United States Senate
WASHINGTON, DC 20510

VIA ELECTRONIC TRANSMISSION

April 28, 2020

The Honorable Andrei Iancu
Director
United States Patent and Trademark Office
600 Dulany Street, Madison East
Alexandria, VA 22314

Dear Director Iancu:

The Supreme Court's ruling last month in *Allen v. Cooper* created a situation in which copyright owners are without remedy if a State infringes their copyright and claims State sovereign immunity under the Eleventh Amendment of the U.S. Constitution.[1] As we understand, this was already the case in patent law and some aspects of federal trademark law following two Supreme Court decisions in 1999. We are concerned about the impact this may have on American creators and innovators, and we would like for the Patent and Trademark Office to research this issue to determine whether there is sufficient basis for federal legislation abrogating State sovereign immunity when States infringe patents or trademarks. We also are asking the Copyright Office to advise on the pervasiveness and prevalence of States' infringements of copyrights.

As you know, *Allen v. Cooper* involved a challenge to the constitutionality of the Copyright Remedy Clarification Act (CRCA),[2] which Congress enacted in 1990 to abrogate State sovereign immunity for copyright infringement and establish that a State would be liable "in the same manner and to the same extent" as a private party under copyright law. The Supreme Court found the CRCA was unconstitutional because it applied to all infringements of copyright by States, not just unconstitutional infringements. The Supreme Court said its decision was largely predetermined by the precedent set in its 1999 opinion in *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, in which the court held that Congress can abrogate State sovereign immunity from patent infringement claims under Section 5 of the Fourteenth Amendment, but not Article I, only if abrogation is limited in scope and remedies a pervasive and unredressed constitutional violation.[3] The Court did not discuss the related 1999

[1] *See Allen v. Cooper*, No. 18–877 (Mar. 23, 2020).

[2] Pub. L. No. 101-553, 104 Stat. 2749 (1990).

[3] 527 U.S. 627 (1999).

decision in *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*, which involved the Lanham Act.[4]

But *Allen v. Cooper* provided Congress a blueprint for how to validly abrogate State sovereign immunity from certain patent and trademark infringement claims. One element that the Court pointed to was the importance of Congress identifying a pattern of unconstitutional infringement before enactment. It is on this point that we request the Patent and Trademark Office's expertise and advice.

We ask that the Patent and Trademark Office study the extent to which patent or trademark owners are experiencing infringements by state entities without adequate remedies under state law. As part of this analysis, the Patent and Trademark Office should consider the extent to which such infringements appear to be based on intentional or reckless conduct.

So that Congress can evaluate whether legislative action needs to be taken, please provide a public report summarizing the findings of your study, as well as the facts and analyses upon which those findings are based, no later than April 30, 2021. Thank you for your careful attention to this matter. If you have any questions, please do not hesitate to contact me.

Sincerely,

Thom Tillis
United States Senator

Patrick Leahy
United States Senator

[4] 527 U.S. 666 (1999).