VLP Partner Edward Kwok Quoted in Law360 Article “PTAB Limits Value of Sovereign Immunity Patent Deals”

VLP Intellectual Property Partner Edward Kwok was quoted in the *Law360* article “PTAB Limits Value of Sovereign Immunity Patent Deals.”

The article reported on a recent decision by the Patent Trial and Appeal Board (PTAB) involving state sovereign immunity as it applies to inter partes review (IPR). According to the article, the PTAB denied a motion from the University of Minnesota seeking to petitions that Ericsson Inc. brought against several of its wireless communications patents in IPR, saying the state sovereign immunity that applies in IPR is waived when the patent owner files an infringement lawsuit in district court.

The article noted that this is a significant limitation and unwelcome news for companies who have transferred or consider transferring their patents to sovereign entities, like state universities or Native American tribes, in an effort to shield them from PTAB review.

Additionally the article reported that this ruling solidifies previous decisions from the PTAB, including one involving the University of Florida, which held state sovereign immunity applies in IPR, but noted that it also answered an open question about whether an entity could claim immunity at the PTAB after filing an infringement lawsuit.

“I think the fact that there was an expanded panel means the [patent office] was pretty determined to give an answer, yes or no, to the community,” Mr. Kwok told *Law360*. “And the judges on the expanded panel gave a no.”

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