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)

Brief Amicus Curiae of the Seneca Nation
in Support of the Patent Owner, Saint Regis Mohawk Tribe

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[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).

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STATEMENT OF INTEREST

The Seneca Nation is a sovereign Indian nation comprised of more than 8,000 citizens, whom occupy five territories (Allegany, Cattaraugus, Oil Springs, Niagara Falls, and Buffalo Creek) in Western New York, over which the Nation exercises its governing authority. The Nation is part of the historic Six Nations Confederacy and has governed itself in accordance with a written constitution establishing a tripartite form of government consisting of legislative, executive, and judicial functions since 1848. The Nation is a federally recognized Indian nation. Indian Entities Recognized and Eligible to Receive Services from the United States Bureau of Indian Affairs, 82 Fed. Reg. 4915, 4918 (Jan. 17, 2017)

The Nation hereby submits this amicus brief in response to the Patent Trial and Appeal Board (PTAB) request for briefing from amicus curiae, Paper No. 96 (Nov. 3, 2017), pursuant to 37 CFR § 42.20(d), in order to address incorrect legal assertions made regarding the indispensable party analysis as it applies to tribal sovereigns. The Nation has the strongest interest in assuring the doctrine of sovereign immunity as applied to Indian nations is understood and respected in federal legal and administrative proceedings. It is of significant importance that this Board adhere to the longstanding practices of the application of the indispensable party analysis and criteria in regards to Indian nations.

We understand that the Board does not have an indispensable party rule but that it does refer to the Federal Rules of Civil Procedure for guidance. As we explain below, under Fed. Rule Civ. Pro. 19, tribes have long been given deference as a sovereign and consideration of whether a case can go forward without a tribe is made with heightened scrutiny. The interests of sovereignty thus compel a heightened deference to tribes in the application of general principles of sovereign immunity, in accordance with what is now settled law.

ARGUMENT

I. Dismissal Is Appropriate Where A Tribal Sovereign Cannot Be Joined.

Indian nations exercise inherent sovereign authority and, as self-governing and self-determining entities, thereby possess sovereign immunity as a "necessary corollary to Indian sovereignty and self-governance." *Three Affiliated Tribes of Fort Berthold Reservation v. Wold Engineering, P.C.*, 476 U.S. 877, 890 (1986). This rule holds even for off-reservation commercial activity. *See, e.g., Michigan v. Bay Mills*, ___ U.S. ___, 134 S.Ct. 2024, 2037 (2014) (hereafter "*Bay Mills*") (Declining to confine tribal sovereign immunity to reservations or to non-commercial activities); *Sac & Fox Nation v. Hanson*, 47 F.3d 1061, 1065 (10th Cir. 1995) (Holding that the extra-territorial nature of commercial activity does not strip the tribe of its right to assert sovereign immunity), *cert. denied*, 516 U.S. 810

(1995); *Kiowa Tribe of Oklahoma v. Mfg. Tech., Inc.*, 523 U.S. 751 (1998) (hereafter "*Kiowa*") (Holding that tribal sovereign immunity barred suits in contract against the tribe, even when the contracts in question involved off-reservation commercial activities).

Furthermore, there is a "strong policy that has favored dismissal when a court cannot join a tribe because of sovereign immunity." *Klamath Tribe Claims Comm. v. United States*, 106 Fed. Cl. 87, 95 (2012), *aff'd*, 541 Fed.Appx. 974 (Fed. Cir. 2013) (hereafter "*Klamath*") (quoting *Davis v. United States*, 192 F.3d 951, 960 (10th Cir. 1999), *cert. denied*, 542 U.S. 937 (2004)); *See also Enterprise Mgmt. Consultants, Inc. v. United States ex rel. Hodel*, 883 F.2d 890, 894 (10th Cir. 1989) (hereafter "*Enterprise*") ("The dismissal of this suit is mandated by the policy of tribal immunity.").

Indeed, when a tribe is immune from suit, there is "very little need for balancing Rule 19(b) factors because immunity itself may be viewed as the compelling factor." *White v. Univ. of Cal.*, 765 F.3d 1010, 1028 (9th Cir. 2014) (internal quotes omitted). It follows that nearly every case has been dismissed when the absent party is an Indian tribe protected by sovereign immunity. *See, e.g., Am. Greyhound Racing, Inc. v. Hull*, 305 F.3d 1015 (9th Cir. 2002); *Dawavendewa v. Salt River Project Agric. Improvement & Power Dist.*, 276 F.3d 1150 (9th Cir. 2002); *Puyallup Tribe, Inc., v. Department of Game of Wash.*,

433 U.S. 165 (1977); *Oklahoma Tax Comm'n v. Citizen Band Potawatomi Tribe of Okla*., 498 U.S. 505 (1991); *United States v. United States Fidelity & Guaranty Co*., 309 U.S. 506 (1940); *Lomayaktewa v. Hathaway*, 520 F.2d 1324 (9th Cir. 1975), *cert. denied*, 425 U.S. 903 (1976)); *Tewa Tesuque v. Morton*, 498 F.2d 240 (10th Cir. 1974), *cert. denied*, 420 U.S. 962 (1975).

The test applied to determine whether a tribe is an indispensable party but cannot be joined because of its sovereign immunity is very similar to that announced in *Philippines v. Pimentel,* 553 U.S. 851, 862–63, 873 (2008) (hereafter "*Pimentel*"), in the context of foreign sovereigns. In *Pimentel*, the Supreme Court held that "[a] case may not proceed when a required-entity sovereign is not amenable to suit … where sovereign immunity is asserted, and the claims of the sovereign are not frivolous, dismissal of the action must be ordered where there is a potential for injury to the interests of the absent sovereign." This rule holds even if there is no alternative forum. *Id*. at 872.

A *Pimentel-like* analysis has applied in the context of Rule 19 and tribal sovereign immunity both before and after the ruling in *Pimentel*. Like *Pimentel*, the policy as applied to tribes has sometimes been defined as mandatory and compelling. *Klamath*, 106 Fed. Cl. at 96 ("*Pimentel* stands for the proposition that where a sovereign party should be joined in an action, but cannot be owing to sovereign immunity, the entire case must be dismissed if there is the potential for

the interests of the sovereign to be injured."). Like *Pimentel*, the lack of a forum does not automatically prevent dismissal of the claims asserted. *See Makah Indian Tribe v. Verity*, 910 F.2d 555, 560 (9th Cir. 1990) ("Sovereign immunity may leave a party with no forum for [that party's] claims.") (citing *Lomayaktewa v. Hathaway*, 520 F.2d at 1326); *Fluent v. Salamanca Indian Lease Authority*, 928 F.2d 542, 547 (2d Cir. 1991) ("The only branch with the ability to provide a forum for resolution of the issues involved here is Congress.")

The Petitioners have sought to distinguish *Pimentel* on the ground that the sovereign in that case was a foreign sovereign while tribes are domestic dependent sovereigns. *See* Petitioners' Opp. brief at 21. This is a false distinction in any event. It been well-established post-*Pimentel* that heightened deference is provided to tribes, just as it is to foreign and domestic sovereigns. *Klamath,* 106 Fed. Cl. at 96 ("As subsequent cases confirm, this rationale applies to domestic sovereigns, *i.e.*, States and Indian nations, as much as it does to foreign sovereigns, e.g., the Philippines"). The tribal immunity and indispensable party line of cases also make it clear that tribes were given such deference long before *Pimentel* was decided. See cases cited at *supra*, 4-5.

The vast majority of cases hold, both as a matter of sound law and good policy, that where a tribe cannot be joined as an indispensable party due to its

sovereign immunity, the case should be dismissed. This Board should follow suit and dismiss the present case on the grounds of tribal sovereign immunity.

II. Third Party Representation Cannot Be Used To Justify Going Forward To Determine The Legal Rights Of A Sovereign Tribe.

The Petitioners have taken the position, Opp. Brief at 13-14, that even if the Tribe does hold an interest in the patent, that Allergan can adequately represent any such interests as an existing party to the proceedings. This assertion is repeated at p. 18, "Allergan can fully represent any ownership interests the Tribe may have."

To the contrary, courts have held in a number of contexts that tribes, as indispensable parties with unique interests, cannot be adequately represented by third parties unless a tribe consents. Without their consent, cases have resulted in dismissal. *See, e.g., Kescoli v. Babbitt*, 101 F.3d 1304 (9th Cir. 1996) (Finding that litigating without the tribes would threaten their sovereignty by attempting to disrupt their ability to govern themselves and to determine what is in their best interests in balancing potential harms of mining operation against the benefits of royalty payments); *Fluent v. Salamanca Indian Lease Auth.*, 928 F.2d 542 (2d Cir. 1991) (Finding in an action challenging the constitutionality of the Seneca Nation Settlement Act of 1990, that "as the beneficiary of a substantial sum of money

from the federal government, it is manifest that the Nation has a vital interest in the constitutionality of the 1990 Act.").

This is so because it is generally understood that no external entity, even one acting as a fiduciary or in a trust relationship with a tribe, such as the United States, can represent the varied interests of a sovereign Indian tribe; only the tribe itself can represent its own interests. In *Enterprise,* for example, the Tenth Circuit considered whether the United States, as a defendant, could represent the Tribe in a suit regarding a tribal contract. The Court held that if the suit went forward, the Tribe's immunity would be effectively abrogated since the suit would result in an adjudication of its interest in that contract without its consent. *Enterprise,* 883 F.2d at 894. The Court concluded that the Tribe was an indispensable party and dismissed the case, holding that the United States could not adequately represent the Tribe's interest because "the Tribe's interest here in its sovereign right not to have its legal duties judicially determined without consent is an interest which the United States' presence in this suit cannot protect." *Id.* Similarly, in *Rosales v. United States,* 73 Fed.Appx. 913, 914 (9th Cir. 2003), the Ninth Circuit, in dismissing the suit, held that the Jamul Indian Village was a necessary and indispensable party which could not be forced to appear and could not be adequately represented by the United States.

It stems from this line of reasoning then, that if Indian nations cannot be adequately represented by their fiduciary, they certainly cannot be represented by any other entity including corporations and field-of-use licensees. Only the tribe itself can represent its unique and varied interests before this Board.

III. Tribes Have Been Held To Be Indispensable And The Case Dismissed In A Variety Of Contexts.

There are also specific factual contexts that establish that a third party cannot represent a tribe. For example, in relation to property interests it has been held that a case simply may not go forward when the question of a tribe's property ownership and rights are at issue and the Tribe cannot be joined. *See Jamul Action Comm. v. Chaudhuri*, 200 F.Supp.3d 1042, 1050 (E.D. Cal. 2016) ("[T]he Tribe's interests in its status, its sovereignty, its beneficial interests in real property, and its contractual interests cannot be adjudicated without its formal presence."); *Quileute Indian Tribe v. Babbitt*, 18 F.3d 1456, 1460 (9th Cir. 1994) (potential for tribe to lose property interest renders tribe indispensable).

In terms of contracts, it has been held that third parties cannot represent tribes in contract disputes. *See E.E.O.C. v. Peabody W. Coal Co.*, 610 F.3d 1070, 1082 (9th Cir. 2010) (The Ninth Circuit has "repeatedly held that '[n]o procedural principle is more deeply imbedded in the common law than that, in an action

[challenging the terms of] a contract, all parties who may be affected by the determination of the action are indispensable.'") (quoting *Lomayaktewa v. Hathaway*, 520 F.2d at 1325); *see also Dawavendewa v. Salt River Project Agr. Imp. & Power Dist.*, 276 F.3d 1150, 1157 (9th Cir. 2002) (Reaffirming the fundamental principle outlined in *Lomayaktewa* that "[A] party to a contract is necessary, and if not susceptible to joinder, indispensable to litigation seeking to decimate that contract", and finding that a judgment rendered in the absence of the Navajo Nation would impair its "sovereign capacity to negotiate contracts and, in general, to govern the Navajo reservation."); *Clinton v. Babbitt*, 180 F.3d 1081, 1088 (9th Cir. 1999) ("[A] district court cannot adjudicate an attack on the terms of a negotiated agreement without jurisdiction over the parties to that agreement.")

Cases presenting an infringement on tribal sovereign immunity in other contexts produce similar results. In a case brought by the Northern Arapaho Tribe alleging unlawful imposition of vehicle and excise taxes by state and county governments, the District Court of Wyoming was compelled to dismiss the case because the Eastern Shoshone Tribe could not be joined due to tribal sovereign immunity. *Northern Arapaho Tribe v. Harnsberger*, 660 F.Supp.2d 1264 (D. Wyo. 2009). The Court determined that "[t]he sovereignty of each nation demands equal respect, yet two of the affected sovereigns resist joinder … the Court finds that this case cannot proceed without them." *Id.* at 1287. S*ee also Vann v.*

Salazar, 883 F.Supp.2d 44, 49-51 (D.D.C. 2011) (Dismissing action against the Secretary of the Interior alleging disenfranchisement of the Cherokee Freedmen after finding the Cherokee Nation would be prejudiced if the action proceeded in its absence); *Rosales v. Dutschke*, Slip Copy, 2017 WL 3730500, *6 (E.D. Cal. 2017) (Dismissing action against federal defendants because Tribe (Jamul Indian Village) is an indispensable party and immune from suit; "JIV's interest in maintaining its sovereign immunity outweighs plaintiffs' interest"); *Union Pacific Railroad Co. v. Runyon*, 2017 WL 923915 (D. Or. 2017) (Dismissing action because Indian tribes' interest in treaty-reserved fishing rights could not be adequately represented by the County board of commissioners, the Columbia River Gorge Commission, or intervening environmental organizations).

Courts across the land have found that when a tribe is an indispensable party in a case impacting their legal interests, the doctrine of tribal sovereign immunity necessitates dismissal. This rule has applied in a wide variety of contexts involving subject matter from property and contractual interests to treaty-reserved rights. This Board should take special care to fully examine and apply this general principle of law to the context of proceedings before this Board: an Indian tribe patent owner, as an indispensable and non-consenting sovereign, cannot have its rights adequately represented by a third party.

CONCLUSION

This Board needs to tread carefully. The Supreme Court has been very deferential to Congress in terms of when and how to address tribal sovereign immunity. It is a well-established principle of federal law that only Congress has the authority to curtail tribal sovereign immunity. Just as the Supreme Court refused to overstep its authority in *Bay Mills*, we urge this Board to not "create a freestanding exception to tribal immunity for all off-reservation commercial conduct." *Id.* at 2039. The Board should not create new precedents but should rely on sound legal reasoning that is grounded in the well-developed jurisprudence of the Supreme Court and federal courts. Contrary to the Opposition's contention, while this may be a case of first impression to the Board, the case law and history of tribal sovereign immunity is longstanding and robust and necessitates dismissal of the present case.

Respectfully submitted,

Dated: December 1, 2017 */Martin E. Seneca, Jr./*

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I hereby certify that on December 1, 2017, I caused the foregoing Amicus Curiae Brief of the Seneca Nation in Support of the Patent Owner, Saint Regis Mohawk Tribe, to be served by email on the following counsel of record:

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