

## University Invokes Sovereign Immunity to Avoid Patent Invalidation Proceeding

**Articles** March 2, 2017

In a recent decision, the Patent Trial and Appeal Board (the "PTAB") held that a states' sovereign immunity applies to patent inter partes review proceedings. Inter partes review is an alternative to traditional litigation and provides a mechanism for challenging the validity of issued patents.

The inter partes petition was filed by Covidien LP ("Covidien") to challenge the claims of United States Patent No. 7,062,251 ("the '251 Patent") owned by the University of Florida Research Foundation, Inc., which is the licensing branch of the University of Florida ("UF"). UF moved to dismiss Covidien's petition asserting UF's sovereign immunity as a defense.

The dispute between the parties stemmed from a lawsuit filed by UF against Covidien alleging breach of a patent license agreement related to the '251 Patent. Covidien responded with a counterclaim that Covidien did not infringe the '251 Patent and, in parallel, filed the inter partes petition to invalidate the '251 Patent.

In its decision, the PTAB stated that UF is an arm of the State of Florida and that the Supreme Court has interpreted a state's sovereign immunity protections to extend not only to proceedings in federal court but also to administrative proceedings. Therefore, the PTAB agreed with UF that the defense of sovereign immunity applied and in this case dismissed Covidien's petition.

This PTAB decision highlights the significant protections state universities have against challenges to their patent portfolio.

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