

PATENT LICENSING: ISSUES & TIPS

Jeffrey A. Wolfson
UT-Advanced Patent Law Institute
US PTO – March 1, 2018

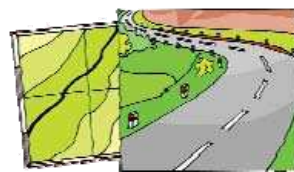
haynesboone

© 2018 Haynes and Boone, LLP

1

Licensing – A Roadmap

- Sovereign Immunity
 - States / state universities
 - Tribes
- Patent Exhaustion
- Nuts & Bolts – Practical provisions



haynesboone

© 2018 Haynes and Boone, LLP

2

Sovereign Immunity - Overview

- Shields sovereign entities from lawsuits: federal government, states, and tribes
- Sovereign Immunity can be:
 - waived by consent or
 - abrogated by Congress
 - *Clark v. Barnard* (1883)
 - *Nev. Dep't. of Human Res. v. Hibbs* (2003)



haynesboone

© 2018 Haynes and Boone, LLP

3

State Sovereign Immunity - Overview

- Basis? U.S. Constitution, 11th Amendment
 - The judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State. . . .
- Protects states and state entities from suit in federal court and federal adjudicative administrative proceedings



haynesboone

© 2018 Haynes and Boone, LLP

4

State Sovereign Immunity Cases

- *Covidien LP v. Univ. of Fla. Research Found. Inc. (2017)*



- Facts:
 - UFRF sued Covidien for breach of license (Circuit Court, 8th Judicial District of Florida)
 - Covidien filed petitions requesting IPR of the licensed patent

haynesboone

© 2018 Haynes and Boone, LLP

5

State Sovereign Immunity Cases

- PTAB Ruling
 - IPR and civil litigation are sufficiently similar proceedings to implicate sovereign immunity
 - UFRF is an arm of Florida
 - UFRF is entitled to sovereign immunity
 - IPR dismissed – No appeal to Fed. Cir.



haynesboone

© 2018 Haynes and Boone, LLP

6

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Patent Licensing: Issues & Tips

Also available as part of the eCourse

[2018 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the
13th Annual Advanced Patent Law Institute session
"Licensing Issues"