

CLIENT ALERT

State Entity's Assertion of Patent Waives Sovereign Immunity As to Section 101 Subject-Matter Eligibility Defense

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University of Florida Research Foundation, Inc. v. General Electric Company, No. 2018-1284 (Fed. Cir. Feb. 26, 2019)
The patent claimed methods for compiling patient physiologic data from hospital bedside machines, such as heart-rate and blood-pressure monitors. The accused infringer argued that the patent claimed ineligible subject matter under Section 101. The patentee argued that it had sovereign immunity as an arm of the State of Florida and that it had not waived sovereign immunity to a Section 101 challenge to its patent. The patentee argued in the alternative that the claims were patent eligible under Section 101. The district court ruled for the accused infringer on both issues. The patentee appealed, and the Federal Circuit affirmed.

The Federal Circuit held that a sovereign entity's suing for patent infringement waived sovereign immunity for any relevant defenses to patent infringement. The patentee contended that Section 101 ineligible subject-matter was not a defense to patent infringement, arguing that 35 U.S.C. § 282(b) lists all "defenses" to patent infringement and does not include Section 101 eligibility. The Federal Circuit disagreed, concluding that Section 101 eligibility was covered by Section 282(b), and that even if it were not, Section 101 eligibility had long been treated by courts as a "defense" to patent infringement. Thus, Section 101 would still be a defense for which immunity is waived when a sovereign sues for patent infringement.

On the merits, the court determined that the claims were directed to an abstract idea of "collecting, analyzing, manipulating, and displaying data." The patent itself described the invention as automating "pen and paper methodologies," and so the court characterized the patent as "a quintessential 'do it on a computer' patent." Thus, the Federal Circuit held that the claims were ineligible under Section 101.

[A copy of the opinion can be found here](#)

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[Mike Rueckheim](#)

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