

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

SAINT REGIS MOHAWK TRIBE,
Patent Owner.

Case IPR2018-01594 (Patent 6,434,687 B1)
Case IPR2018-01599 (Patent 6,076,152)
Case IPR2018-01600 (Patent 6,247,110 B1)
Case IPR2018-01601, IPR2018-01602, and IPR2018-01603
(Patent 7,225,324 B2)
Case IPR2018-01604 (Patent 7,421,524 B2)
Case IPR2018-01605, IPR2018-01606, and IPR2018-01607
(Patent 7,620,800 B2)¹

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Motion to
Extend Preliminary Response Deadlines
37 C.F.R. § 42.5(c)(2)

¹ This Decision addresses an issue pertaining to all ten cases. Therefore, we exercise our discretion to issue a single Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On November 23, 2018, we issued an Order authorizing Saint Regis Mohawk Tribe (“Patent Owner”) to submit a motion to stay these proceedings until the Supreme Court renders a decision on Patent Owner’s forthcoming petition for a writ of certiorari appealing the Court of Appeals for the Federal Circuit’s (“Federal Circuit”) decision in *Saint Regis Mohawk Tribe v. Mylan Pharms. Inc.*, Nos. 18-1638, 18-1639, 18-1640, 18-1641, 18-1642, and 18-1643 (“*Mylan*”). Paper 9,²³ 2–3 (citing 37 C.F.R. § 42.20(d)). Our Order further authorized Microsoft Corporation (“Petitioner”) to submit an opposition to Patent Owner’s motion to stay. *Id.* Patent Owner filed a Motion (Paper 11, “Mot.”) requesting that “the Board extend [Patent Owner’s] Preliminary Response deadlines in all of these proceedings until March 1, 2019 to see if the Supreme Court grants certiorari.” Mot. 1. Petitioner filed an Opposition (Paper 12, “Opp.”).

In *Mylan*, the Federal Circuit held that “tribal sovereign immunity cannot be asserted in IPRs.” Ex. 2006, 7. Patent Owner filed a petition for rehearing en banc, which the Court denied on October 22, 2018. Ex. 2021. Patent Owner also “move[d] to stay issuance of the Court’s mandate pending

² IPR2018-01599, IPR2018-01600, IPR2018-01601, IPR2018-01602, IPR2018-01603, IPR2018-01604, IPR2018-01605, IPR2018-01606, and IPR2018-01607 include similar papers, and accordingly all citations are to IPR2018-01594 unless otherwise noted.

³ Our initial Order (Paper 9) included a typographical error identifying a due date of January 15, 2018 for some of Patent Owner’s preliminary responses. We corrected this typographical error in a subsequent Order to reflect the correct due date of January 15, 2019. *See* Paper 13, 2.

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the filing and disposition of a petition for a writ of certiorari in the United States Supreme Court,” and the Court denied the motion on November 13, 2018. Ex. 2022. The mandate subsequently issued. Patent Owner states that it “will file a petition for a writ of certiorari that asks the Supreme Court to decide whether sovereign immunity may be asserted in *inter partes* reviews before the Patent Trial and Appeal Board,” and “intends to file the petition in mid-December if possible.” Mot. 3–4 & n.1.

Patent Owner argues that “sovereign immunity is a threshold issue that must be addressed before the IPR may proceed because tribal sovereign immunity is not merely a liability defense, it is an ‘immunity from suit’ that ‘is effectively lost if a case is erroneously permitted to go to trial.’” Mot. 5 (citing *Burlington Northern & Santa Fe Ry. Co. v. Vaughn*, 509 F.3d 1085, 1090 (9th Cir. 2007)). Patent Owner argues that “a stay will preserve the *status quo* while this important issue is decided,” and that Patent Owner “would be irreparably harmed if its Preliminary Response Deadline is not extended.” *Id.* at 6–7. Patent Owner contends that Petitioner would not be prejudiced by any delay because Petitioner argued in favor of a stay in the district court case where the patents challenged in these proceedings are being asserted, and previously was “willing to enter into a mutual stay of the IPRs.” *Id.* at 8 (quoting Ex. 2023). Accordingly, Patent Owner asserts that “[g]ood cause is present here” to extend the deadlines for Patent Owner’s preliminary responses under 37 C.F.R. § 42.5(c)(2), and the Federal Circuit denial of Patent Owner’s motion to stay in *Mylan* is not controlling because

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“the standard to stay a mandate and the standard to extend the deadline for a Patent Owner’s Preliminary Response are not the same.” *Id.* at 8–9.

Petitioner opposes Patent Owner’s motion to stay. Opp. 5. Petitioner argues that Patent Owner’s assertion of sovereign immunity has been heard and rejected, and “[t]he status quo is that [Patent Owner’s] tribal sovereign immunity does not apply in an IPR.” *Id.* at 5–7. Accordingly, Petitioner argues that good cause to extend the preliminary response deadlines does not exist. *Id.* at 7. Petitioner further argues that Patent Owner presented the same arguments to the Federal Circuit to demonstrate good cause for a stay of the mandate in *Mylan* and the Federal Circuit denied Patent Owner’s motion. *Id.* at 7–8. Petitioner asserts that it would be harmed by a stay because Petitioner “is entitled to have its petitions considered in the ordinary course, just as any other IPR petitioner is.” *Id.* at 9. Petitioner further asserts that it was only “willing to enter into a mutual stay of the IPRs” pending the Federal Circuit’s resolution of the rehearing petition in *Mylan*, and “[t]hat resolution has now occurred, and the mandate in *Mylan* has now issued.” *Id.* at 10. Accordingly, Petitioner argues that the Federal Circuit’s decision in *Mylan* is controlling because both staying the mandate and extending the deadlines for Patent Owner’s preliminary responses require a showing of good cause. *Id.* at 11. According to Petitioner, “[i]t would be extraordinary, after that decision, for the Board to come to a different conclusion based on the exact same facts and arguments.” *Id.*

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After considering all of the parties' arguments for and against extending the preliminary response deadlines, we agree with Petitioner. A request for an extension of time, including for a patent owner preliminary response, "must be supported by a showing of good cause." 37 C.F.R. § 42.5(c)(2). Patent Owner has not provided such a showing. As argued by Petitioner, the Federal Circuit in *Mylan* rejected Patent Owner's argument that tribal sovereign immunity can be asserted in an *inter partes* review, and considered whether Patent Owner's petition for a writ of certiorari to the Supreme Court on the issue "would present a substantial question" and whether Patent Owner demonstrated "good cause for a stay" of the mandate to the Board. *See* Ex. 2006, 7; Fed. R. App. P. 41(d)(1). The Federal Circuit determined that Patent Owner did not make the necessary showing. Ex. 2022. The Federal Circuit's determination that Patent Owner had not demonstrated a substantial question and good cause to stay its mandate in *Mylan* pending the Supreme Court's decision on Patent Owner's forthcoming petition instructs us to similarly find that Patent Owner has not demonstrated good cause to extend the deadlines for Patent Owner's preliminary responses in these proceedings for the same reasons.

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Motion to extend the deadlines for its preliminary responses in these proceedings is *denied*.

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