Motion to Dismiss. Paper 81.

Dated: January 2, 2018

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 2, 2018, a complete and entire copy of *Patent Owner's Request for Oral Argument* was provided, via electronic service, to the Petitioners by serving the correspondence address of record as follows:

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