

No. 19-337

IN THE
Supreme Court of the United States

REGENTS OF THE UNIVERSITY OF MINNESOTA,
Petitioner,

v.

LSI CORPORATION, *ET AL.*,
Respondents.

**On Petition for a Writ of Certiorari to
the United States Court of Appeals
for the Federal Circuit**

BRIEF IN OPPOSITION

ADAM H. CHARNES
KILPATRICK TOWNSEND
& STOCKTON LLP
2001 Ross Avenue
Suite 4400
Dallas, TX 75201
(214) 922-7106
acharnes
@kilpatricktownsend.com

KRISTOPHER L. REED
Counsel of Record
KILPATRICK TOWNSEND
& STOCKTON LLP
1400 Wewatta St.
Suite 600
Denver, CO 80202
(303) 405-8536
kreed
@kilpatricktownsend.com

*Counsel for Respondents LSI Corporation and Avago
Technologies U.S. Inc.*

QUESTION PRESENTED

States may not invoke the shield of sovereign immunity against actions taken by the Federal Government. *Alden v. Maine*, 527 U.S. 706, 755 (1999). The grant of a patent is an action taken by the Federal Government, in particular, “patents are public franchises that the Government grants to the inventors of new and useful improvements.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1373-74 (2018). *Inter partes* review (IPR) “is simply a reconsideration of that grant.” *Id.* at 1373. While a private party supplies information to guide that reconsideration, “the decision to institute review is made by the Director and committed to his unreviewable discretion.” *Id.* at 1378 n.5; 35 U.S.C. § 314. The Director of the Patent Office also can continue an IPR without the petitioner (35 U.S.C. § 317(a)), and intervene in any appeal (35 U.S.C. § 143).

Petitioner UMN filed a lawsuit against LSI alleging infringement of a single patent. In response, LSI filed a petition for IPR asking an agency of the Federal Government to reconsider whether that patent had been erroneously granted. The Board denied a motion by UMN to dismiss the IPR on the basis of sovereign immunity. And the Federal Circuit affirmed the Board’s denial, holding that IPR simply allows the Patent Office to evaluate whether a prior grant of a public franchise was wrong.

The question presented is:

Whether the University of Minnesota can assert state sovereign immunity to stop the United States Patent Office from reconsidering a potentially erroneous patent grant.

RULE 29.6 STATEMENT

Broadcom Inc. is publicly held company that owns 10% or more and acts as the parent company of both Respondent LSI Corporation and Respondent Avago Technologies U.S. Inc.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
RULE 29.6 STATEMENT	ii
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES	iv
STATEMENT OF THE CASE.....	1
REASONS FOR DENYING THE PETITION	3
I. The Petition Repeats Arguments Already Considered By This Court in a Recent Certiorari Denial	3
II. The Federal Circuit Followed This Court’s Precedents To Identify Two Independent Bases For Affirmance of the PTAB.....	6
A. Sovereign Immunity Cannot Preclude a Federal Agency From Reconsidering Its Own Grant of a Public Franchise	6
B. IPR Is <i>In Rem</i> and Sovereign Immunity Does Not Apply	11
III. This Case Is a Poor Vehicle for Deciding the Question Presented	13
CONCLUSION.....	14

TABLE OF AUTHORITIES

	<i>Page(s)</i>
Cases	
<i>Crowell v. Benson</i> , 258 U.S. 22 (1932).....	12
<i>Federal Maritime Comm’n v. South Carolina Ports Authority</i> , 535 U.S. 743 (2002).....	4, 7-8, 9, 11
<i>Gardner v. New Jersey</i> , 329 U.S. 565 (1947).....	14
<i>Lapides v. Bd. of Regents of Univ. Sys. of Georgia</i> , 535 U.S. 613 (2002).....	14
<i>Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC</i> , 138 S. Ct. 1365 (2018).....	6
<i>Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.</i> , IPR2016-1914, Paper 23 (P.T.A.B. Mar. 3, 2017).....	13
<i>Return Mail, Inc. v. U.S. Postal Serv.</i> , No. 17-1594, Slip Op. at 14 (U.S. June 10, 2019)	7
<i>RPX Corp. v. Applications in Internet Time, LLC</i> , IPR2015-01750, 2015 WL 6157114 (P.T.A.B. Oct. 20, 2015).....	9

Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.,
896 F.3d 1322 (Fed. Cir. 2018), *cert. denied*, 139 S. Ct. 1547(2019)..... *passim*

SAS Inst., Inc. v. Iancu,
138 S. Ct. 1348 (2018)..... 7

Tenn. Student Assistance Corp. v. Hood,
541 U.S. 440 (2004)..... 12

Statutes

35 U.S.C. § 143..... 8

35 U.S.C. § 313..... 9

**BRIEF FOR RESPONDENTS LSI
CORPORATION AND AVAGO TECHNOLOGIES
U.S. INC. IN OPPOSITION**

Respondents LSI Corporation and Avago Technologies U.S. Inc. (collectively “LSI”) respectfully submit that the petition for a writ of certiorari should be denied.

STATEMENT OF THE CASE

Petitioner UMN sued respondent LSI on August 25, 2016, alleging infringement of a single patent and demanding hundreds of millions of dollars in purported damages.¹ The asserted patent expired on October 15, 2016—less than two months after UMN filed suit. Thus, far from using the “patent system to promote the utilization of inventions arising from federally supported research and development” as UMN suggests (Pet. 4), UMN seeks to extract *ex post* licensing revenue for mature technology that was commercialized long ago.

LSI subsequently petitioned for IPR, asking the Patent Office to reconsider the patentability of the asserted patent claims. Pet. App. 3a. Before the Patent Office decided whether to institute the IPR, UMN moved to dismiss the proceeding based on state sovereign immunity. *Id.* at 4a. A majority of the Board panel first concluded that sovereign immunity applies, but one judge objected stating that “[a]t its core,

¹ C.A. J.A. 251; 811.

inter partes review is a circumscribed in rem proceeding, in which the Patent Office exercises jurisdiction over the patent challenged, rather than the parties named.” Pet. App. 40a-52a. The Board ultimately denied UMN’s motion, unanimously concluding that UMN waived any claim to immunity by filing suit against LSI in district court. *Id.* at 43a-47a.

A unanimous panel of the Federal Circuit affirmed the Board’s decision, albeit on the ground that “state sovereign immunity does not apply to IPR proceedings.” Pet. App. 26a. In reaching this decision, the Federal Circuit followed “the reasoning of the majority and concurrence in *Saint Regis*” (*id.*)—a recent decision where the Federal Circuit held that “tribal sovereign immunity cannot be asserted in IPRs.” *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, 896 F.3d 1322, 1326 (Fed. Cir. 2018), *cert. denied*, 139 S. Ct. 1547(2019).

Although not constituent to its holding, the Federal Circuit seconded the view of the objecting PTAB judge, concluding that “state sovereign immunity also does not apply to IPR proceedings because they are in substance the type of in rem proceedings to which state sovereign immunity does not apply.” Pet. App. 29a-36a.

The Federal Circuit declined to reach the issue of whether “if sovereign immunity were to apply to IPR proceedings, the state here waived such immunity by asserting patent claims in district court that were later challenged in a petition for IPR.” Pet. App. 28a.

Finally, the Federal Circuit warned that “if sovereign immunity barred IPR proceedings against patents obtained by a sovereign, nothing would

prevent a state from lending its sovereign immunity to private parties,” and that “[s]uch manipulation would undo Congress’ central quality control mechanism in creating post-grant administrative proceedings.” *Id.*

UMN did not seek rehearing *en banc* of the Federal Circuit’s decision.²

REASONS FOR DENYING THE PETITION

The Federal Circuit’s decision faithfully applies this Court’s precedents regarding both sovereign immunity and IPR, and presents nothing worthy of this Court’s review. In its petition for a writ of certiorari, UMN recycles arguments from a petition this Court previously rejected, and provides no reason to question either independent basis cited by the Federal Circuit for its unanimous decision. And even if Petitioner’s question warranted review, this case would be a poor vehicle to decide it, as reversal here ultimately would have no impact on the underlying PTAB decision affirmed by the Federal Circuit.

I. The Petition Repeats Arguments Already Considered By This Court in a Recent Certiorari Denial

UMN’s petition largely repeats arguments from a certiorari petition this Court already considered and denied. In *Saint Regis*, the Federal Circuit held that

² The appellants in *Saint Regis* did petition the Federal Circuit for rehearing *en banc*, and that petition was denied without dissent. *Saint Regis Mohawk Tribe v. Mylan Pharm. Inc.*, No. 2018-1638 (October 22, 2018) (order denying petition for rehearing *en banc*).

“tribal sovereign immunity cannot be asserted in IPRs.” *Saint Regis*, 896 F.3d at 1326. In reaching that holding, the Federal Circuit carefully adhered to this Court’s decision in *FMC*—a decision involving state, not tribal, immunity. *Id.* (“Although the precise contours of tribal sovereign immunity differ from those of state sovereign immunity, the *FMC* analysis is instructive.”) The central argument in the *Saint Regis* certiorari petition was that the Federal Circuit had misapplied this Court’s precedents, especially *FMC*.³ The Court denied the *Saint Regis* petition. 139 S. Ct. 1547 (2019).

UMN’s central argument here, like in the *Saint Regis* petition, is that the Federal Circuit misapplied this Court’s precedents, especially *FMC*. *See* Pet. 15-19. UMN speculates that “[t]he Court’s denial of certiorari in *Saint Regis* no doubt reflects that the case did not squarely present the more important question—presented here—of *State* sovereign immunity to IPR and the vehicle problems specific to that litigation.” *Id.* at 33-34 n.20. But this claim is unfounded. While *Saint Regis* did concern tribal immunity, the dispositive question was the same as here: can an assertion of sovereign immunity preclude the United States Patent Office from reconsidering a potentially erroneous patent grant. On that question, there is no basis for treating tribal and state actors differently. This was expressly acknowledged by the petitioners in *Saint Regis*, who argued:

Although the Court of Appeals stated that its opinion was limited to tribal immunity, its holding turns entirely on the inherent attributes of the IPR proceeding itself,

³ *Saint Regis* Pet. 26-31.

which are the same for all IPRs. The identity of the patent owner is not relevant under the Federal Circuit's decision. Accordingly, there is no principled basis for differentiating (for purposes of sovereign immunity in IPRs) among patents owned by state entities, Indian tribes, federal agencies, or private persons.⁴

And the *Saint Regis* petitioners were not alone in this view, as “*amici* briefs were filed in the Federal Circuit on behalf of nine States or state entities supporting *en banc* rehearing and warning of the implications of the Federal Circuit's decision for States and state universities.” *Id.* That included petitioner UMN and many of the *amici* here.⁵ *See id.* at 33-35.

In this case, the Federal Circuit unanimously reached the same conclusion, holding that “state and tribal sovereign immunity do not differ in a way that is material to the question of whether IPR proceedings are subject to state sovereign immunity.” Pet. App. 20a.

* * *

The Court already considered and denied the petition in *Saint Regis*. UMN's arguments are not materially distinguishable from those in the *Saint Regis* petition. The UMN petition also should be denied.

⁴ *Saint Regis* Pet. 33.

⁵ In addition to UMN, present *amici* STC.UNM and the states of Indiana, Hawaii, Illinois, Texas, and Massachusetts all supported *en banc* rehearing in *Saint Regis*.

II. The Federal Circuit Followed This Court's Precedents To Identify Two Independent Bases For Affirmance of the PTAB

Even if this Court were again to consider the *Saint Regis* arguments as reformulated in UMN's petition, the outcome should not change. The Federal Circuit not only followed the holding in *Saint Regis*, but identified a separate reason why IPRs are a type of proceeding in which sovereign immunity does not apply. Such additional reasoning further undermines any claim that UMN's petition warrants this Court's review.

A. Sovereign Immunity Cannot Preclude a Federal Agency From Reconsidering Its Own Grant of a Public Franchise

The Federal Circuit correctly recognized this Court's longstanding position that "sovereign immunity does not apply to suits brought by the United States, including agency proceedings commenced by the United States." Pet. App. 19a (collecting cases). In reaching this holding, the Federal Circuit thoroughly reviewed prior efforts by Congress to protect the public from erroneous patent grants, while keeping a close eye on this Court's sovereign immunity and IPR precedents. *Id.* at 6a-18a. In particular, the Federal Circuit read this Court's "holding in *Oil States*, that IPR evaluation of patent validity concerns 'public rights,' as supporting the conclusion that IPR is in key respects a proceeding between the government and the patent owner." *Id.* at 23a. The Federal Circuit also weighed this Court's holding in *Cuozzo* that "IPR proceedings are essentially agency reconsideration of a prior patent grant." *Id.* at 20a (citing *Cuozzo*, 136 S.

Ct. at 2144). The Federal Circuit likewise fully considered the Court’s *SAS* and *Return Mail* decisions:

The USPTO’s enlistment of third parties in IPR has made the process less of an “agency-led, inquisitorial process for reconsidering patents,” and more of a “party directed, adversarial process,” *SAS*, 138 S. Ct. at 1355, i.e., “[an] adversarial, adjudicatory proceeding[] between the ‘person’ who petitioned for review and the patent owner,” *Return Mail*, slip op. at 14, but that does not disturb the basic purpose of the proceeding, “namely, to reexamine an earlier agency decision,” *Cuozzo*, 136 S. Ct. at 2144.

Pet. App. 21a (quoting *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018); *Return Mail, Inc. v. U.S. Postal Serv.*, No. 17-1594, slip op. at 14 (U.S. June 10, 2019); and *Cuozzo*, 136 S. Ct. at 2144). This careful and comprehensive analysis led to a single conclusion:

It is clear from the history and operation of IPR that these proceedings are designed to allow the USPTO to harness third parties for the agency to evaluate whether a prior grant of a public franchise was wrong.

Id. at 22a. And under *FMC*, such proceedings are not barred by sovereign immunity. *See id.* at 22a-23a (“In this way, IPR is akin to *FMC* proceedings brought by the agency that would not be barred by sovereign immunity.”) (citing *Federal Maritime Comm’n v. South Carolina Ports Authority*, 535 U.S. 743, 767-68 (2002)).

Nonetheless, like the petitioners in *Saint Regis*, UMN centers its certiorari argument on this Court’s

decision in *FMC*. Pet. 15-19. *FMC* involved an adjudicatory proceeding before the Federal Maritime Commission in which a private party sought monetary reparations and injunctive relief against a state agency. 535 U.S. at 748-49. The Court held that sovereign immunity applied to that proceeding largely because “the similarities between FMC proceedings and civil litigation are overwhelming.” *Id.* at 759. The Court also carefully limited this decision, explaining that the FMC, as a federal agency, “remains free to investigate alleged violations of the Shipping Act, either upon its own initiative or upon information supplied by a private party, and to institute its own administrative proceeding against a state-run port.” *Id.* at 768 (citation omitted).

IPR is precisely the type of proceeding blessed in *FMC*—a federal agency investigation based “upon information supplied by a private party.” *See id.* While the initiative to investigate is provided by “information supplied by a private party”—the IPR petitioner—the “decision to institute is within [the Director’s] discretion, and Congress went so far as to bar judicial review of that decision.” Pet. App. 21a-22a. Further, “even if the petitioner or patent owner elects not to participate during the IPR, the Board can continue to a final written decision.” *Id.* And the Director may intervene in any subsequent appeal. 35 U.S.C. § 143. For these and other reasons, the Federal Circuit correctly held that “IPR, like inter partes reexamination, is similar to an agency enforcement action instituted by the USPTO ‘upon information supplied by a private party’ rather than civil litigation, so state sovereign immunity is not implicated.” Pet. App. 23a (quoting *FMC*, 535 U.S. at 768).

UMN acknowledges “the Board’s power to refuse to institute an IPR,” but argues that does not matter because “the institution decision does not occur until well after the State has been summoned as a defendant to answer the complaints of private persons.” Pet. 20 (citations omitted). This misstates the law. Patent owners are not “summoned” or otherwise required to participate in IPRs. Whether a state or other patent owner elects to provide information to the Director to inform his institution decision, that choice is voluntary and not coerced. *See* 35 U.S.C. § 313. Unlike in *FMC*, no default judgment will be entered and no future rights will be lost if a state chooses not to file a preliminary response. *Compare* 35 U.S.C. § 313 *with FMC*, 535 U.S.C. at 757 (“If a defendant fails to respond to a complaint, default judgment may be entered on behalf of the plaintiff.”).

The single IPR proceeding UMN cites, ostensibly for the proposition that “[t]he patent holder is then subject to potential discovery and other motion practice before the Board decides [institution],” is inapposite. *See* Pet. 20 n.11. All the orders cited by UMN from that IPR flowed from a voluntary, strategic action taken by the patent owner prior to institution. *E.g., RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, 2015 WL 6157114 (P.T.A.B. Oct. 20, 2015) (granting the patent owner’s motion for additional discovery). UMN fails to identify any Board decision ordering discovery or otherwise attempting to compel a patent owner to do anything prior to a voluntary decision to participate. Nor is there any statute or rule authorizing the Board to do so.

UMN further attempts to argue by analogy that “[n]o one could reasonably argue, for example, that Congress could evade the limits on its power to abrogate sovereign immunity by simply giving district courts or ALJs discretion whether to hear suits by private parties against States.” Pet. 21. But this argument ignores the fact that the Federal Circuit’s decision, like the *Saint Regis* decision before it, was in no way premised on Congress’ power to abrogate sovereign immunity:

The patentee’s suggestion that *Saint Regis* rests on the authority of Congress to abrogate tribal sovereign immunity finds no support in the decision or the statutory scheme. There is no indication in the AIA or its legislative history that Congress designed IPR to abrogate tribal immunity. And, contrary to UMN’s arguments, *Saint Regis* did not base its reasoning on implied abrogation of tribal sovereign immunity. Instead, *Saint Regis* concluded that IPR was an agency reconsideration proceeding to which sovereign immunity does not apply in the first instance. This reasoning applies equally to states as it does to tribes.

Pet. App. 25a (citation omitted).

UMN ultimately resorts to challenging not only the Federal Circuit decision below, but this Court’s precedent as well, arguing that sovereign immunity should apply because states “did not consent to actions brought against them by the federal government *in federal agencies*.” Pet. 27. This blatantly contradicts this Court’s directive in *FMC* that the Federal Maritime Commission—a federal agency—

“remains free to investigate alleged violations of the Shipping Act, either upon its own initiative or upon information supplied by a private party, and to institute its own administrative proceeding against a state-run port.” *FMC*, 535 U.S. at 768 (citations omitted).

In sum, the Federal Circuit’s close adherence to the rationale in *Saint Regis* provides no basis for granting UMN’s petition for a writ of certiorari.

B. IPR Is *In Rem* and Sovereign Immunity Does Not Apply

Beyond the rationale set forth in *Saint Regis*, the Federal Circuit provided an independent reason why sovereign immunity would not apply to IPR: IPR proceedings “are in substance the type of in rem proceedings to which state sovereign immunity does not apply.” Pet. App. 29a. As such, there still would be no basis for granting UMN’s petition, “even if the proceedings are deemed adversarial as between private parties.” *Id.*

UMN wrongly argues that “IPRs are *in personam*, not *in rem*.” Pet. 28 (emphasis in original). UMN relies on dicta from *Return Mail* that IPRs are “between the ‘person’ who petitioned for review and the patent owner.” *Id.* Yet UMN ignores the fundamental aspects of IPR. To wit, in IPR, “jurisdiction is premised on the res (i.e., the patent),” and there is no exercise of personal jurisdiction over the patent owner (whether a state or private party). Pet. App. 34a. Further,

[A] petitioner for IPR “does not seek monetary damages or any affirmative relief from a State by seeking to [have a patent

reviewed in IPR]; nor does he subject an unwilling State to a coercive judicial process.” “[IPR] does not make any binding determination regarding ‘the liability of [one party to another] under the law as defined.’” The petitioner only seeks to have the agency reconsider a previous grant of a patent, and the only relief the Board can offer is the revocation of erroneously granted patent claims.

Pet. App. 34a (citations omitted).

In sum, liability in IPR turns only on the nature of the res (i.e., the patent), and the only outcome affects the res (i.e., confirmation, cancellation, or amendment of claims). Thus, like the debt in *Hood*, IPR is *in rem*—and that does not change if the patent owner is a state, a tribe, or a private party. See *Tenn. Student Assistance Corp. v. Hood*, 541 U.S. 440, 448 (2004) (holding that a court’s “exercise of its *in rem* jurisdiction to discharge a debt does not infringe state sovereignty.”). And the Federal Circuit correctly determined that “IPR proceedings are the type of *in rem* proceedings to which state sovereign immunity does not apply.” Pet. App. 36a.

III. This Case Is a Poor Vehicle for Deciding the Question Presented

UMN’s affirmative decision to put its patent at issue makes this case a poor vehicle for addressing the sovereign immunity question. UMN laments that “if left unreviewed, the precedent established here will provide a template for further incursions on States’ immunity.” Pet. 33. But there has been no “incursion” here—UMN itself started this entire process by suing

LSI for infringement of its patent.⁶ LSI predictably responded by asking the Board to determine whether the patent improperly issued in the first place. And the Board unanimously rejected UMN's motion to dismiss precisely because UMN had first sued LSI, and by so doing had waived any claim to immunity with respect to LSI's IPR request. Pet. App. 59a-64a.

While UMN now takes the position that “the PTAB's waiver holding is meritless” (Pet. 34), that is contrary to the position UMN took before the Board in an earlier IPR. In *Reactive Surfaces*, UMN insisted that if it ever enforced a patent by filing an infringement action, it “could be deemed to have waived its sovereign immunity to the IPR process.” *Reactive Surfaces Ltd., LLP v. Toyota Motor Corp.*, IPR2016-1914, Paper 23, at 19-20 (P.T.A.B. Mar. 3, 2017); *also* Pet. App. 61a-62a.

At bottom, UMN already exercised its prerogative to select the forum to which it will submit its disputes when it filed suit against LSI in Minnesota federal court. Having made that selection, UMN now “must abide the consequences.” *See Gardner v. New Jersey*, 329 U.S. 565, 573 (1947). And that includes the risk that a defendant will file a corresponding IPR request on the same patent. To hold otherwise would allow the University to use its sovereign immunity as a sword to gain unfair advantage in contravention of this Court's holding in *Lapides*. *See Lapides v. Bd. of Regents of Univ. Sys. of Georgia*, 535 U.S. 613, 619 (2002) (instructing that “a Constitution that

⁶ C.A. J.A. 251; 811. For this reason, the speculation by the various state *amici* that IPRs will involuntarily co-opt state universities' budgets is misplaced, as all legal spend in this case traces back to UMN's affirmative act of suing LSI.

permitted States to follow their litigation interests” by using immunity as both sword and shield “could generate seriously unfair results.”).

* * *

Due to UMN’s waiver, the Board ultimately is going to consider LSI’s petition for IPR of UMN’s asserted patent irrespective of whether sovereign immunity applies to IPRs. As such, a decision on the question presented in UMN’s certiorari petition would, in effect, provide only advisory relief.⁷

CONCLUSION

The petition for a writ of certiorari should be denied.

⁷ Further, certiorari would be premature here given the present uncertainty regarding the structure of the Board following the Federal Circuit’s *Arthrex* decision. See Br. in Opp. of Ericsson at 1-2; 30-33.

Respectfully submitted,

ADAM H. CHARNES
KILPATRICK TOWNSEND
& STOCKTON LLP
2001 Ross Avenue
Suite 4400
Dallas, TX 75201
(214) 922-7106
acharnes
@kilpatricktownsend.com

KRISTOPHER L. REED
Counsel of Record
KILPATRICK TOWNSEND
& STOCKTON LLP
1400 Wewatta St.
Suite 600
Denver, CO 80202
(303) 405-8536
kreed
@kilpatricktownsend.com

*Counsel for Respondents LSI Corporation and Avago
Technologies U.S. Inc.*

December 5, 2019