

Report to Congress

**Infringement disputes between
patent and trademark rights holders
and states and state entities**

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UNITED STATES
PATENT AND TRADEMARK OFFICE



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The United States Patent and Trademark Office (USPTO) thanks the members of the public who submitted written comments in connection with this report.

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I. Executive summary

This report summarizes the results of a study that the United States Patent and Trademark Office (USPTO) undertook regarding the extent to which patent and trademark owners experience infringement of their intellectual property by states and state entities without adequate remedies under state law and the extent to which such infringement may be intentional or reckless. The study was conducted—and this report was prepared—at the request of Senators Thom Tillis and Patrick Leahy.¹ The request from the Senators was made following a ruling by the Supreme Court in *Allen v. Cooper*² that a statute³ abrogating sovereign immunity for states in copyright matters was unconstitutional.

On the basis of helpful information from commenters and our own research, we identified 78 instances of asserted state infringements over a period running from 1985 to the present, including 49 assertions made with respect to patents and 29 made regarding trademarks.⁴ The report concludes that the precise legal significance of these numbers cannot, at present, be ascertained. As explained below, the Supreme Court has held that future legislation abrogating

sovereign immunity for states in patent and copyright matters could pass constitutional muster only if, among other things, it was supported by a record showing widespread and persisting infringement by states.

The Supreme Court did not provide precise guidance as to how the “widespread and persisting” standard should be applied, and this report, therefore, takes no position as to whether the level of infringement it identifies meets that standard.

While the USPTO was asked to report on whether instances of state infringement were intentional or reckless, the USPTO was not able to draw any such conclusions. The report does conclude that when state entities engage in patent and trademark infringement, rights holders, as a general matter, have no assurance that adequate state law or other remedies will be available to them.

Finally, the report summarizes arguments offered by members of the public, both those supporting abrogation of sovereign immunity in patent and trademark infringement matters and those advocating for its continuation.

1 A copy of the letter from the Senators to the USPTO requesting that it conduct the study and prepare this summary is attached as appendix A. Senators Tillis and Leahy also requested the United States Copyright Office (USCO) to conduct a parallel study on copyright issues. See the Notice of Inquiry that the USCO published in connection with that request, 85 Fed. Reg. 34,252 (June 3, 2020).

2 *Allen v. Cooper*, 140 S. Ct. 994 (2020).

3 Copyright Remedy Clarification Act, 17 U.S.C. § 501 et seq. (1990).

4 As discussed further later in this report, this number likely does not reflect the totality of assertions of infringement by states that were made during the relevant period.

II. Introduction: Relevant Supreme Court jurisprudence

Under the 11th Amendment of the Constitution,⁵ state entities are immune from suits in federal courts.⁶ Nevertheless, there are two circumstances in which parties may successfully sue states in federal court:⁷ (1) when the state has waived its immunity or (2) when Congress has authorized the suit pursuant to its enforcement of the 14th Amendment.

In the area of intellectual property (IP), Congress has enacted statutes barring state entities from asserting sovereign immunity in infringement matters, but the Supreme Court invalidated these statutes. In *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*,⁸ the Court found that the Patent and Plant Variety Protection Remedy Clarification Act, which had abrogated state immunity from patent infringement suits, was unconstitutional. Likewise, in *College Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*,⁹ a decision issued on the same day as *Florida Prepaid*, the Court found that the Trademark Remedy Clarification Act, which abrogated state sovereign immunity for claims under the Lanham Act, was unconstitutional. More recently, in *Allen v. Cooper*,¹⁰ the Court ruled that the Copyright Remedy Clarification Act of 1990

(CRCA), which abrogated state immunity for liability for copyright infringement, was also unconstitutional.

In all of these decisions, the Supreme Court made clear that Congress does have authority, in certain circumstances, to strip states of their sovereign immunity.¹¹ The decisions pointed to a series of cases, including *Fitzpatrick v. Bitzer*¹² and *City of Boerne v. Flores*,¹³ that defined some of the contours of Congress's authority under section 5 of the 14th Amendment¹⁴ to enact legislation to prevent conduct prohibited by section 1 of that Amendment,¹⁵ such as the deprivation of property without due process of law. In principle, Congress may abrogate state sovereign immunity to prevent the unconstitutional deprivation of an IP right.

Nevertheless, the Court emphasized that some, but not all, such deprivations are unconstitutional. A state's deprivation of property will violate the 14th Amendment¹⁶ only if (1) the act of infringement is "intentional, or at least reckless"¹⁷ and (2) the state does not provide an adequate remedy to redress the deprivation. Due process is not lacking when there is an adequate remedy in place.¹⁸

5 U.S. CONST. amend. XI.

6 See, e.g., *Kimel v. Florida Bd. of Regents*, 528 U.S. 62 (2000); *Will v. Michigan Dep't. of State Police*, 491 U.S. 58 (1989).

7 See *College Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 670 (1999).

8 *Florida Prepaid Post Secondary Educ. Expense Bd. v. College Savings Bank* 527 U.S. 627 (1999).

9 *College Savings Bank*, 527 U.S. at 666.

10 *Allen v. Cooper*, 140 S. Ct. 994 (2020).

11 *Id.* at 1004 *et seq.*; *College Savings Bank*, 527 U.S. at 675; *Florida Prepaid*, 527 U.S. at 635 *et seq.*

12 *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976).

13 *City of Boerne v. Flores*, 521 U.S. 507 (1997).

14 U.S. CONST. amend. XIV, § 5.

15 U.S. CONST. amend. XIV, § 1.

16 U.S. CONST. amend. XIV.

17 *Allen v. Cooper*, 140 S. Ct. 994, 1004 (2020).

18 *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*, 527 U.S. 627, 643 (1999).

In *Allen* and *Florida Prepaid*, the Court found that Congress’s abrogation of state sovereign immunity was not supported either by a record that showed sufficiently significant levels of infringing conduct by the states¹⁹ or by consideration of whether there were adequate state remedies available for infringement.²⁰ *Allen* stressed that Congress was not precluded from passing a valid law in the future that abrogated state sovereign immunity for copyright infringement.²¹ The Court suggested that such a statute should “[link] the scope of its abrogation to the redress or prevention of unconstitutional injuries” and that this link should be supported by a legislative record.²² In particular, the Court said that at the time Congress passed the CRCA,

Congress likely did not appreciate the importance of linking the scope of its abrogation to the redress or prevention of unconstitutional injuries—and of creating a legislative record to back up that connection. But going forward, Congress will know those rules. And under them, if it detects violations of due process, then it may enact a proportionate response.²³

In the context of the present report—which considers, among other things, the degree to which patent and trademark rights holders experience infringement by state entities—this guidance from the Court gives rise to the following question: What standard has the Court provided to assess which levels of intentional or reckless infringement are sufficiently significant? It appears that that standard is “widespread and persisting” unconstitutional infringements.²⁴

In *Florida Prepaid*, the Court found that the Patent Remedy Act (PRA) was unconstitutional because “[t]he legislative record .. suggests that [the Act did] not respond to a history of ‘widespread and persisting deprivation of constitutional rights’ of the sort Congress has faced in enacting proper prophylactic § 5 legislation.”²⁵ In *Boerne*, the Court invalidated the statute in question, the Religious Freedom Restoration Act, because there was insufficient evidence in the record of “legislation enacted or enforced due to animus or hostility to the burdened religious practices” or of “some widespread pattern of religious discrimination in this country.”²⁶

19 *Id.* at 645; *Allen*, 140 S. Ct. at 1006. In *College Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 675 (1999), the Court found that the interest asserted to have been violated, a right to prevent the state defendant from making alleged misstatements about a service the plaintiff offered, was not a property right. Hence, there was no deprivation of a right protected under the 14th Amendment and, therefore, no need to undertake an analysis of whether the measure in question—namely, the Trademark Remedy Clarification Act—was needed to prevent a violation of the 14th Amendment. By contrast, in *Florida Prepaid*, the Court affirmed that patents are a form of property, and it did likewise with respect to copyrights in *Allen*. See, *Allen*, 140 S. Ct. at 1004 and *Florida Prepaid*, 527 U.S. at 642.

20 *Florida Prepaid*, 527 U.S. at 643–44; *Allen*, 140 S. Ct. at 1006–07.

21 *Allen*, 140 S. Ct. at 1007.

22 *Id.*

23 *Id.*

24 The relevant decisions—*Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*, 527 U.S. 627 (1999) and *Allen v. Cooper*, 140 S. Ct. 994, 1004 (2020)—address, respectively, patents and copyrights. There are no Supreme Court precedents on point with respect to trademarks. Although *College Savings Bank* considered—and invalidated—a statute that had abrogated state sovereign immunity for a range of Lanham Act violations, trademark infringement was not asserted in *College Savings Bank*. Because *Allen*, a copyright case, draws on *Florida Prepaid*, a patent case, this report assumes that the standard derived from these cases is relevant to other IP rights, including trademarks.

25 *Florida Prepaid*, 527 U.S. at 645, citing *City of Boerne v. Flores*, 521 U.S. 507, 526 (1997) (emphasis added).

26 *City of Boerne*, 521 U.S. at 531.

Thereafter, in *Allen*, the Court pointed to the *Florida Prepaid* analysis in its evaluation of the CRCA. It held that (1) because the CRCA was identical in scope to the PRA, the CRCA could pass constitutional muster only if it had been enacted in response to “materially stronger evidence of infringement”²⁷ than was present in the case of the PRA, and (2) in the case of the CRCA, the evidence in the record of infringement by states was found to be insufficient. Although in *Allen* the Court did not use

the precise wording it employed in *Florida Prepaid*—“widespread and persisting”—in evaluating the evidence of the quantity of state infringements, it nevertheless relied on the discussion in *Florida Prepaid* that employed that phrase.²⁸ While the standard for determining whether there has been significant infringement appears to be “widespread and persisting,” the Court has not furnished precise guidance as to how it should be applied.

III. Summary of findings

The key findings set forth in this report include the following:

- On the basis of information provided by commenters and USPTO-conducted research, for the period running from 1985 to the present, the USPTO identified 49 instances in which a state was alleged to have infringed a patent and 29 instances in which a state was alleged to have infringed a trademark.
- The Supreme Court has provided a standard as to what level of state infringement of patents and copyrights could, together with other factors, justify statutory abrogation of state sovereign immunity in such cases: The infringement must be widespread and persisting.²⁹ However, the metrics by which to apply

that standard are unclear, and this report takes no position on whether the cases identified here evidence widespread and persisting patent or trademark infringement by states.

- The record does not allow a conclusion as to the extent to which states’ infringement of patents and trademarks, when it occurs, is intentional or reckless.
- Although the varied nature of states’ laws makes it difficult to draw general conclusions about the adequacy of state law remedies that may be available to patent and trademark rights holders who assert infringement by states and state entities, obstacles to recovery under state law may often be significant.

27 *Allen*, 140 S. Ct. at 1006.

28 *Id.* (“Despite undertaking an exhaustive search, [the Register of Copyrights] came up with only a dozen possible examples of state infringement.”).

29 See *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*, 527 U.S. 627, 645 (1999).

IV. Methods

A. Requests for information

To assist in gathering information for this report, the USPTO published a Request for Information in the Federal Register on November 5, 2020.³⁰ The notice invited interested members of the public to answer questions regarding the extent and nature of assertions of patent and trademark infringement by state entities and to provide information about a variety of matters, including the following:

- The extent to which there are assertions of patent or trademark infringements or both by state entities
- Particular instances of infringement
- The manner in which defenses of sovereign immunity are asserted and treated in patent and trademark infringement cases
- Effects of the availability of state sovereign immunity in patent and trademark infringement cases
- The nature and availability of state remedies for patent and trademark infringement

The USPTO took various steps to help ensure maximum awareness of the notice. These included (1) distribution of a letter announcing the notice on the day of publication to a variety of stakeholders, including state attorneys general, bar groups, and IP rights holder groups, and (2) notification of publication of the notice,

distributed via a USPTO social media account.

On January 22, 2021, the USPTO published a second notice in the Federal Register, inviting interested members of the public to address the questions posed in the original notice or either of two additional questions.³¹ The two additional questions asked for information from IP rights holders about instances of a state or state entity using a patent or trademark without permission and for information from states or state entities about relevant policies or state laws to provide safeguards against, and remedies for, patent and trademark infringement.

The USPTO received 11 responses to its Requests for Information. Responses were submitted by a diverse set of commenters, including (1) universities, (2) industry associations, (3) bar associations and another civic organization, and (4) individuals.

B. Assessing the extent of asserted patent and trademark infringement by states

To prepare this report, the USPTO explored the nature and extent of claims that states and state entities have infringed patents and trademarks, from 1985 to the present. The USPTO arrived at an estimate of the number of instances of asserted patent and trademark infringements by reviewing the following:

- An account provided by one commenter, a private university, describing actions by

30 85 Fed. Reg. 70,589 (Nov. 5, 2020).

31 86 Fed. Reg. 6,636 (Jan. 22, 2021).

three public universities that it believed infringed its trademark,³²

- 68 litigated infringement disputes involving state defendants that we identified through our own research or that were called to our attention by commenters;³³
- Two instances, identified through searches of the USPTO's TTABVUE database, in which parties to proceedings at the Trademark Trial and Appeal Board (TTAB) involving state entities, although litigating questions of trademark registrability rather than infringement, made assertions that state³⁴ entities had engaged in conduct that could be construed as infringing;
- An assertion made by a trademark owner in a complaint it had filed in an infringement action, that, in addition to the asserted infringement that was the subject of the complaint, its trademark had also been infringed by other entities,

not parties to the suit, four of whom were state universities; and³⁵

- One instance in which one private entity accused another private entity of inducing a state entity to infringe a patent.³⁶

Thus, for the period examined, the USPTO identified 78 instances in which rights holders asserted that a state, or an arm of a state, infringed a patent or trademark. Of these, 49 involved patents and the remaining 29 involved trademarks.³⁷

C. Limitations of the data

It is important to stress that this finding relies heavily on the record of litigated cases, and that those do not provide a complete picture of the universe of infringements. In particular, not all infringement assertions against state entities result in lawsuits, and those that do may not produce written decisions. Indeed, the very availability of sovereign immunity as a defense is likely to

32 See Liberty University, comment at 2-6. Another commenter, a state university, to support its assertion that state patent and trademark infringements occur infrequently, reported that in a 20-year period beginning in 2000, it had “fielded a very small number of allegations of trademark infringement ... totaling less than ten allegations and likely no more than five” (University of Illinois System, comment at 2). These were not included in the estimated count of asserted infringements because the information provided was insufficiently precise.

33 See, e.g., Pharmaceutical Research and Manufacturers of America (hereinafter PhRMA), comment at 2-9; American Bar Association-Intellectual Property Law (hereinafter ABA-IPL) Section, comment at 2-3; American Intellectual Property Law Association (hereinafter AIPLA), comment at 4 and 5. In certain limited instances, the USPTO determined that cases identified by commenters should not be included in our count. For example, one commenter identified various instances in which a rights holder asserted claims against various independent school districts in Texas. AIPLA, comment, exhibit C. Although this information was helpful—as the commenter noted, it helped identify the types of allegations that may be included in plaintiffs’ suits against state entities—the identified instances were not included in the count because various courts have found that Texas school districts are not arms of the state for 11th Amendment purposes. See, e.g., Lopez v. Houston Indep. Sch. Dist., 817 F.2d 351, 353 (5th Cir. 1987), overruled on other grounds, Walton v. Alexander, 44 F.3d 1297 (5th Cir. 1995); Chapman v. Dallas Cty. Cmty. Coll. Dist., No. 3:05-CV-1809-G ECF (N.D. Tex., November 29, 2006). By contrast, school districts in California are indeed considered to be arms of the state for 11th Amendment purposes. See, e.g., Sato v. Orange Cty. Dep’t of Educ., 861 F.3d 923 (9th Cir. 2017); and an assertion of patent infringement made against a California school system is included in the count. In addition, the count does not include instances of asserted infringement that occurred before 1985.

34 Technical Coll. Sys. of Georgia v. Louisiana Econ. Dev., No. 91191683 (TTAB, filed August 27, 2009) (see Opposer’s Reply in Support of Its Trial Brief, at 9-10, filed September 26, 2011) asserted that the party whose application for registration it was opposing had sought to capitalize on the goodwill associated with the opposer’s trademark; and Univ. of Iowa v. Univ. of Southern Mississippi, No. 91164745 (TTAB, filed April 1, 2005) (see Opposer’s Trial Brief at 12-13, filed November 9, 2010) asserted that the party whose application for registration was being opposed knew of a potential conflict between the involved trademarks, and see the TTAB’s Decision (July 29, 2011) sustaining the opposition, and, in particular, its discussion (51) regarding that party’s knowledge of its adversary’s trademark. It is noted that in both these cases, all parties were arms of the state.

35 eScholar v. Miami Univ. of Ohio, No. 7:12-cv-09039 (S.D.N.Y., December 12, 2012) (Complaint at 8). The rights holder pointed to these instances of asserted infringement in an effort to demonstrate to the court that it had been vigilant in policing its trademark.

36 Syrrx, Inc. v. Oculus Pharm., Inc., 64 U.S.P.Q.2d 1222 (D. Del. 2002).

37 The litigated infringement disputes are identified in appendix B.

deter many rights holders from asserting claims of infringement, whether through litigation or other means.³⁸ One commenter's own experience bears that out: It reports that, in two instances, it declined to litigate trademark infringement claims against state entities because of the prospect that sovereign immunity would be raised as a defense.³⁹

In addition, as another commenter notes, disputes involving patent and trademark holders are resolved through a variety of means, including confidential out-of-court settlements and voluntary agreements by state entities to cease the allegedly infringing action. These disputes will not be reflected in the record of publicly available cases.⁴⁰

Moreover, it is possible that all relevant publicly available cases may not have been identified, as certain cases may have been overlooked or difficult to find.⁴¹ It is notable that, although the USPTO's Requests for Information invited commenters⁴² to identify and describe particular instances of asserted infringement by states and state entities that did not result in litigation, most did not do so. A private university reported several instances of infringement, and those reports are included in the count. One commenter⁴³

reported that it was not aware of widespread infringement by one category of state entities, namely, public universities. And another commenter,⁴⁴ a state university, said that in a 20-year period, it had encountered only five to ten allegations of patent or trademark infringement. Still another,⁴⁵ an entity operated by a public university, noted that it had never been a defendant in a patent infringement suit in federal district court.

D. Examining the nature of assertions of patent and trademark infringement by states

To explore the nature of patent and trademark infringement disputes involving states, including, among other things, whether the asserted infringements were intentional or reckless, we reviewed judicial rulings, if any, that were issued in litigated disputes. In addition, we reviewed the records of litigated disputes in all instances in which these were available in order to identify a range of the characteristics of those disputes, including the following:

- When and in which courts the disputes were litigated
- Whether the plaintiffs asserted intentional or reckless infringement in

38 See ABA-IPL Section, comment at 2; AIPLA, comment at 6.

39 Liberty University, comment at 6.

40 AIPLA, comment at 6.

41 Relatedly, the count of litigated cases includes only those whose relevance could be confirmed; others are not included. In particular, the count does not include a cluster of cases that appeared relevant: The CourtLink® database coded them as patent or trademark infringement disputes, and the named parties included defendants that appeared to be state entities. The USPTO was unable to learn much about these cases because (1) they did not appear to have been the subject of published rulings and (2) the court papers were unavailable in electronic format or from the National Archives and Records Administration or the relevant courts. Moreover, although these cases were classified as "infringement" disputes in the database, the USPTO could not include them in the count without first viewing the corresponding court papers. The classification is broad and encompasses a range of actions not relevant to this report, such as actions for declaratory judgments of non-infringement and disputes about inventorship.

42 85 Fed. Reg. at 70,590, question 2 (iv). Likewise, in the second Request for Information (86 Fed. Reg. at 6637), patent and trademark rights holders were invited (question 1) to report whether a state government or state entity had ever used its IP without authorization.

43 See Association of Public and Land-grant Universities (hereinafter APLU), comment at 4.

44 See *id.*; University of Illinois, comment at 2. We did not include this report of "five to ten" allegations in our count because the commenter did not provide information sufficient for us to do so.

45 See UNM Rainforest Innovations (hereinafter UNM), comment at 5-6.

the complaints and, if so, whether they alleged facts that, if true, would suggest that those assertions were valid, and whether the record revealed any evidence regarding intentionality or recklessness

- Whether decisions or rulings, if any, address the question of intentionality or recklessness
- The entity type of the state defendant
- Whether sovereign immunity was asserted as a defense and, if so, what ruling, if any, was issued regarding the defense
- Whether the record indicated whether the parties had settled.

V. Key findings

A. The legal significance of observed levels of patent and trademark infringement by states is uncertain

The Supreme Court has not provided precise guidance as to what constitutes “widespread and persisting” unconstitutional infringement by states. On the one hand, the Court’s jurisprudence makes clear what amount of infringement does *not* rise to that level. In *Allen v. Cooper*, the Court signaled that none of the following was enough: two examples of patent infringement cases against states cited in a House Report, an additional seven such examples between 1880 and 1990 identified in the Federal Circuit decision that

E. Legal research and analysis of stakeholder comments

Preparation of this report also entailed legal research regarding matters such as (1) the availability of state remedies and, more broadly, the extent to which different states make themselves amenable to tort and contract claims in their own courts and (2) the availability and efficacy of injunctive relief.

Finally and critically, the work draws from the helpful information and analyses provided by commenters in response to the Requests for Information.⁴⁶

the Court was reviewing in *Florida Prepaid*, and a dozen possible examples of copyright infringements by states identified in a 1988 report prepared by the U.S. Copyright Office.⁴⁷

But, if the Court has spoken on what falls below the minimum, it has not stated what that minimum is. Therefore, it is difficult to reach any conclusions as to whether the levels of asserted state patent and trademark infringements described in this report are widespread.

Those levels are certainly greater than the ones that were before the Court in *Allen*

⁴⁶ It is noted that commenters chose not to address several of the questions set forth in the Requests for Information. For example, commenters did not respond to (1) requests for information regarding formal or informal policies that states may have for responding to claims of patent or trademark infringement or (2) requests for information as to which state officials the rights holders typically turn when they notify state entities of infringement informally rather than via lawsuits. Therefore, this report does not explore those questions.

⁴⁷ *Allen v. Cooper*, 140 S. Ct. 994, 1005–06 (2020) (citations omitted).

and *Florida Prepaid*.⁴⁸ But without a precise metric, conclusions as to whether these levels are widespread cannot be drawn.

Some commenters suggested that certain recent developments could portend a future rise in instances of unauthorized uses of IP by states. In particular, two commenters⁴⁹ remarked that the Supreme Court's decision in *Allen* is likely to result in increased instances of infringement by states and state entities. In the view of one of these commenters, *Florida Prepaid* may have had such an effect, noting that approximately two-thirds of the instances of alleged infringement since 1931 that it identified arose after that decision.⁵⁰ In addition, another commenter⁵¹ suggested that it is unlikely that one type of state entity, namely public universities, engages in widespread infringement. That commenter suggested that such conduct would result in reputational harm for those institutions and would be contrary to policies they have

adopted to promote proper use of inventions and other works.

B. The record does not allow a conclusion as to whether asserted state infringements are typically intentional or reckless

In both *Allen* and *Florida Prepaid*, the Supreme Court has made it clear that a state's deprivation of property will violate the 14th Amendment only if it is *intentional* or *reckless*. A state actor's *negligent* act that causes *unintended* injury to a person's property does not deprive that person of property within the meaning of the Due Process Clause.⁵²

Senators Tillis and Leahy accordingly asked the USPTO to investigate not only the extent to which patent and trademark rights holders experience infringement by states, but also the extent to which those infringements are intentional or at least reckless.

None of the 68 litigated cases of asserted patent and trademark infringement by a

48 There is likewise no guidance as to what would constitute "persisting" infringement under the Supreme Court standard; that term also appears to be undefined. The following is noted regarding persistence with respect to the instances of asserted patent infringement the USPTO has identified, focusing on the period following the Supreme Court decision in *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*, 527 U.S. 627 (1999) and up to the present. During that time, there were only three years—2003, 2018, and 2019—in which there was not at least one assertion that a state infringed a patent. While this might suggest a level of persistence, the number of assertions appears to have lessened since the mid-2010s. The number of asserted trademark infringement by states was sparse in the early 2000s. The USPTO is aware of only one such assertion in 2003 and only one in 2005. Thereafter, there was an increase in such assertions beginning in 2009, with at least one such assertion in each subsequent year except in 2010 and 2016.

49 See PhRMA, comment at 20; Liberty University, comment at 2.

50 PhRMA, comment, *id.* The USPTO's analysis does not suggest that the level of asserted state patent and trademark infringement, over time, can be attributed to the Supreme Court's rulings in either *Florida Prepaid* or to *College Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999). For each year during the period from 2000 to the present, the USPTO compared (1) the number of patent infringement assertions and cases in federal district court involving state entities collected from public sources to the number of all patent infringement cases in federal district courts using the USPTO's Office of the Chief Economist's Patent Litigation Research dataset and (2) the number of trademark infringement assertions and cases in federal district court involving state entities collected from public sources to the number of all trademark infringement cases in federal district court, using data derived from the CourtLink® database. (For purposes of these comparisons, the USPTO excluded (1) trademark cases filed in state courts and (2) assertions of trademark infringement by states that were not litigated.) For patent infringement claims, the USPTO found that during the period from 2000 to 2008, yearly increases and decreases in claims involving states mostly tracked increases and decreases in infringement claims generally, but that beginning in 2008, the number of patent infringement claims involving states relative to all such claims started to drop over time and then to stabilize at a lower level in the period from 2012 to 2016. For trademarks, there is a similar decrease in the number of trademark infringement claims involving states relative to all such claims beginning in 2008, which also continued steadily at a relatively low level through 2020. (The USPTO notes that the number of all trademark infringement cases may be overstated, because, as noted elsewhere (see note 41), the CourtLink® database classifies a range of trademark disputes—including actions for declaratory judgments of non-infringement—as infringement disputes.) In addition, as discussed later in this report (see pages 17-18), PhRMA and another commenter, the Association for Accessible Medicines, suggest that recent and expected changes to states' laws regarding the manufacture of generic drugs could lead to a rise in infringements by states.

51 APLU, comment at 5.

52 See *Allen*, 140 S. Ct. at 1089.

state or state entity that were identified and analyzed appear to have adjudicated or resolved the issue of intentionality. This finding is not an indication that there was no intentional or reckless infringement; more likely, the dispositive issue of these cases turned on other issues, or the cases were settled or dismissed. For example, as one commenter noted, in cases when sovereign immunity is successfully asserted as a defense, it is unlikely that there will be any determinations regarding intentionality.⁵³

In 36 of the cases for which the USPTO was able to obtain copies of court filings, plaintiffs alleged intentional or reckless infringement. Although there may have been intentional or reckless behavior beyond these 36 cases, in the absence of rulings regarding intentional infringement, it is difficult to draw conclusions on the extent to which these infringements were intentional.

Moreover, the anecdotal information submitted by commenters, taken as a whole, does not provide a sufficient basis for any conclusions regarding intentionality or recklessness on a significant scale.⁵⁴ For these reasons, the record as a whole does not provide a sufficient basis for concluding

that states or state entities engage in intentional or reckless patent or trademark infringement on a significant scale.

C. There is no assurance that state remedies can be utilized to secure adequate relief for state infringements of patents and trademarks

The question of whether patent and trademark rights holders whose rights are infringed by states or state entities can obtain adequate recovery in state courts was also considered. Generalized conclusions about the adequacy of state law are difficult to draw: States differ somewhat in the nature and degree of their waivers of state law sovereign immunity, and their courts may be relatively more or less open to particular legal theories. But if all encompassing descriptions of the state-law landscape are not possible, it nevertheless appears that, as a general matter, obstacles to recovery against state actors under state law will often be formidable. All this is seen in the following representative overview of states' approaches to waivers of state law sovereign immunity, and of how assertions of certain claims for recovery may be treated by different state courts.⁵⁵

53 AIPLA, comment at 11. That commenter also suggested that claims of willful infringement are not a reliable measure of the extent of such infringements, because plaintiffs have incentives to assert those claims.

54 One commenter suggested that a state university's alleged infringing use of its trademark was at one point intentional—because it persisted following receipt of a cease and desist letter—and thereafter reckless because the use continued after the USPTO refused the state university's application to register the mark, based on the commenter's existing registration (Liberty University, comment at 7). In contrast, another commenter, a state university, reports that there have never been any allegations that it engaged in intentional infringement (University of Illinois, comment at 2). Beyond that, the record does not include accounts of individual patent or trademark owners' or users' experiences with intentional—or unintentional—infringement of patents or trademarks.

55 In considering the availability of adequate state law remedies for state patent and trademark infringement, one question that arises is whether and to what extent such remedies may be preempted by federal law. Another and distinct question is whether the federal courts have exclusive jurisdiction over the claims at issue. Where trademarks are concerned, "[t]he federal system of registration and protection does not preempt parallel state law protection, either by state common law or state registration and in the vast majority of situations, federal and state trademark law peacefully coexist." *Matal v. Tam*, 137 S. Ct. 1744, 1753, (2017), quoting J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:2 (5th ed. 2021). By contrast, 28 U.S.C. § 1338(a) provides federal courts with exclusive jurisdiction over any case "arising under any Act of Congress relating to patents." Section 1338 further provides that "[s]uch jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases." (In addition, in 2011, Congress expanded the Federal Circuit's jurisdiction to encompass compulsory counterclaims "arising under" patent law. See Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284 (2011).)

Federal courts have exclusive jurisdiction over all cases arising under the patent laws, but not over all questions in which a patent may be the subject matter of the controversy. See, e.g., *Gunn v. Minton*, 568 U.S. 251 (2013) (The Supreme Court found that a claim alleging legal malpractice for failing to raise an experimental-use argument in a patent case was not one "arising under" federal patent law

1. State law sovereign immunity

In addition to the 11th Amendment immunity that confers immunity on states from suit in federal courts, state governments may, in certain circumstances, enjoy sovereign immunity from state actions. This immunity from state actions complicates a patent or trademark holder's ability to obtain adequate recovery in state courts for infringement.

All states appear to have consented, in varying degrees, to be sued in their courts,⁵⁶ often in specialized forums.⁵⁷ However, the degree to which states waive their immunity and provide for recovery varies. First, some states place limits on the dollar amount of recovery,⁵⁸ and those limits vary. For example (1) Arkansas limits the award that the Arkansas State Claims Commission, the body entrusted with hearing claims against

the state, can grant to \$15,000;⁵⁹ (2) Florida sets recovery at \$200,000 per claimant and \$300,000 per occurrence;⁶⁰ and (3) Illinois sets recovery at \$2,000,000 per claimant in most circumstances.⁶¹

Second, the reach of states' waivers of their sovereign immunity differs. For example, many states, while waiving immunity, decline to assume liability for damages resulting from the performance of discretionary acts.⁶² However, states vary in how broadly they extend this carve-out. Many include abuses of discretion within the scope of the exception,⁶³ but a few do not.⁶⁴

Hence, no single picture emerges regarding states' amenability to suits in their courts.⁶⁵ In one case, a rights holder's injury might be adequately remedied by the maximum amount of damages that may be awarded in Arkansas, but in another case, a trademark

subject to exclusive federal court jurisdiction and could be resolved in state court.)

Although federal courts have exclusive jurisdiction over "patent cases" seeking to determine patent infringement and patent validity, the state courts retain concurrent jurisdiction over other matters relating tangentially to patents, such as contract actions concerning patent matters and royalties. *Hunter Douglas, Inc. v. Harmonic Design, Inc.*, 153 F.3d 1318 (Fed. Cir. 1998) (overruled on other grounds by *Midwest Industries, Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 50 U.S.P.Q.2d 1672 (Fed. Cir. 1999)); *Koninklijke Philips Electronics v. Digital Works, Inc.*, 358 F. Supp. 2d 328 (S.D. N.Y. 2005) (breach of contract to pay royalties). Thus, not every case involving a patent question is within the exclusive jurisdiction of the federal courts.

- 56 See, e.g., ALASKA STAT. § 09.50.250 (2020); ARK. CODE ANN. § 19-10-204 (2019); COLO. REV. STAT. § 24-10-106 (2020); DEL. CODE ANN. tit.10, § 4001 (2020); DEL. CONST. art. 1, § 9; FLA. CONST. art. 10, § 13; FLA. STAT. § 768.28 (2017); GA. CODE ANN. § 50-21-23 (1992); HAW. REV. STAT. § 662-2 (1972); IDAHO CODE § 6-903 (2011); ILL. CONST. art. 13, § 4; IOWA CODE § 669.01 et. seq. (1991); KY. REV. STAT. ANN. § 49.060 (2017); LA. CONST. art. 12, § 10 (1995); LA. STAT. ANN. § 13:5106 (2018); MINN. STAT. § 3.736 (2017); MONT. CONST. art. 2, § 18 (1974); MONT. CODE ANN. § 2-9-102 (1977); NEV. REV. STAT. § 41.031 (1997). One partial exception to this trend of acceptance, in principle, of general amenability to suit is the law in Alabama: Suits are permitted in certain limited circumstances (see *Ex parte Wilcox Cty. Bd. of Educ.*, 279 So. 3d 1135 (Ala. 2018)). Article I, section 14 of the state's constitution provides that the state "shall never be made a defendant in any court of law or equity," and the state's Supreme Court has said that immunity is a wall that "is nearly impregnable." *Patterson v. Gladwin Corp.*, 835 So. 2d. 137, 142 (Ala. 2002). Nevertheless, parties can bring claims before the Board of Adjustment, which considers, among other issues, "[a]ll claims for damages to the person or property growing out of any injury done to either the person or property by the State of Alabama or any of its agencies, commissions, boards ... " ALA. CODE § 41-9-62 (1994).
- 57 See, e.g., ARK. CODE ANN. § 19-10-204 (2019); CONN. GEN. STAT. § 4-142 (2016); 705 ILL. COMP. STAT. 505/8 (2018); and KY. REV. STAT. ANN. § 49.120 (West 2017).
- 58 See, e.g., FLA. STAT. § 768.28 (5) (2017), setting recovery limit at \$200,000 per claimant and \$300,000 per occurrence, with any higher amounts requiring legislative approval; KAN. STAT. ANN. § 75-6105 (1987), setting a per occurrence limit of \$500,000.
- 59 ARK CODE ANN. § 19-10-215 (a). Any award in excess of the maximum can be paid only upon approval of the Arkansas General Assembly.
- 60 FLA. STAT. § 768.28 (5) (2017).
- 61 705 ILL. COMP. STAT. 505/8 (d) (2018).
- 62 See e.g., IDAHO CODE § 6-904(1) (1988); ALASKA STAT. § 09.50.250.
- 63 See, e.g., GA. CODE ANN. § 50-21-24 (2018).
- 64 See e.g., IND. CODE. § 34-13-3-3 (7) (2016); DEL. CODE ANN. § 4001 (1988).
- 65 As one commenter notes, the "varying, limited waivers [of immunity] create a piecemeal system where a rights holder's options for redress depend upon the state in which there might be jurisdiction rather than the merits of the claim." ABA-IPL Section, comment at 4.

rights holder may not be made whole by the maximum available in a state with a more generous cap on awards.

But if an all-encompassing description of states' systems is not possible, it is nevertheless likely that many infringement claims would be defeated by a widely shared feature of these systems: The exclusion of discretionary acts from the scope of the waivers of state law sovereign immunity. States' improper uses of patents and trademarks are likely to have been carried out pursuant to officials' discretionary acts. Although, as one court noted, the "outer limits of the definition of 'discretionary' are murky,"⁶⁶ and states' particular definitions will vary, a common thread that seems to run through many interpretations of the term is that it refers to an act that is not performed pursuant to a preexisting set of rules or procedures. For example, the Supreme Court of Missouri found that discretionary acts require "the exercise of reason in the adaption of means to an end, and discretion in determining how or whether an act should be done or a course pursued," in contrast to ministerial acts, which are "of a clerical nature which a public officer is required to perform upon a given state of facts, in a prescribed manner, in obedience to the

mandate of legal authority, without regard to his own judgment or opinion concerning the propriety of the act to be performed."⁶⁷

It is highly unlikely that a state's adoption of a particular trademark or its use of a particular patented technology would be based on a mechanical application of a set of procedures. Instead, it would almost certainly be the result of a series of discretionary decisions.

2. Takings claims in state courts

Nearly all state constitutions include takings clauses, which provide that private property may not be taken for public use without just compensation.⁶⁸ However, states have different views as to whether an IP infringement by a state will constitute a taking under such clauses. For example, the Supreme Court of Kansas⁶⁹ observed in dicta that "[t]he protections of eminent domain extend beyond tangible property and include protection of intangible types of property such as patents, mineral rights, and contract rights."⁷⁰ Likewise, the Supreme Courts of Florida⁷¹ and Texas⁷² agreed that an infringement could constitute a taking. However, in *Smith v. Lutz*,⁷³ another Texas court ruled that an asserted improper use of a database and interface system by a

66 *Albers v. Breen*, 346 Ill. App. 3d 799, 808, 806 N.E.2d 667 (Ill. App. Ct. 2004).

67 *Rustici v. Weidemeyer*, 673 S.W.2d 762, 769 (Mo. 1984). Similarly, in *Marson v. Thomason*, 483 S.W.3d 292, 297 (Ky. 2014), the Supreme Court of Kentucky held that "[t]he distinction between discretionary acts and mandatory acts is essentially the difference between making higher-level decisions and giving orders to effectuate those decisions, and simply following orders." A further example is seen in *Coe v. Bd. of Educ. of the Town of Watertown*, 301 Conn. 112, 118, 19 A.3d 640 (2011), in which the Connecticut Supreme Court noted that "[t]he hallmark of a discretionary act is that it requires the exercise of judgement. ... In contrast, [m]inisterial refers to a duty which is to be performed in a prescribed manner without the exercise of judgement or discretion" (citations omitted).

68 See, e.g., TEX. CONST. art. I, § 17(a) ("No person's property shall be taken, damaged or destroyed for or applied to public use without adequate compensation being made ..."); K.S.A. CONST. art. 12, § 4 ("No right of way shall be appropriated to the use of any corporation, until full compensation therefor be first made in money, or secured by a deposit of money, to the owner, irrespective of any benefit from any improvement proposed by such corporation.")

69 *Creegan v. State*, 391 P.3d 36 (Kan. 2017).

70 *Creegan*, 391 P.3d at 47.

71 See *Jacobs Wind v. Dep't of Transp.*, 626 So. 2d 1333 (Fla. 1993).

72 See *Texas v. Holland*, 221 S.W.3d 639 (Tex. 2007).

73 *Smith v. Lutz*, 149 S.W.3d 752, 760-61 (Tex. App. 2004).

state university did not constitute a taking because the university obtained the software pursuant to a contract: When a state acts pursuant to a colorable contractual right, it is not engaging in a taking under eminent domain.⁷⁴ Applying a different rationale, in *Schneider v. Northeast Hospital Authority*,⁷⁵ another Texas court held that although trademarks are property, they cannot be classified as such for purposes of the takings clause of the Texas state constitution.

In addition, as one commenter noted, another more recent decision from Texas casts doubt on whether courts in that state will find that patent and trademark infringements by the state constitute takings.⁷⁶ In *University of Houston Sys. v. Jim Olive Photography*,⁷⁷ the Texas Court of Appeals held that a plaintiff could not assert

that an alleged infringement of a copyright was a taking because it never deprived the plaintiff of his right to use the copyrighted material. The Supreme Court of Texas recently affirmed this decision.⁷⁸

3. Tort and contract claims in state courts

The likelihood that patent and trademark rights holders can look to tort remedies to recover against state infringers appears to be uncertain and varies from state to state. On the one hand, state courts will sometimes entertain claims for unjust enrichment⁷⁹ and unfair competition.⁸⁰ On the other hand, as several commenters have observed, another tort theory, conversion, may also be unavailable, because state courts have typically held that it does not apply to intangible property rights.⁸¹ Moreover, as

74 See also *Holland*, 221 S.W.3d at 643 (Tex. 2007). (“When the government acts pursuant to colorable contract rights, it lacks the necessary intent to take under its eminent-domain powers and thus retains its immunity from suit.”)

75 *Schneider v. Northeast Hospital Authority*, No. 01-96-01098-CV, 1998 WL 834346 (Tex. App.-Houston [1st Dist.] Nov. 25, 1998, pet. denied). See also *Univ. of Houston Sys. v. Jim Olive Photography*, 580 S.W.3d 360 (Tex. App.-Houston [1st Dist.] 2019), aff’d, ___ S.W.3d ___, No. 19-0605, 2021 WL 2483766 (Tex. June 18, 2021).

76 PhRMA, comment at 32-33.

77 *Univ. of Houston Sys.*, 580 S.W.3d at 360, aff’d. ___ S.W.3d ___, 2021 WL 2483766 (Tex. June 18, 2021).

78 Notably, although the Supreme Court of Texas affirmed the Court of Appeals’ decision, its ruling appears not to preclude the possibility that in the future, a takings claim in a copyright action could succeed. In particular, the concurring opinion stressed that the plaintiff could perhaps have succeeded in its claim for compensation if it had pointed to language in the Texas Constitution that goes beyond typical “takings” provisions in state constitutions and provides that “[n]o person’s property shall be taken, damaged or destroyed for or applied to public use without adequate compensation.” *Jim Olive*, 2021 WL 2483766, slip op. at 9, (Busby, J., concurring), citing Tex. CONST. art. I § 17(a).

79 See, e.g., *Leone v. Ohio Lottery Comm’n*, No. 13AP-307, 2013 WL 5675367 (Ohio Ct. App., Oct. 17, 2013) (where the court considered—but rejected on the basis of evidence—a claim that the state lottery commission’s alleged copying of a game for which a patent had at one time been sought amounted to unjust enrichment); *Qaddura v. Indo-European Foods, Inc.*, 141 S.W.3d 882 (Tex. App. 2004); *Nw. Motorsport, Inc. v. Sunset Chevrolet, Inc.*, 14 Wash. App. 2d 1057 (Wash. App. 2020); *United Brake Sys., Inc. v. American Environmental Protection, Inc.*, 963 S.W.2d 749 (Tenn. Ct. App.) 1997.

80 See, e.g., *Willowbrook Home Health Care Agency, Inc. v. Willow Brook Retirement Ctr.*, 769 S.W.2d 862 (Tenn. Ct. App. 1989); *Wood v. Wood’s Homes, Inc.*, 519 P.2d 1212 (Colo. App. 1974).

81 AIPLA, comment at 10; PhRMA, comment at 32. Findings that claims of conversion are not available with respect to intangible property indeed appear to be widespread. See, e.g., *Beardmore v. Jacobsen*, 131 F. Supp. 3d 656 (S.D. Tex. 2015) (Conversion is outside the scope of Texas law where the property in question is intellectual rather than tangible property.); *Neles-Jamesbury, Inc. v. Bill’s Valves*, 974 F. Supp. 979 (S.D. Tex. 1997) (Texas does not recognize a claim of conversion for a trademark.); *Margae, Inc. v. Clear Link Technologies, LLC*, 620 F. Supp. 2d 1284, 1287 (D. Utah 2009) (Although no Utah state courts appeared to have decided the question, the court was “convinced that Utah would not allow a conversion claim for intangible intellectual property.”); *Struzziero v. Lifetouch Nat. Sch. Studios, Inc.*, 677 F. Supp. 2d 350, 354 (D. Mass. 2009) (“[p]ursuant to Massachusetts law, conversion claims do not extend to intangible property”); *3D Global Solutions, Inc. v. MVM, Inc.*, 552 F. Supp. 2d 1, 10 (citations omitted) (D.D.C. 2008) (“Neither District of Columbia nor Virginia law recognizes a cause of action for conversion of intangible property.”). See also *Pettit v. Arizona Bd. of Regents*, 2006 WL 8422968 (D. Ariz. 2006) (Although a claim of conversion can be asserted with respect to intangible property if that property is merged into a tangible document that has value as property, a “patent application does not constitute intangible property merged with a document in the same sense as a stock certificate or insurance policy” (citations omitted); *Hetronic Int’l, Inc. v. Hetronic Germany GmbH*, Case No. CIV-14-650 (W.D. Okla. 2015) (noting that “[t]he Supreme Court of Oklahoma has not recognized a conversion claim for intellectual property”). *But cf. Adelos Inc. v. Halliburton Co.*, 2017 WL 3836145 (D. Mont. 2017) (A conversion claim was not

one commenter noted, some states, while waiving sovereign immunity, do not include intentional torts within the scope of those waivers.⁸²

In addition to tort claims, patent and trademark rights holders who believe their rights have been infringed by states can potentially pursue contract actions in state courts. It appears that states typically waive state sovereign immunity for breach of contract claims by statute or have been found by judicial rulings to have done so.⁸³ However, the availability of this remedy depends on the existence of a contract to which rights holders can point.

4. State law trademark infringement claims

Finally, it is noted that virtually all states allow trademark owners to obtain state trademark registrations⁸⁴ and provide a

cause of action for trademark infringement.⁸⁵ Moreover, these state-based trademark protections typically mirror federal trademark law.⁸⁶ Hence, state trademark laws provide a potential avenue of recovery for trademark rights holders who assert that a state entity has infringed its trademark. However, rights holders who pursue that route of recovery may encounter some of the obstacles described earlier, including state defendants' successful assertions of state law sovereign immunity.⁸⁷ Moreover, state law-based trademark remedies, by their nature, are not as far-reaching as corresponding federal remedies, which potentially provide nationwide protection.

D. Injunctions against state officials in federal court

An additional avenue for IP rights holders asserting infringement by state entities is

dismissed on the grounds that the intellectual property in question was intangible because that "property has been merged or 'represented' by documents [namely, the plaintiff's] patents and patent applications."). Likewise, other courts have found that a conversion claim can be brought with respect to certain forms of intangible property. See, e.g., *Multi-Family Development, L.L.C. v. Crestdale Associates, Ltd.*, 193 P.3d 536 (Nev. 2008) (Nevada Supreme Court explicitly rejects the notion that personal property must be tangible to be capable of being converted.); *Kremen v. Cohen*, 337 F.3d 1024 (9th Cir. 2013) (An internet domain name is a type of intangible property that can be a basis for a conversion claim under California law.); and *Missouri Ozarks Radio, Network, Inc. v. Baugh*, 598 S.W.3d 154 (Mo. Ct. App. 2020).

82 AIPLA, comment at 10, citing, *inter alia*, Mass. GEN. LAWS ch. 258, § 10 (2005); and N.H. REV. STAT. ANN. § 541-B:19 (1985).

83 See, e.g., ALASKA STAT. ANN. § 09.50.250 (permitting "[a] person or corporation having a contract, quasi-contract, or tort claim against the state [to] bring an action against the state in a state court that has jurisdiction over the claim"); *Pan-Am Tobacco Corp. v. Dep't of Corrections*, 471 So.2d 4 (Fla. 1984) (Florida Supreme Court ruling that state's authorization to enter into commercial contracts acts as an implied waiver of immunity and subjects the state to ordinary contract liability); GA. CODE ANN. § 50-21-1 (1982) (waiving sovereign immunity "as to any action ex contractu for the breach of any written contract existing on April 12, 1982, or thereafter entered into by the state, departments and agencies of the state, and state authorities"); 705 ILL. COMP. STAT. § 505/8 (b) (2018) (granting the Illinois Court of Claims jurisdiction to hear "[a]ll claims against the State founded upon any contract entered into with the State of Illinois"); IND. CODE § 34-13-1-1 (a) (1998) (allowing suit against the state for any claim arising out of an express or implied contract, if brought within 10 years from accrual of the claim); KY. REV. STAT. ANN. § 45A.245 (1) (1978) (providing, *inter alia*, that breach of contract claims may be brought against the state and that "[a]ll defenses in law or equity, except the defense of governmental immunity, shall be preserved to the Commonwealth"); MD. CODE ANN., State Govt. § 12-201 (a) (1984) (provides that "[e]xcept as otherwise expressly provided by a law of the State, the State, its officers, and its units may not raise the defense of sovereign immunity in a contract action, in a court of the State, based on a written contract"); N.J. STAT. ANN. § 59:13-3 (1972) (state "waives its sovereign immunity from liability arising out of an express contract or a contract implied in fact"); *Smith v. State*, 222 S.E.2d 412 (N.C. 1976) (North Carolina Supreme Court ruling that state implicitly consents to be sued for damages on a contract if it breaches it).

84 See, e.g., ALA. CODE § 8-12-7 (1988); ARK. CODE ANN. § 4-71-202 (1997); COLO. REV. STAT. § 7-70-102 (2009); 765 ILL. COMP. STAT. 1036/10 (2009); IND. CODE § 24-2-1-3 (1986).

85 See, e.g., ALASKA STAT. § 45.50.170 (1961); ARIZ. REV. STAT. ANN. § 44-1451 (1998); CAL. BUS. & PROF. CODE § 14245(a) (2009); CONN. GEN. STAT. § 35-11i (1993); DEL. CODE ANN. § 3314(b)-(i) (1997); FLA. STAT. § 495.141 (2007); GA. CODE ANN. § 10-1-450 (1988); HAW. REV. STAT. § 482-31 (2008); IDAHO CODE § 48-514 (1996); and KAN. STAT. ANN. § 81.215 (1999).

86 J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:1.50 (5th ed. 2021).

87 See *Arkansas Lottery Commission v. Alpha Marketing*, 2013 Ark. 232, 428 S.W.3d 415 (Ark. 2014); and *Kyle v. Georgia Lottery Corp.*, 290 Ga. 87, 718 S.E.2d 801 (2011). In both cases, plaintiffs' causes of action included state law trademark claims, and in both, assertions of sovereign immunity were successful.

to seek injunctions against state officials in federal court. Under the *Ex parte Young* doctrine,⁸⁸ private parties may bring suits against state officials for injunctive or declaratory relief to prevent violations of federal law.⁸⁹

Courts have found that violations of IP rights can be enjoined under the *Ex parte Young* doctrine,⁹⁰ and one commenter suggested that the availability of these injunctions obviates any need to abrogate sovereign immunity.⁹¹ By contrast, most other commenters noted that there are limitations inherent to this remedy.⁹² In particular, they point to the requirement that for an injunction to be granted, the plaintiff must demonstrate that there is an ongoing violation of law that is attributable to the official named as a defendant, a showing that can be difficult to make. They further note that injunctive relief is prospective and unlike other remedies, including, for example, ones that provide for treble damages, does not compensate the rights holder for past monetary and reputational harm or for loss of goodwill.⁹³

One commenter suggested that because of these limitations, patentees rarely seek *Ex parte Young*⁹⁴ injunctions to vindicate

their rights. Likewise, another commenter, describing its own experience, reported that in one case, it declined to bring suit against the operators of a state university it believed was infringing its trademark, in part because it determined that the “efficacy” of doing so was “dubious.”⁹⁵

All this suggests that for plaintiffs precluded from suing for damages in federal courts, the availability of injunctions, although potentially beneficial, is not a sufficient substitute for such suits.

Finally, one commenter proposed that Congress could enact legislative changes that would transform *Ex parte Young* injunctions into a more robust remedy in IP infringement cases.⁹⁶ In that commenter’s view, the relative dearth of IP cases in which injunctions are sought may result, in part, from the absence of uniform rulings among the judicial circuits, including with respect to the question of whether a state official’s connection to the alleged infringement is sufficiently close to render the official liable. The commenter suggests that Congress should therefore consider legislation to standardize adjudication of *Ex parte Young* claims across the circuits.

88 *Ex parte Young*, 209 U.S. 123 (1908).

89 See, e.g., *City of Austin v. Paxton*, 943 F.3d 993 (5th Cir. 2019). Likewise, in general, injunctions appear to be available in state courts, notwithstanding state sovereign immunity, if the acts sought to be enjoined are allegedly ultra vires, contrary to law or unconstitutional. See, e.g., *Arkansas Tech Univ. v. Link*, 17 S.W.3d 809 (Ark. 2000); *City of El Paso v. Heinrich*, 284 S.W.3d 366 (Tex. 2009); *Burch v. Birdsong*, 181 So. 3d 343 (Ala. Civ. App. 2015); *White Deer Indep. Sch. Dist. v. Martin*, 596 S.W.3d 855 (Tex. App. 2019).

90 See, e.g., *Pennington Seed, Inc. v. Produce Exch. No. 299*, 457 F.3d 1334 (Fed. Cir. 2006).

91 APLU, comment at 5.

92 ABA-IPL Section, comment at 3-4; PhRMA, comment at 34; AIPLA, comment at 7.

93 ABA-IPL Section, comment at 4; AIPLA, comment at 8. AIPLA does observe that, theoretically, monetary damages could be assessed against state officials, but notes that there appear to be no instances in which such an award was issued in a patent or trademark infringement claim against a state official.

94 AIPLA, comment at 6.

95 Liberty University, comment at 3.

96 AIPLA, comment at 7-8.

VI. Some policy considerations identified by commenters

Commenters advanced various policy arguments, some in support of abrogating state sovereign immunity for patent and trademark infringement, others in support of continuing it.⁹⁷

A. The role of public universities

Two commenters representing, respectively, a nonprofit research park operated by a state university⁹⁸ and an association of public research universities, state university systems, and affiliated organizations,⁹⁹ suggested that public universities' immunity from IP infringement suits provided benefits to public universities and, by extension, to the public at large. Both noted that public universities play critical roles in furthering U.S. innovation, including through the mechanisms provided for by the Bayh-Dole Act of 1980,¹⁰⁰ and that abrogation of sovereign immunity would undermine those efforts. For example, these commenters remarked that, in the absence of sovereign immunity, funds that would otherwise be spent on research and development and educational missions would instead be used to defend against frivolous infringement claims, according to one of

these commenters,¹⁰¹ or against “nuisance value patent infringement claims” by patent assertion entities, according to the other.¹⁰²

Both commenters also suggest that a lifting of sovereign immunity for patent infringement would be of limited benefit to potential plaintiffs. Their reasoning is that because patent infringement by universities would likely be non-commercial in nature, the recovery would be minimal.¹⁰³ In addition, one of these commenters opined that under the Bayh-Dole scheme, universities commercialize technologies by licensing to non-state business entities and that aggrieved patent holders have the option of suing these non-state licensees.¹⁰⁴

Both of these commenters also suggested that the enactment of the 11th Amendment was key to the establishment of the nation and to the division of sovereignty between the federal government and the states,¹⁰⁵ and that the circumstances do not justify an abrogation of this immunity when patent infringement is concerned.¹⁰⁶ In the view of one of these commenters, Congress should pass legislation to “reaffirm and restore” state sovereign immunity.¹⁰⁷

97 The USPTO takes no position on the merits of these comments.

98 UNM, comment.

99 APLU, comment.

100 See UNM, submission at 2; APLU, submission at 2-3.

101 APLU, submission at 4.

102 UNM, submission at 4. UNM also reports (UNM, submission at 3-4) that shortly following the Federal Circuit's holding in *Regents of Univ. of Minn. v. LSI Corp.*, 926 F.3d 1327 (Fed. Cir. 2019), cert. denied, 140 S. Ct. 908 (2020), that sovereign immunity did not bar petitions against state entities seeking cancellation of patent claims at the Patent Trial and Appeal Board, the Board was the object of a sudden rush of such petitions. It argues that this trend suggests that an abrogation or diminishment of state sovereign immunity would harm state universities.

103 UNM, submission at 6; APLU, submission at 4.

104 APLU, submission at 5. As noted below, however (see page 16), another commenter argued, in contrast, that suits against private parties are sometimes dismissed when state entities are deemed to be indispensable but, because of the protections afforded them by sovereign immunity, are not amenable to suit.

105 UNM, submission at 7; APLU, submission at 5-8.

106 UNM, submission at 7; APLU, submission at 7.

107 UNM, submission at 7.

Finally, one of these commenters,¹⁰⁸ as well as another,¹⁰⁹ suggested that the shield provided by sovereign immunity protected universities from liability for unintentional infringement that may occur in the course of research and experimentation.

B. Developments in the generic pharmaceutical industry

Two pharmaceutical industry organizations that submitted comments suggested that because recent trends at the state legislative level could lead certain states to become involved in the manufacture of generic and biosimilar drugs, abrogation of state sovereign immunity is advisable.¹¹⁰ Both commenters pointed to the California Affordable Drug Manufacturing Act of 2020,¹¹¹ which they believe could involve the state in the manufacture of generic drugs.¹¹² In addition, both reported that other states are contemplating adopting similar measures.

One of these commenters states, generally, that these measures can ultimately “implicate” the question of patent infringement by states, and reports that there have been suggestions that states could invoke sovereign immunity to circumvent patent rights.¹¹³ The other commenter argues more broadly that states’ possible entries into the generic drug market, combined with the protection afforded them by sovereign immunity, could “upend the

generic marketplace and raise prescription drug prices.”¹¹⁴ In that commenter’s view, the regulatory framework through which the Food and Drug Administration (FDA) considers requests to approve the marketing of generic drugs, coupled with sovereign immunity, endows would-be state producers of generic drugs with unfair advantages relative to other generic producers.

Briefly summarized, the commenter’s argument is as follows:¹¹⁵ Under FDA regulations, if a generic manufacturer seeks approval to market a drug covered by a patent before the patent’s expiration, then a process is triggered whereby, if the patent owner commences suit within 45 days, the generic manufacturer will not be granted marketing approval until the sooner of 30 months or the suit’s dismissal. The commenter suggests that, on the basis of sovereign immunity, states that manufacture generic drugs may be able to obtain speedy dismissals of the patent suits, thereby enabling them to enter the market well in advance of their private sector competitors.

The commenter further suggests that even if the state manufacturer does not enter the market ahead of others, sovereign immunity will provide the state entity with certain advantages. For example, in the commenter’s view, if a private manufacturer prevails in an infringement suit and then takes its drug to market, it risks suffering a reversal of the

108 *Id.* at 4-5.

109 Knowledge Ecology International, submission.

110 See PhRMA, comment at 21-22; Association for Accessible Medicines (hereinafter AAM), comment at 1-6.

111 CAL. HEALTH & SAFETY CODE § 127690 et seq. (2020).

112 PhRMA, submission at 21; AAM, submission at 2. The two commenters offer somewhat different interpretations of the statute. One states that the statute authorizes the state to produce biosimilars, biosimilar insulins, and generic drugs (PhRMA, submission at 21), and the other notes that the statute envisions that a state agency will partner with drug manufacturers, but it is unclear about the roles of each partner. The USPTO takes no position regarding the proper interpretation of the statute with respect to this or any other matter.

113 PhRMA, submission at 21-22.

114 AAM, submission at 1.

115 See AAM, submission at 3-4.

favorable ruling on appeal and then being subject to damages. By contrast, according to the commenter, a state manufacturer of generics would only be subject to injunctions, not to damages, and therefore is able to enter the market with considerably less risk than private manufacturers. The commenter believes that the advantages state manufacturers enjoy can lead to various unwelcome outcomes, including higher prices for consumers and possible exposure of physicians and patients to lawsuits, because in the commenter's view, plaintiffs could sue them for patent infringement in the absence of a manufacturer-defendant.¹¹⁶

In addition, one of these commenters urged, more generally, that states' immunity from IP infringement suits produces outcomes that the commenter believes should be avoided, including (1) allowing non-state defendants to escape exposure to potential liability or unfavorable declaratory judgment rulings when a state entity is deemed both indispensable and beyond the reach of the court because of sovereign immunity, (2) motivating states to assert sovereign immunity in administrative forums in which it is sometimes not available, and (3) imposing adverse financial effects on inventors.¹¹⁷

C. Other policy and related comments

One commenter suggested that this study should consider whether states' patent and trademark infringements could be addressed through mechanisms other than a statutory abrogation of immunity.¹¹⁸ In

that commenter's view, the burden for establishing the constitutionality of such a statute is high, and therefore, this study should consider whether states should be incentivized to avoid infringing trademarks, for example, through the imposition of penalties for failure to properly clear trademarks before using them.

Another commenter suggested that a benefit of continued sovereign immunity from IP infringement suits is that it can enable states to thwart legal challenges by patent assertion entities.¹¹⁹ In this commenter's view, states could establish "patent protection exchanges" through which states would purchase companies' products, distribute them, and thereby, in the commenter's view (1) free the company from possible patent-infringement liability for any sales and (2) prevent an actual suit for damages by a patent assertion entity, because the sole distributor of the product—that is, the "patent protection exchange"—would enjoy sovereign immunity. By contrast, other commenters urged that the availability of sovereign immunity as a defense in patent and trademark infringement cases can lead to significant harms.

One commenter argued that the defense enables state entities to use it as a sword rather than a shield,¹²⁰ including (1) as a means to avoid being joined as a voluntary plaintiff in a proceeding, resulting in the dismissal of an entire case;¹²¹ (2) as a basis for asserting, albeit unsuccessfully,

116 *Id.* at 4.

117 PhRMA, submission at 9-14.

118 ABA-IPL, comment at 5.

119 Mark Kofsky, comment.

120 PhRMA, comment at 9, citing *Bd. of Regents v. Medtronic PLC*, No. A-17-cv-0942-LY, 2018 WL 2353788 (W.D. Tex. May 17, 2018), vacated in part, 2018 WL 4179080 (W.D. Tex. Jul. 19, 2018).

121 PhRMA, comment at 10, citing *Gensetix, Inc. v. Bd. of Regents of Univ. of Texas Sys.*, 966 F.3d 1316 (Fed. Cir. 2020).

that sovereign immunity entitles a state entity to the dismissal of a counterclaim for invalidity in an infringement suit that the state entity had brought,¹²² and (3) as a basis for asserting, again unsuccessfully, that a state entity should be exempt from invalidity claims in inter partes reviews at the Patent Trial and Appeal Board.¹²³

That commenter also suggested that non-state entities can exploit the sovereign immunity defense, citing as an example a case in which a non-state defendant in an infringement suit moved to dismiss the suit on the ground that the allegedly infringing products were for use by a sovereign state.¹²⁴ In addition, the commenter believes that the defense can prevent inventors from suing state entities to enforce royalty contracts.¹²⁵

VII. Conclusions

On the basis of USPTO-conducted research and stakeholder information, for the period running from 1985 to the present, there are 49 instances in which a state was said to have infringed a patent and 29 in which a state was said to have infringed a trademark. This figure is likely less than the actual number of such assertions: it is heavily, though not exclusively, based on records of litigated disputes, and many disputes with states are not litigated. Some are never pursued, and others are resolved through various means that keep them away from public view, including confidential settlements. However, commenters identified relatively few instances of asserted infringement that were not litigated and that are not otherwise in the public record, and this suggests that the number of asserted state infringements may not be substantially greater than the numbers we identified.

It is unclear whether the level of identified assertions of state patent and trademark infringement constitute a widespread and persisting phenomenon. While the Supreme Court has held that this level of infringement must be present in order for Congress to abrogate sovereign immunity for infringements, it has not provided a guidepost as to how this level should be defined. Therefore, the record does not allow conclusions as to whether state infringement of patents and trademarks, when it occurs, is intentional or reckless.

Finally, it is likely that patent and trademark right holders will often encounter significant obstacles if they seek redress under state law for state infringements.

122 PhRMA, comment at 11, citing *Univ. of Florida Found., Inc. v. Gen. Elec. Co.*, 916 F.3d 1363 (Fed. Cir. 2019).

123 PhRMA, comment at 11, citing *Regents of Univ. of Minnesota v. LSI Corp.* (Fed. Cir. 2019).

124 PhRMA, comment at 13, citing *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, No. 6:09-cv-1968-Orl-19KRS, 2010 WL 2243727 (M.D. Fla. Jun. 4, 2020).

125 PhRMA, comment at 13, citing *Sedaghat-Herati v. Bd. of Trustees of Univ. of Alabama*, No. 5:08-cv-01304-UWC (N.D. Ala. Jan. 28, 2009).

VIII. Appendix A

Letter to the USPTO from Senators Leahy and Tillis

United States Senate
WASHINGTON, DC 20510

VIA ELECTRONIC TRANSMISSION

April 28, 2020

The Honorable Andrei Iancu
Director
United States Patent and Trademark Office
600 Dulany Street, Madison East
Alexandria, VA 22314

Dear Director Iancu:

The Supreme Court’s ruling last month in *Allen v. Cooper* created a situation in which copyright owners are without remedy if a State infringes their copyright and claims State sovereign immunity under the Eleventh Amendment of the U.S. Constitution.¹ As we understand, this was already the case in patent law and some aspects of federal trademark law following two Supreme Court decisions in 1999. We are concerned about the impact this may have on American creators and innovators, and we would like for the Patent and Trademark Office to research this issue to determine whether there is sufficient basis for federal legislation abrogating State sovereign immunity when States infringe patents or trademarks. We also are asking the Copyright Office to advise on the pervasiveness and prevalence of States’ infringements of copyrights.

As you know, *Allen v. Cooper* involved a challenge to the constitutionality of the Copyright Remedy Clarification Act (CRCA),² which Congress enacted in 1990 to abrogate State sovereign immunity for copyright infringement and establish that a State would be liable “in the same manner and to the same extent” as a private party under copyright law. The Supreme Court found the CRCA was unconstitutional because it applied to all infringements of copyright by States, not just unconstitutional infringements. The Supreme Court said its decision was largely predetermined by the precedent set in its 1999 opinion in *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, in which the court held that Congress can abrogate State sovereign immunity from patent infringement claims under Section 5 of the Fourteenth Amendment, but not Article I, only if abrogation is limited in scope and remedies a pervasive and unredressed constitutional violation.³ The Court did not discuss the related 1999

¹ See *Allen v. Cooper*, No. 18–877 (Mar. 23, 2020).

² Pub. L. No. 101-553, 104 Stat. 2749 (1990).

³ 527 U.S. 627 (1999).

decision in *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*, which involved the Lanham Act.⁴

But *Allen v. Cooper* provided Congress a blueprint for how to validly abrogate State sovereign immunity from certain patent and trademark infringement claims. One element that the Court pointed to was the importance of Congress identifying a pattern of unconstitutional infringement before enactment. It is on this point that we request the Patent and Trademark Office's expertise and advice.

We ask that the Patent and Trademark Office study the extent to which patent or trademark owners are experiencing infringements by state entities without adequate remedies under state law. As part of this analysis, the Patent and Trademark Office should consider the extent to which such infringements appear to be based on intentional or reckless conduct.

So that Congress can evaluate whether legislative action needs to be taken, please provide a public report summarizing the findings of your study, as well as the facts and analyses upon which those findings are based, no later than April 30, 2021. Thank you for your careful attention to this matter. If you have any questions, please do not hesitate to contact me.

Sincerely,

Handwritten signatures of Thom Tillis and Patrick Leahy in blue ink. The signature of Thom Tillis is on the left and the signature of Patrick Leahy is on the right.

Thom Tillis
United States Senator

Patrick Leahy
United States Senator

⁴ 527 U.S. 666 (1999).

IX. Appendix B

Litigated Patent and Trademark Infringement Disputes Involving States or State Entities

| Patent Cases | |
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| 1. | A.C. Aukerman Co. v. Texas, 902 S.W.2d 576 (Tex. App. 1995) |
| 2. | ArrivalStar S.A. v. Maryland Transit Admin., No. 1:11-cv-00761 (D. Md., filed March 22, 2011) |
| 3. | ArrivalStar S.A. v. Massachusetts Bay Transp. Auth., No. 1:10-cv-10456 (D. Mass., filed March 17, 2010) |
| 4. | ArrivalStar S.A. v. Ne. Illinois Reg'l Commuter R.R. Corp., No. 1:11-cv-01502 (N.D. Ill., filed March 3, 2011) |
| 5. | Baum Research and Dev. Corp. v. Univ. of Massachusetts at Lowell, 503 F.3d 1367 (Fed. Cir. 2007) |
| 6. | Biomedical Patent Mgmt. v. California Dep't. of Health Services, 505 F.3d 1328 (Fed. Cir. 2007) |
| 7. | Brown v. Baylor Health Care Sys., 662 F. Supp. 2d 669 (S.D. Tex. 2009) |
| 8. | Chew v. California, 893 F.2d 331 (Fed. Cir. 1990) |
| 9. | Cook Group, Inc. v. Purdue Research Found., No. IP 02-0406-C-M/S, 2002 WL 1610951 (S.D. Ind. June 24, 2002) |
| 10. | Digestor, LLC. v. Powers, No. 1:10-cv-01841 (D. Colo., filed August 3, 2010) |
| 11. | Emergis Technologies, Inc. v. South Carolina Pub. Serv. Auth., No. 2:06-cv-00735 (D.S.C., filed March 9, 2006) |
| 12. | Emtel, Inc. v. Coastal Family Health Ctr., Inc., No. 3:12-cv-00100, 2012 WL 12857221 (S.D. Miss., filed February 14, 2012) |
| 13. | Gen-Probe, Inc. v. Amoco Corp., 926 F. Supp. 948 (S.D. Cal. 1996) |
| 14. | Grid Innovations v. Elec. Reliability Council of Texas, No. 1:17-cv-00234 (W.D. Tex., filed March 14, 2017) |

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| 15. | Hawk Tech. Sys., LLC v. Centinela Valley Union High Sch. Dist., No. 2:16-cv-03568 (C.D. Cal., filed May 23, 2016) |
| 16. | Hawk Tech. Sys., LLC v. Penn. State Univ., No. 4:14-cv-839 (M.D. Pa., filed April 30, 2014) |
| 17. | Hawk Tech. Sys., LLC v. Univ. Health Sys. of Eastern North Carolina, Inc., No. 4:15-cv-00194 (E.D.N.C., filed December 9, 2015) |
| 18. | Hawk Tech. Sys., LLC v. Univ. of Maryland St. Joseph Med. Ctr., No. 1:16-cv-00535 (D. Md., filed February 24, 2016) |
| 19. | Hildebrand v. Henderson Truck Equip., No. 1:15-cv-00486 (D. Colo., filed March 6, 2015) |
| 20. | Human Biologics v. Xenotech, LLC, No. 2:96-cv-1184 (D. Ariz., filed May 15, 1996) |
| 21. | IT Aire, Inc. v. Oregon Health & Science Univ., No. 3:16-cv-01797 (D. Or., filed September 10, 2016) |
| 22. | Jacobs Wind Elec. Co. v. Florida Dep't of Transp., 919 F.2d 726 (Fed. Cir. 1990) |
| 23. | Kersavage v. Univ. of Tennessee, 731 F. Supp. 1327 (E.D. Tenn. 1989) |
| 24. | LBH Engineers, LLC v. Archer Western Contractors, LLC, No. 1:19-cv-04477, 2020 WL 4559707 (N.D. Ga., filed October 4, 2019) |
| 25. | Margaritis v. Global Construction, No. 3:97-cv-03301 (D.N.J., filed June 30, 1997) |
| 26. | Margaritis v. Industrial Enterprise Sandblast and Paint, Inc., No. 3:97-cv-03303 (D.N.J., filed June 30, 1997) |
| 27. | Margaritis et al. v. Kazanas Industrial et al. No. 2:96-cv-01020 (N.D. Iowa, filed May 9, 1996) |
| 28. | Margaritis v. North Star Painting, No. 4:95-cv-01478 (N.D. Ohio, filed July 6, 1995) |
| 29. | Martin Marietta Materials, Inc. v. Bedford Reinforced Plastics, Inc., No. 5:02-cv-00933 (E.D. N.C., filed December 20, 2002) and No. 3:03-cv-0057 (W.D. Pa., filed March 17, 2003) |

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| 30. | MH Systems, Inc. v. Peter McNulty, No. 2:05-cv-07263, 2008 WL 5548113 (C.D. Cal., filed October 6, 2005) |
| 31. | NeuroGraphix v. Regents of the Univ. of California, No. 2:11-cv-7591 (C.D. Cal., filed September 14, 2011) |
| 32. | Next Generation, Inc. v. Niagara Frontier Transp. Auth., No. 1:00-cv-01044 (W.D.N.Y., filed December 20, 2000) |
| 33. | Paperless Accounting, Inc. v. Mass Transit Admin., Civil No. HAR 84-2922 (D. Md. 1985) |
| 34. | Parking Security Sys. Corp. v. Massachusetts Port Auth., No. 1:08-cv-10578 (D. Mass, filed April 7, 2008) |
| 35. | Parking Security Sys. Corp. v. Metropolitan Washington Airports Authority, No. 3:08-cv-00192 (E.D. Va., filed March 26, 2008) |
| 36. | Pennington Seed, Inc. v. Produce Exch. No. 299, 457 F.3d 1334 (Fed. Cir. 2006) |
| 37. | Peralta v. California Franchise Tax Bd., 124 F. Supp. 3d 993 (N.D. Cal. 2015) |
| 38. | ProBatter Sports, LLC v. Joyner Tech., Inc., No. 6:05-cv-2045 (N.D. Iowa, filed May 17, 2005) |
| 39. | Progressive Angioplasty Systems, Inc. v. Medtronic Interventional Vascular, Inc., No. 3:94-cv-196 (S.D. Cal., filed February 8, 1994), appeal voluntarily dismissed, 57 F.3d 1082 (Fed. Cir. 1995) |
| 40. | Progressive Games, Inc. v. Shuffle Master, Inc., 69 F. Supp. 2d 1274 (D. Nev. 1999) |
| 41. | Sharafabadi v. Univ. of Idaho, No. C09-1043JLR (W.D. Wash. November 27, 2009) |
| 42. | State Contracting Engineering Corp. v. Florida, 258 F.3d 1329 (Fed. Cir. 2001) |
| 43. | Texas v. Holland, 221 S.W.3d 639 (Tex. 2007) |
| 44. | Tet Systems GMBH & Co. KG. v. Univ. of California Irvine, No. 1:13-cv-02056 (D. Del., filed May 22, 2014) |
| 45. | Toco v. Pennsylvania State Univ., No. 4:98-cv-00531 (M.D. Pa., filed March 31, 1998) |

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| 46. | Trizen Systems, Inc. v. Software AG, Inc., No. 6:02-cv-00920 (M.D. Fla., filed August 9, 2002) |
| 47. | Wilcox Industries v. Ohio, 79 Ohio App. 3d 403 (Ohio Ct. App. 1992) |
| 48. | Wordtech Sys., Inc. v. Integrated Network Solutions, Inc., No. 2:04-cv-01971 (E.D. Cal., filed December 6, 2007) |
| Trademark Cases | |
| 49. | Anger Sports, LLC v. Rutgers, the State University, No. 3:17-cv-08015 (D.N.J., filed October 9, 2017) |
| 50. | Arkansas Lottery Commission v. Alpha Marketing, 428 S.W.3d 415 (Ark. 2013) |
| 51. | Bd. of Regents of the Univ. of Wisconsin v. Phoenix Int'l. Software, 653 F.3d 448 (7th Cir. 2011) |
| 52. | Dynamic Measurement Group, Inc. v. Univ. of Oregon, No. 6:14-cv-01295 (D. Or. filed August 12, 2014) |
| 53. | eScholar v. Miami University of Ohio, No. 7:12-cv-09039 (S.D.N.Y., filed December 12, 2012) |
| 54. | Fashion Institute of Design & Merchandising v. Central Michigan Univ., No. 1:20-cv-1981 (E.D.N.Y, filed April 30, 2020) |
| 55. | Florida Virtual Sch. v. ASU Prep Global Academy and Arizona State Univ., No. 6:18-cv-643 (M.D. Fla., filed April 24, 2018) |
| 56. | Food-Tek, Inc. v. Rutgers, No. 1:94-cv-1114 (D.N.J., filed March 4, 1994) |
| 57. | Force Therapeutics, LLC v. Univ. of Massachusetts Med. Sch., No. 2:17-cv-04922 (E.D. Pa., filed November 2, 2017) |
| 58. | Gameologist Group, LLC v. New York Division of Lottery, No. 102951/2009 (N.Y. Sup. Ct. December 7, 2009) |
| 59. | Greater Orlando Aviation Auth. v. Melbourne Airport Auth., No. 6:19-cv-00540 (M.D. Fla., filed March 19, 2019) |
| 60. | Healthwise, Inc. v. Regents of the University of California et al., No. 1:98-cv-0449 (D. Idaho, filed November 12, 1998) |
| 61. | Kyle v. Georgia Lottery Corp., 718 S.E.2d 801 (2011) |

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| 62. | Maryland Primary Care Physicians v. Maryland Dep't of Health and Mental Hygiene, No. 1:99-cv-604 (D. Md., filed March 2, 1999) |
| 63. | MIS Sciences Corp. v. Massachusetts Bay Transp. Auth., No. 2:13-cv-04449 (C.D. Cal., filed June 20, 2013) |
| 64. | Oklahoma Agricultural and Mechanical Colleges Bd. of Regents v. New Mexico State Univ., No. 5:14-cv-01147 (W.D. Okla., filed October 20, 2014) |
| 65. | Regent University v. Bd. of Regents of the Univ. Sys. of Georgia, No. 1:12-cv-00141 (S.D. Ga. 2012) |
| 66. | Rodriguez v. Casa Salsa Restaurant, 260 F. Supp. 2d 413 (D.P.R. 2003) |
| 67. | Schneider v. Ne. Hosp. Auth., No. 01-96-01098-CV, 1998 WL 834346 (Tex. App. Nov. 25, 1998) |
| 68. | Utah Republican Party v. Herbert, 141 F. Supp. 3d 1195 (D. Utah 2015) |