

# PATENT LICENSING: ISSUES & TIPS

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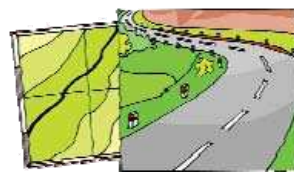
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## Licensing – A Roadmap

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



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## 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)



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## State Sovereign Immunity - Overview

- Basis? U.S. Constitution, 11<sup>th</sup> 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



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## State Sovereign Immunity Cases

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



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

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## 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.



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First appeared as part of the conference materials for the  
13<sup>th</sup> Annual Advanced Patent Law Institute session

"Licensing Issues"