



December 21, 2020

Mary Critharis
Acting Chief Policy Officer and Director for International Affairs
United States Patent and Trademark Office
Mail Stop OPIA: Office of Policy and International Affairs
P.O. Box 1450
Alexandria, Virginia 22314

Dear Ms. Critharis:

Below are the comments of the Association of Public and Land-grant Universities (APLU) in response to the United States Patent and Trademark Office's Request for Information on Docket Number: PTO-T-2020-0043 regarding its study on state sovereign Immunity.

APLU is a research, policy, and advocacy organization dedicated to strengthening and advancing the work of public universities. Its 232 U.S. members include public research universities (203—including all land-grant universities), state university systems (26), and affiliated organizations (3). APLU's agenda is built on the three pillars of increasing degree completion and academic success, advancing scientific research, and expanding engagement. Annually, its U.S. member campuses enroll 4.3 million undergraduates and 1.2 million graduate students, award 1.2 million degrees, employ 1.1 million faculty and staff, and conduct \$46.8 billion in university-based research.

Public Universities: Serving their Communities, Nation, and the World

Public universities' positive impact extends well beyond the confines of their campuses. Indeed, it is a core part of public universities' mission to serve their communities, and there is scarcely a corner of society that doesn't benefit from their work. These institutions contribute to their local communities, regional and state economies, the country, and world through education, research, innovation, and community engagement.

In addition to educating highly skilled graduates who invest in and contribute to their communities, public universities play a key role in enhancing lives through their cutting-edge research in nearly every conceivable field and industry. Public university research and related technology development, often done with federal government support, continue to improve our lives and offer opportunities that have never been greater for societal improvement such as with smart cities, artificial intelligence, personalized medication and healthcare, and advancements in agriculture and energy that enhance efficiencies and reduce environmental impacts.

Public university research is a crucial driver of important innovation and economic opportunities. As expressed in APLU's 2017 report *Technology Transfer Evolution: Driving Economic Prosperity*¹ "University leaders are increasingly responding to the needs of the innovation economy—and in particular their local economies—by including innovation, entrepreneurship, and "economic engagement" programming in their strategic planning processes. As part of this response, university technology transfer offices are evolving, and must continue to evolve, toward participation in a broader scope of efforts—with patents and licensing as one emphasis, and also connecting with and engaging in other efforts that support the learning and discovery missions of the university."

Congressional Endorsed Process of Technology Transfer from Public Universities Provides Substantial Benefits to Society

University research and technology transfer have been fundamental to the development of numerous new technologies, medicine, and products that improve the daily lives of people around the globe. This month is the 40th Anniversary of the Bayh-Dole Act. The bipartisan Bayh-Dole Act ushered in a substantial increase in the use of patents and technology licenses by universities resulting in countless more research discoveries in university labs benefiting the public. Universities and partner companies depend on strong patent laws to protect their time and investments to bring new products and ideas to the marketplace. It is estimated that, between 1996 and 2017, the Bayh-Dole Act helped spur university technology transfer activities that bolstered U.S. economic output by \$1.7 trillion, supported 5.9 million jobs, and helped more than 13,000 startup companies.²

Prior to the enactment of the Bayh-Dole Act, the federal government retained ownership of university inventions developed with federal funding. Unfortunately, due to the federal government's reliance on non-exclusive patent licenses and other bureaucratic hurdles,³ many inventions remained shelved with little chance of being commercialized. The Bayh-Dole Act encouraged universities to partner with the private sector to further develop and commercialize new inventions. The Act further requires universities to give preferences to American small businesses. Start-ups and their private investors assume the financial risks of bringing a production to market. If a product succeeds, a university could reap some financial reward through royalty payments or other reimbursement.

When a venture is successful, the Bayh-Dole Act requires revenue from licensing activities to be shared with the creators of the technology and used to help advance scientific research and education often through reinvestments in the academic enterprise. These reinvestments could

¹ <https://www.aplu.org/library/technology-transfer-evolution-driving-economic-prosperity/file>

² This information was compiled from AUTM and the Biotechnology Innovation Organization: *The Economic Contribution of University/Nonprofit Inventions in the United States: 1996-2017*; June 2019 as well as the AUTM 2018 Licensing Activity Survey and Statistics Access for Technology Transfer Database, www.autm.net/STATT, and the Academic Patent Licensing Helps Drive the U.S. Economy, IPWatchdog.com, June 20, 2017.

³ See President's Council of Advisors on Science and Technology, *Report on Technology Transfer of Federally Funded R&D 2* (May 2003), <http://bit.ly/2KVFAUz>; Ashley J. Stevens, *The Enactment of Bayh-Dole*, 29 J. of Tech. Transfer 93, 94 (2004), <http://bit.ly/2ION27m>.

include support for graduate students, new equipment, follow-on research, and support for future technology transfer activities including paying for future patent and legal processing fees for new inventions. However, it is important to note that a large portion of start-up companies often fail. And many public institutions spend more of their own resources to support technology transfer activities than they receive in royalty payments.

It is in the United States' economic interest to continue the success driven by the Bayh-Dole Act. The congressional decision to encourage universities to engage in patenting and technology transfer under the auspices of the Act that been described as "the most inspired pieced of legislation enacted in America over the past half century"⁴ by *The Economist*. Innovative technologies that have been developed and deployed by public universities into the marketplace since the passage of the Bayh- Dole Act include: powerful antibiotics, including Streptomycin (Rutgers University), magnetic resonance imaging (State University of New York), time release pharmaceutical capsules (University of Kansas), and touchscreens (University of Delaware and University of Kentucky). Recently, the University of Texas at Austin and The University of Texas Medical Branch contributed to the development of RNA vaccines that have proven effective against Covid-19 and are now being deployed to save lives.

The House of Representatives has formally recognized that university ownership of patents has made "substantial contributions to the advancement of scientific and technological knowledge," has helped develop "new domestic industries and hundreds of thousands of new private sector jobs," and "remains critical to the future well-being of the United States."⁵

This economically important cycle of scientific research, technological development, and technology transfer through licensing does sometimes provide public universities a source of revenue that is used to reinvest in further research and educational efforts that are key to the universities' mission of public good.

At the outset, it is important to note that APLU is unaware of instances of widespread infringement of intellectual property laws being engaged in by public universities that would begin to warrant the passage of legislation by Congress designed to abrogate States' sovereign immunity rights in intellectual property disputes derived from the Eleventh Amendment of the U.S. Constitution. As was noted in the Request for Information, a number of U.S. Supreme court cases, including the recent *Allen v. Cooper* case decided in 2020, and the *Florida Prepaid Postsecondary Ed. Expense Bd. V. College Savings Bank* case decided in 1999, have made clear that Congress would need to meet a high bar before legislation would not be found to be unconstitutional, that would abrogate the sovereign immunity rights of States in intellectual property disputes. For public universities, state sovereign immunity not only protects state treasuries, but also protects the resources necessary to engage in these core educational and civic missions without disruption.

⁴ Innovation's Golden Goose, *The Economist*, December 12, 2002

⁵ 156 Cong. Rec. at 17,529-17,530 (Nov. 17, 2010)

Voluntary Ethical Principles in Licensing University Patents

Numerous public universities have voluntarily endorsed the Association of University Technology Managers guiding principles statement, *In the Public Interest: Nine Points to Consider in Licensing University Technology*⁶. These guiding principles encourage universities to promote technology development for the benefit of society and consider enforcement of their intellectual property carefully. They also encourage universities to resolve disagreements about intellectual property with solutions that benefit both sides, as opposed to litigation. Public universities are reluctant litigants, often initiating infringement actions only to fulfill obligations to existing licenses or in cases of blatant infringement or a refusal to negotiate reasonable license terms - always keeping in mind the primary mission to serve the public good.

No Substantial Evidence of Widespread, Constitutional Violations by Public Institutions to Justify Abrogation of State Sovereign Immunity

Public universities rarely face patent-infringement suits as defendants because universities do not manufacture, sell, or import goods containing third party patented inventions. In addition, if the infringement occurs in the service of educational and teaching activities, “the costs of suing a university would likely outweigh any potential financial damages recovered.”⁷ Public universities will often work with patent owners expeditiously to resolve any claims prior to a lawsuit being filed. In those very rare cases in which there may be a refusal to negotiate or exceedingly unreasonable or frivolous claims by a third party, public universities may rely on sovereign immunity to protect state resources and to protect public dollars that could otherwise be devoted to education, research, and community services from being devoted to the increased risk and cost of litigation.

APLU is unaware of any recent publicly available report or survey to indicate an increase in assertions of constitutional violations of the due process rights of patent and/or trademark owners by public universities since the Supreme Court’s decision in *Florida Prepaid*. Not every infringement is a constitutional violation. At a minimum, the violation must be intentional rather than negligent or reckless. Indeed, in *Florida Prepaid*, the Court noted Congress only cited two cases of patent infringement by state or state entities in the legislative history. A General Accounting Office study from 2001 found “through an analysis of the published case law and a survey of the states,”⁸ 58 lawsuits between 1985 and 2001 in either a state or federal court in which a state was a defendant in an action involving intellectual infringement. The federal courts heard 47 of these cases, which represented 0.05 percent of the nearly 105,000 intellectual property cases filed in federal district courts during the sixteen years covered by the study. Additionally, as part of the 2001 report, GAO surveyed state institutions of higher education regarding accusations of infringement by their institutions. Many participating institutions reported no accusations and the majority indicated they had dealt with 5 or fewer cases.

⁶ <https://autm.net/about-tech-transfer/principles-and-guidelines/nine-points-to-consider-when-licensing-university>

⁷ Maria Teresita Barker, University of Iowa, *Patent litigation involving colleges and universities: an analysis of cases from 1980 – 2009, Iowa* <https://ir.uiowa.edu/cgi/viewcontent.cgi?article=2585&context=etd>

⁸ United States General Accounting Office, *Intellectual Property: State Immunity in Infringement Actions* (2001)

It is highly unlikely that public universities will seek to violate the due process rights of other inventors simply because state sovereignty may provide a defense to being sued in federal courts. As creators, users, and distributors of a wide variety of intellectual property (IP), public institutions have publicly available policies and robust educational programs for employees and students focused on the appropriate use, purchase, licensure, and citation of these inventions and other works. Moreover, wide-scale infringement would be antithetical to the educational and civic missions of public universities. Indeed, states and state universities did not respond to *Florida Prepaid* by abusing patent rights or committing infringement.⁹ Quite the contrary, for example, state universities in the Fifth Circuit strengthened their commitment to comply with federal intellectual property laws.¹⁰

Public universities are keenly aware that they must maintain their reputational capital. “[M]any state entities, especially universities, are entering into the commercial domain, where goodwill translates into business relationships, licensing revenues, and further funding of their research activities. As this process occurs, goodwill becomes even more crucial for those state entities seeking any measure of commercial success.”¹¹ For example, public universities that engage in repeated infringement “would likely encounter a great deal of difficulty in a number of key activities. It would be difficult for them to partner with private industry groups to fund research, to attract new research faculty, or to form partnerships with private universities.”¹²

In addition, patent owners who may have bona fide claims of infringement based on public university technology commercialization are not left without a remedy. As describe above, under the commercialization structure enabled by the Bayh-Dole Act, public universities commercialize technology by licensing it to non-state business entities. To the extent such commercialization arguably violates another party’s intellectual property, the full array of remedies could be asserted against the non-state licensee. And even if there were instances in which a public university willfully infringed patents on a regular basis, there are extant legal mechanisms - such as injunctions, limitations on the immunity of state university employees, and the takings doctrine - that can address such violations without doing harm to sovereign immunity.

State Sovereign Immunity is a Bedrock Principle of the U.S. Constitutional System of Government

“In the compound republic of America, the power surrendered by the people is first divided between two distinct governments.”¹³ The Constitution establishes “two orders of government,

⁹ See Tejas N. Narechania, Note, *An Offensive Weapon?: An Empirical Analysis of the “Sword” of State Sovereign Immunity in State-Owned Patents*, 110 Colum. L. Rev. 1574, 1605 (2010) (“[S]tates do not wield their immunity as a patent sword.”).

¹⁰ See *Chavez v. Arte Publico Press*, 204 F.3d 601 (5th Cir. 2000).

¹¹ Beals, 9 U. Pa. J. Const. L. at 1270.

¹² *Id.* At 1270-1271.

¹³ THE FEDERALIST NO. 51 at 291 (James Madison). See also THE FEDERALIST NO. 28 at 149 (Alexander Hamilton) (“Power being almost always the rival of power, the general government will at all times stand ready to check the usurpations of the state governments, and these will have the same disposition towards the general government.”).

each with its own direct relationship, its own privity, its own set of mutual rights and obligations to the people who sustain it and are governed by it.”¹⁴ By dividing sovereignty between the National Government and the States,¹⁵ the Constitution insured that “a double security arises to the rights of the people. The different governments will control each other, at the same time that each will be controlled by itself.”¹⁶ Thus, “the preservation of the States, and the maintenance of their governments, are as much within the design and care of the Constitution as the preservation of the Union and the maintenance of the National Government. The Constitution, in all its provisions, looks to an indestructible Union, composed of indestructible States.”¹⁷ This division of sovereignty between the States and the National Government “is a defining feature of our Nation’s constitutional blueprint.”¹⁸ The division of power between *dual sovereigns*, the States and the National Government, is reflected throughout the Constitution’s text,¹⁹ as well as its structure.²⁰ “Just as the separation and independence of the coordinate branches of the Federal Government serve to prevent the accumulation of excessive power in any one branch, a healthy balance of power between the States and the Federal Government will reduce the risk of tyranny and abuse from either front.”²¹

Recognizing that “the States retain substantial sovereign powers under our constitutional scheme, powers with which Congress does not readily interfere,”²² and that “the erosion of state

¹⁴ *U.S. Term Limits v. Thornton*, 514 U.S.779, 838 (1995) (Kennedy, J., concurring). As early as 1768, John Dickinson suggested that sovereignty should be divided between the British Parliament and the Colonial Legislatures. See 1 Alfred H. Kelly, Winfred A. Harbison, & Herman Belz, *THE AMERICAN CONSTITUTION: ITS ORIGINS AND DEVELOPMENT* 46-49 (7th ed. 1991)

¹⁵ Prior to the adoption of the Constitution, the thirteen States effectively were thirteen sovereign nations. See *Declaration of Independence* (“these United colonies are and of right ought to be free and independent states”). Each individual State retained the “Full Power to levy War, conclude Peace, contract Alliances, establish Commerce, and to do all other Acts and Things which Independent States may of right do.” *Id.* Indeed, the Articles of Confederation explicitly recognized that each State “retains its sovereignty, freedom, and independence, which is not by this confederation expressly delegated to the United States, in Congress assembled.” ARTICLES OF CONFEDERATION, art. II. In sum, before the ratification of the United States Constitution, the States were sovereign entities. See *Blatchford v. Native Vill. of Noatak*, 501 U.S. 775, 779 (1991).

¹⁶ THE FEDERALIST NO. 51 at 291 (James Madison).

¹⁷ *Texas v. White*, 74 U.S. (7 Wall.) 700, 725 (1868).

¹⁸ *Federal Mar. Comm’n*, 535 U.S. at 751.

¹⁹ See *Printz, v. United States*, 521 U.S. 898, 919 (1997).

²⁰ See *Alden*, 527 U.S. at 714-15. See also U.S. Const. amend. X. (If a sovereign power is not explicitly given to the National Government, it is reserved to the States to the People.). As the Supreme Court observed:

The Tenth Amendment likewise restrains the power of Congress, but this limit is not derived from the text of the Tenth Amendment itself, which, as we have discussed, is essentially a tautology. Instead, the Tenth Amendment confirms that the power of the Federal Government is subject to limits that may, in a given instance, reserve power to the States. The Tenth Amendment thus directs us to determine, as in this case, whether an incident of state sovereignty is protected by a limitation on an Article I power.” *New York*, 505 U.S. at 156-57. Moreover, the Tenth Amendment is not the exclusive textual source of protection for principles of federalism.

See *Printz*, 521 U.S. at 924 n.13.

²¹ *Gregory v. Ashcroft*, 501 U.S. 452, 458 (1991). See also J. Harvie Wilkinson III, *Federalism for the Future*, 74 S. Cal. L. Rev. 523 (2001).

²² *Gregory*, 501 U.S. at 461.

sovereignty is likely to occur a step at a time,”²³ the Supreme Court has declared that the National Government may not compel the States to pass particular legislation,²⁴ to require state officials to enforce federal law,²⁵ to dictate the location of the State Capitol,²⁶ to regulate purely local matters,²⁷ or to abrogate the State’s sovereign immunity.²⁸

“An integral component of that ‘residuary and inviolable sovereignty’ retained by the States is their immunity from private suits.”²⁹ The adoption of the Constitution “did not disturb States’ immunity from private suits, thus firmly enshrining this principle in our constitutional framework.”³⁰ Indeed, “leading advocates of the Constitution assured the people in no uncertain terms that the Constitution would not strip the States of sovereign immunity.”³¹ The widespread acceptance of this proposition is demonstrated by the reaction to *Chisholm v. Georgia*,³² which held that private citizens from one State could sue another State.³³ Almost immediately, Congress passed and the States subsequently ratified the Eleventh Amendment, which effectively overturns *Chisholm*.³⁴ While the text of the Eleventh Amendment is limited to “the specific provisions of the Constitution that had raised concerns during the ratification debates and formed the basis of the *Chisholm* decision,”³⁵ the Eleventh Amendment confirms a much broader proposition—the States are immune from suit.³⁶ Sovereign immunity does not exist solely in

²³ *South Carolina v. Baker*, 485 U.S. 505, 533 (1988) (O’Connor, J., dissenting).

²⁴ *New York v. United States*, 505 U.S. 144, 162 (1992).

²⁵ *Printz*, 521 U.S. at 935.

²⁶ *Coyle v. Smith*, 221 U.S. 559, 579 (1911).

²⁷ *United States v. Morrison*, 529 U.S. 598, 617-19 (2000); *Lopez*, 514 U.S. at 561 n.3 (1995). Cf. *Gonzales v. Oregon*, 126 S. Ct. 904, 925 (2006) (National Attorney General may not shift “authority from the States to the Federal Government to define general standards of medical practice in every locality.”).

²⁸ *Seminole Tribe*, 517 U.S. at 72. Indeed, in some circumstances, the States’ sovereignty interest will preclude federal courts from enjoining on-going violations of federal law. See *Idaho v. Coeur d’Alene Tribe*, 521 U.S. 261, 286-87 (1997).

²⁹ *Federal Mar. Comm’n*, 535 U.S. at 751. See also THE FEDERALIST NO. 39, at 213 (James Madison) (“the proposed government cannot be deemed a *national* one; since its jurisdiction extends to certain enumerated objects only, and leaves to the several States a residuary and inviolable sovereignty over all other objects.”); THE FEDERALIST NO. 81, at 455 (Alexander Hamilton) (“It is inherent in the nature of sovereignty not to be amenable to the suit of an individual *without its consent*.”) (emphasis original).

³⁰ *Federal Mar. Comm’n*, 535 U.S. at 752.

³¹ *Alden*, 527 U.S. at 716.

³² 2 U.S. (2 Dall.) 419 (1793).

³³ *Id.* at 468 (Cushing, J.); 440 (Wilson, J.); 478-79 (Jay, C.J.); 450-53 (Blair, J.). Subsequently, the Court has explicitly acknowledged that its decision in *Chisholm* was wrong. See *Federal Mar. Comm’n*, 535 U.S. at 752-53; *Alden*, 527 U.S. at 721-22.

³⁴ See *Federal Mar. Comm’n*, 535 U.S. at 752; *Alden*, 527 U.S. at 721.

³⁵ *Id.* at 723.

³⁶ *Hans v. Louisiana*, 134 U.S. 1, 15 (1890); (Federal jurisdiction over suits against unconsenting States “was not contemplated by the Constitution when establishing the judicial power of the United States.”). Cf. *Puerto Rico Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc.*, 539 U.S. 139, 146 (1993) (“The Amendment is rooted in a recognition that the States, although a union, maintain certain attributes of sovereignty, including sovereign immunity.”); *Blatchford*, 501 U.S. at 779 (“[W]e have understood the Eleventh Amendment to stand not so much for what it says, but for the presupposition of our constitutional structure which it confirms....”).

order to “preven[t] federal-court judgments that must be paid out of a State’s treasury,”³⁷ but allows the States to avoid “the indignity of subjecting a State to the coercive process of judicial tribunals at the instance of private parties.”³⁸ “Although the sovereign immunity of the States derives at least in part from the common-law tradition, the structure and history of the Constitution make clear that the immunity exists today by constitutional design.”³⁹

Thus, the immunity confirmed by the Eleventh Amendment bars suits against the States by Indian Tribes,⁴⁰ foreign nations,⁴¹ and corporations created by the National Government.⁴² Moreover, it applies to proceedings in state court,⁴³ federal administrative proceedings,⁴⁴ admiralty,⁴⁵ and in situations where the State’s treasury is not implicated.⁴⁶ Indeed, there is a presumption “that the Constitution was not intended to ‘rais[e] up’ any proceedings against the States that were ‘anomalous and unheard of when the Constitution was adopted.’”⁴⁷

Of course, this immunity is not absolute. In 1976, the Court held that Congress could abolish the State sovereign immunity by exercising its powers to enforce the Fourteenth Amendment.⁴⁸ In 1989, the Court extended that holding and declared that Congress could use *any* of its powers—including those powers set out in Article I-- to limit the State sovereign immunity,⁴⁹ thereby giving it virtually unlimited power to strip the States of their sovereign immunity.⁵⁰ Not surprisingly, Congress took advantage of these rulings and proceeded to cancel the State sovereign immunity for most federal statutes.⁵¹

However, the Court soon imposed significant constraints on the Congressional power to abrogate sovereign immunity. In 1996, in *Seminole Tribe*, the Court held that Congress could not use its Article I powers to abrogate immunity. Rather, any effort to abrogate must be based on an effort to enforce the Fourteenth.⁵² A year later, in *City of Boerne v. Flores*,⁵³ the Court imposed significant limitations on the power of Congress to enforce the Fourteenth Amendment. *Flores* holds that Congress’ powers under § 5 are limited to enforcing the actual substantive guarantees of the Fourteenth Amendment, which include Equal Protection of the laws, the Privileges or Immunities of national citizenship, and Due Process. In order for legislation to be a

³⁷ *Hess v. Port Auth. Trans-Hudson Corp.*, 513 U.S. 30, 48 (1994).

³⁸ *Puerto Rico Aqueduct*, 506 U.S. at 146 (internal quotation marks omitted).

³⁹ *Alden*, 527 U.S. at 733.

⁴⁰ *Blatchford*, 501 U.S. at 782.

⁴¹ *Principality of Monaco v. Mississippi*, 292 U.S. 313, 330-32 (1934).

⁴² *Smith v. Reeves*, 178 U.S. 436, 446, 449 (1900).

⁴³ *Alden*, 527 U.S. at 712.

⁴⁴ *Federal Mar. Comm’n*, 535 U.S. at 760.

⁴⁵ *In re New York*, 256 U.S. 490, 503 (1921).

⁴⁶ See *Doe v. Regents of the Univ. of California*, 519 U.S. 425, 431 (1997).

⁴⁷ *Federal Mar. Comm’n*, 535 U.S. at 755 (quoting *Hans*, 134 U.S. at 18).

⁴⁸ See *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976).

⁴⁹ See *Pennsylvania v. Union Gas*, 491 U.S. 1, 14-23 (1989).

⁵⁰ See *Union Gas*, 491 U.S. at 38-56 (Scalia, J., dissenting).

⁵¹ See, e.g., 42 U.S.C. § 2000d-7(a)(1) (attempting to abrogate sovereign immunity for numerous statutes).

⁵² *Seminole Tribe*, 517 U.S. at 56-71.

⁵³ 521 U.S. 507 (1997).

valid exercise of congressional power to enforce the Fourteenth Amendment, Congress must make specific findings that the States have violated the Constitution. Even if those findings are made, the resulting legislation to enforce the Fourteenth Amendment must be a “proportionate response” to the violations. When *Flores* and *Seminole Tribe* are combined, congressional abrogation of sovereign immunity becomes extremely difficult. In order to have a valid abrogation, Congress must first make a specific finding that the States are violating the substantive guarantees of the Constitution. Once there are such findings, Congress must then demonstrate that abrogation of sovereign immunity for a particular class of claims is a proportionate response to the violations.

The “congruence and proportionality” test involves three questions.⁵⁴ First, the Court must “identify with some precision the scope of the constitutional right at issue.”⁵⁵ Second, after identifying the right at issue, the Court must determine “whether Congress identified a history and pattern of unconstitutional ... discrimination by the States...”⁵⁶ Third, if there is a pattern of constitutional violations by the States,⁵⁷ then the Court must determine whether the Congress’ response is proportionate to the finding of constitutional violations.⁵⁸

Applying this test to the patent and trademark context, it is clear Congress cannot justify abrogation. First, the “constitutional right at issue” is the right not to be deprived of property (a patent or trademark) without due process. Not every infringement of a patent or trademark is a deprivation of due process. Indeed, because constitutional violations must be intentional, negligent or reckless infringements are not constitutional violations. Second, there is no “history and pattern” of constitutional violations by the States. Because local governments generally are not the State for Eleventh Amendment purposes, violations by local governments or community colleges cannot be considered. Third, as to proportionality, violations by *some* States in the past does not justify abrogation for *all* States. As Justice Scalia, observed: “There is no guilt by association, enabling the sovereignty of one State to be abridged under § 5 of the Fourteenth Amendment because of violations by another State, or by most other States, or even by 49 other States.”⁵⁹ Before a State’s immunity is deemed abrogated, it should be able to “demand that *it* be shown to have been acting in violation of the Fourteenth Amendment.”⁶⁰ Similarly, if a State violated the Constitution in the past, it should not lose its immunity forever.

Congress should not engage in a futile constitutional exercise. At this time, there is no evidence that *any* State is engaged in widespread constitutional violations of the due process rights of patent and trademark holders. Even if there is sufficient evidence to justify abrogation for *some* States, there is no justification for abrogating the immunity of all States. Rather, it is essential for Congress to continue to protect public universities from potentially costly litigation

⁵⁴ See generally *Garrett*, 531 U.S. at 365-74.

⁵⁵ *Garrett*, 531 U.S. at 365.

⁵⁶ *Garrett*, 531 U.S. at 368.

⁵⁷ If there is no pattern of constitutional violations by the States, then Congress has not acted properly and the inquiry ends. *College Sav. Bank*, 527 U.S. at 675. In such a situation, sovereign immunity has not been abrogated.

⁵⁸ *Florida Prepaid*, 527 U.S. at 646.

⁵⁹ *Hibbs*, 538 U.S. at 741-42 (Scalia, J., dissenting) (emphasis original).

⁶⁰ *Id.* at 743 (Scalia, J., dissenting)

and encourage them to continue serve their public mission providing education, research, and community services.

Sincerely,

A handwritten signature in black ink, reading "Peter McPherson". The signature is written in a cursive style with a large initial "P" and "M".

Peter McPherson
President
Association of Public and Land-grant Universities