

PTAB Cuts Down Two More Allergan Restasis Patents

By **Matthew Bultman**

Law360 (September 30, 2019, 6:56 PM EDT) -- The Patent Trial and Appeal Board has invalidated two patents on Allergan's dry-eye drug Restasis, delivering the potential final blow to a group of patents the drugmaker sought to shield from the PTAB under the cover of tribal sovereign immunity.

Deciding challenges brought by Mylan and other generic companies on Friday, PTAB found the fate of the two patents was sealed when a court found related Restasis patents were obvious. PTAB said those patents describe essentially the same inventions.

"Patent owner has not persuasively identified any meaningful difference between the subject matter claimed in [these two patents] and the subject matter claimed in [certain other patents] that would have affected the patentability analysis," the board wrote.

The inter partes review decisions came just more than two years after Allergan transferred six patents for Restasis to the St. Regis Mohawk tribe, operating under the theory that tribal sovereign immunity should insulate the patents from PTAB review.

The Federal Circuit rejected the controversial maneuver in 2018, finding tribal immunity does not apply in IPR.

Allergan was separately tangled in district court litigation with Mylan, Akorn and Teva, which were developing copycat versions of Restasis. Weeks after the St. Regis deal, a judge sitting in the Eastern District of Texas ruled that four of the patents are invalid because they would have been obvious.

After the judge's ruling was affirmed on appeal, Allergan and St. Regis appealed to the U.S. Supreme Court. The justices refused to hear the case in June.

On Friday, PTAB said the court ruling "necessarily" required a determination that the remaining two patents are obvious.

Under the doctrine of collateral estoppel, parties are barred from relitigating issues that have been "fully and fairly tried" in another proceeding. PTAB said the obviousness of the patents in the district court was substantially similar to the arguments made in IPR.

"[W]e determine that patent owner had a full and fair opportunity to litigate the limitations of each

claim of" these two patents, the board wrote. "Accordingly, we find that collateral estoppel applies to each claim of the [patents]."

Representatives for Allergan and the generic-drug makers could not immediately be reached for comment Monday.

The patents at issue are U.S. Patent Nos. 8,642,556 and 8,633,162.

Mylan is represented by Wilson Sonsini Goodrich & Rosati PC. Teva is represented by Carlson Caspers Vandenburg & Lindquist PA and Sterne Kessler Goldstein & Fox PLLC. Akorn is represented by Sughrue Mion PLLC.

Allergan is represented by Fish Richardson PC. St. Regis is represented by Shore Chan DePumpo LLP and Marsha Schmidt.

The cases are Mylan Pharmaceuticals Inc. et al. v. Saint Regis Mohawk Tribe and Allergan Inc., case numbers IPR2016-01130 and IPR2016-01129, at the Patent Trial and Appeal Board.

--Editing by Stephen Berg.

Correction: A previous version of this story misstated a law firm for the petitioners. The error has been corrected.