Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ERICSSON INC. AND TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioners,

v.

REGENTS OF THE UNIVERSITY OF MINNESOTA,
Patent Owner.

_____

Case No. IPR2017-01200
Patent 8,718,185

_____

PETITION FOR REVIEW / NOTICE OF APPEAL
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT
BY REGENTS OF THE UNIVERSITY OF MINNESOTA

Notice is hereby given that Petitioner/Appellant, Regents of the University of Minnesota ("UMN"), in the above-named proceeding, hereby petitions and appeals to the United States Court of Appeals for the Federal Circuit (the "Federal Circuit") for review of the December 19, 2017 decision of the Patent Trial and Appeal Board (the "Board") denying UMN's motion to dismiss an *inter partes* review ("IPR") petition on sovereign immunity grounds. *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01200, Paper No. 16.

The respondent is the United States Patent and Trademark Office.

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The Board's decision is appealable under 28 U.S.C. § 1295(a)(4)(A), via the collateral order doctrine. UMN outlines below the basis for appellate jurisdiction and review.

The Board correctly found that UMN is an arm of the State of Minnesota and is entitled to rely on sovereign immunity in IPRs. The Board, however, erroneously concluded that UMN had waived its sovereign immunity by filing suit for patent infringement in the U.S. District Court for the District of Minnesota.

UMN did not waive its sovereign immunity from the Board proceedings, and the Board's decision contravenes controlling case law establishing that waiver is forum specific. *See Tegic Commc'ns Corp. v. Bd. of Regents of Univ. of Tex. Sys.*, 458 F.3d 1335, 1342-45 (Fed. Cir. 2006) ("[A] State's constitutional interest

in immunity encompasses not merely *whether* it may be sued, but *where* it may be sued....") (italics in original, internal quotations omitted); *A123 Sys., Inc. v. Hydro-Quebec*, 626 F.3d 1213, 1219-20 (Fed. Cir. 2010) ("[W]here a waiver of immunity occurs in one suit, the waiver does not extend to an entirely separate lawsuit, even one involving the same subject matter and the same parties."); *Mull v. Salisbury Veterans Admin. Med. Ctr.*, 2011 WL 3882479, at *4 (DOL Admin. Rev. Bd. Aug. 31, 2011) ("[W]aiver of sovereign immunity in one forum does not affect waiver in other forums....").

Only an immediate appeal of the Board's decision will safeguard the important constitutional right at issue: UMN's entitlement to be free from the burdens of litigation in a forum chosen by a private party. *E.g.*, *P.R. Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc.*, 506 U.S. 139, 145-47 (1993) ("The very object and purpose of the 11th Amendment were to prevent the indignity of subjecting a State to the coercive process of judicial tribunals at the instance of private parties….[T]he value to the States of their constitutional immunity … is for the most part lost as litigation proceeds past motion practice....") (internal quotations omitted); *R.I. Dep't of Envt'l Mgmt. v. United States*, 304 F.3d 31, 43 (1st Cir. 2002) ("[A]bsent immediate judicial review, an agency's adverse immunity determination will wholly deprive the state of a meaningful and adequate means of vindicating its … rights," as "the state's sovereign rights … include an

immunity from being haled before a tribunal by private parties") (internal quotations and alterations omitted); *Sofamor Danek Grp. v. Brown*, 124 F.3d 1179, 1183 n. 2 (9th Cir. 1997) ("[T]he central benefit of immunity, the right not to stand trial in the first instance, is effectively lost if a case is erroneously permitted to proceed to trial."); *Minotti v. Lensink*, 798 F.2d 607, 608 (2d Cir. 1986) ("[T]he essence of the immunity is the possessor's right not to be haled into court—a right that cannot be vindicated after trial."); *Cf. Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2141 (2016) (noting the "presumption favoring review" and emphasizing that the Court left undecided "the precise effect of [35 U.S.C.] § 314(d) on appeals that implicate constitutional questions") (citing *Johnson v. Robison*, 415 U.S. 361, 367 (1974) (holding that statute precluding review of "any question of law or fact under any law administered by the Veterans' Administration" did not bar review of constitutional challenges)).

Accordingly, the Board's decision is appealable under 28 U.S.C. § 1295(a)(4)(A), via the collateral order doctrine. *E.g.*, *P.R. Aqueduct*, 506 U.S. at 141 ("We hold that States and state entities that claim to be 'arms of the State' may take advantage of the collateral order doctrine to appeal a district court order denying a claim of Eleventh Amendment immunity."); *Will v. Hallock*, 546 U.S. 345, 350 (2006) ("A State has the benefit of the [collateral order] doctrine to appeal a decision denying its claim to Eleventh Amendment immunity...."); *Univ.*

of Utah v. Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V., 734 F.3d 1315, 1319 (Fed. Cir. 2013) ("This court has jurisdiction under 28 U.S.C. § 1295(a)(1) and the collateral order doctrine [to consider an appeal of the denial of defendant's motion to dismiss on the basis of sovereign immunity]."); *In re Board of Regents of Univ. of Texas Sys.*, 435 F. App'x 945, 947-48 (Fed. Cir. 2011) ("If the district court denies the Board's immunity, the Board can of course immediately appeal and seek review of that issue before entry of final judgment, thus eliminating any harm asserted by the Board that it might face an unnecessary trial."); *Baum Research and Dev. Co., Inc. v. Univ. of Mass. at Lowell*, 503 F.3d 1367, 1369 (Fed. Cir. 2007) ("The issue of Eleventh Amendment immunity is subject to collateral appellate review, and such review was accepted by this court."); *Gilliland v. Bd. of Educ. of Charles Cty.*, 526 F. App'x 243, 245 (4th Cir. 2013) (reversing district court's finding of waiver of sovereign immunity, on appeal under the collateral order doctrine) (citing *P.R. Aqueduct*); *Madison v. Virginia*, 474 F.3d 118, 123 (4th Cir. 2006) ("Virginia also appeals the district court's ruling that Virginia waived its sovereign immunity…, a final order appealable under the collateral order doctrine.").

Like sovereign immunity itself, the collateral order doctrine applies equally to appeals from agency adjudications—including appeals in which an agency rejects a sovereign immunity claim. *E.g.*, *Chehazeh v. Attorney General of U.S.*,

666 F.3d 118, 136 (3rd Cir. 2012) ("We see no reason to depart from the unanimous view on the issue and, therefore, join in holding that the collateral order doctrine applies to judicial review of agency decisions."); *Osage Tribal Council ex rel. Osage Tribe of Indians v. U.S. Dep't. of Labor*, 187 F.3d 1174, 1180 (10th Cir. 1999) ("[W]e hold that the Secretary's order as to sovereign immunity may be immediately appealed under the collateral order doctrine...."). The Board agreed in its decision granting UMN's motion to stay the proceeding pending this appeal that "[t]he collateral order doctrine, therefore, authorizes immediate appeal of an order denying a claim of Eleventh Amendment immunity." Paper No. 23 at 2.

For these reasons, Petitioner/Appellant UMN hereby notices its appeal of the Board's denial of UMN's motion to dismiss based on UMN's sovereign immunity.

Dated: February 12, 2018

Respectfully submitted,
Regents of the University of Minnesota

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CERTIFICATE OF FILING

I hereby certify that, in addition to being filed electronically through the Board's PTABE2E System, the original version of the foregoing Notice of Appeal, was filed by Priority Mail Express (Label No. EL 635344025 US) on this 12th day of February, 2018, with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450, Alexandria, VA 22313-1450

CERTIFICATE OF FILING

I hereby certify that a true and correct copy of the foregoing Notice of Appeal was filed with the Clerk's Office of the United States Court of Appeals for the Federal Circuit through the federal courts' Case Management and Electronic Case Files (CM/ECF) system on the 12th day of February, 2018, along with the requisite fee. One copy was sent to the clerk by certified mail at the following address:

United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W., Suite 401
Washington, DC 20005

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on February 12, 2018, I will cause a copy of the foregoing document, including any exhibits or appendices referred to therein, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

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Date: February 12, 2018

/MacAulay S. Rush/
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