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So Sioux Me : Native American Tribal Immunity From PTAB Proceedings & District Court Litigations

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Recent Tribal Immunity Supreme Court Cases

- In *Kiowa Tribe of Okla. V. Mfg. Techs., Inc.* and *Michigan v. Bay Mills Indian Cmty.*, the Supreme Court held that Indian tribes retain their sovereign immunity from suits unless there is a Congressional provision otherwise.
- *Kiowa* extended sovereign immunity to off-reservation commercial activity and *Bay Mills* reaffirms that.
- Most recently, in *Lewis v. Clarke*, the Supreme Court held that tribal immunity extends to only the real party in interest. Therefore, more specifically, a tribal employee does not have tribal immunity from an auto accident suit.

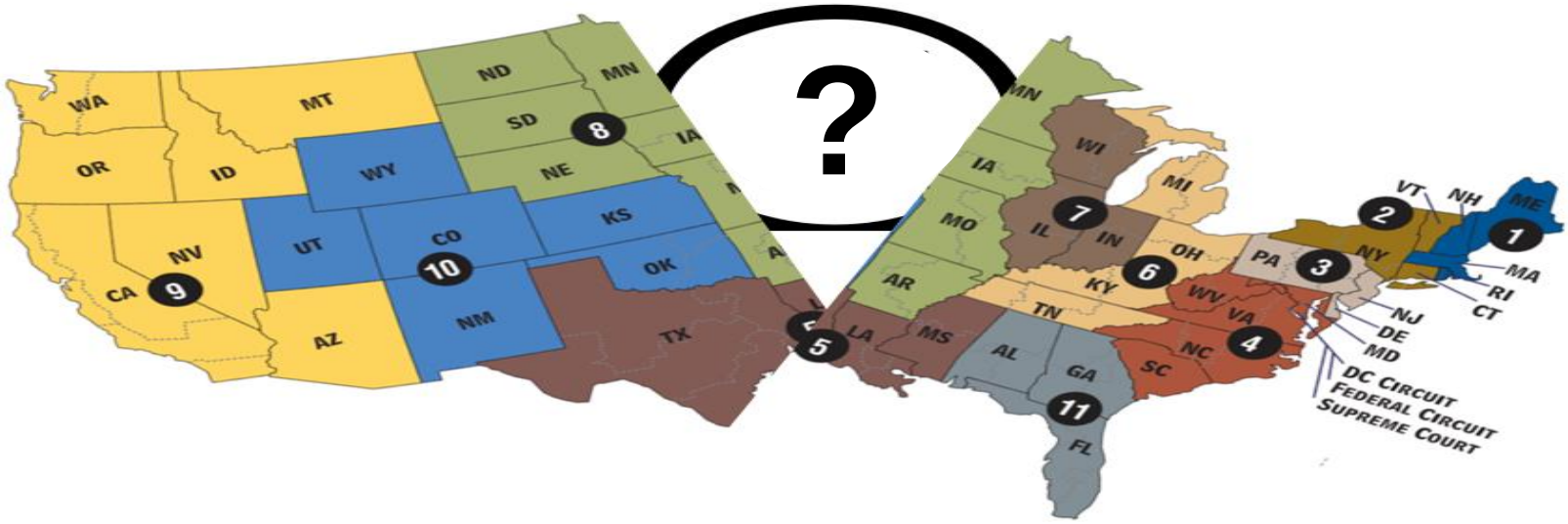
All Involved Immunity From Suits Brought Under State Law

The *Tuscarora* Doctrine: Tribal Immunity

- In its 1960 *Tuscarora* decision, the Supreme Court said that “general Acts of Congress apply to Indians as well as all others in the absence of a clear expression to the contrary.”
- And other older Supreme Court cases indicated limitations on tribal immunity:
  - In *Wheeler*, the Court said that “Indian tribes still possess those aspects of sovereignty not withdrawn by treaty or statute, or by implication as a necessary result of their dependent status.”
  - *Duro v. Reina* held that “the retained sovereignty of the tribes is that needed to control their own internal relations, and preserve their own customs and social order.”

The *Tuscarora* Circuit Split

- The Second, Sixth, Ninth, and Eleventh Circuits have applied the *Tuscarora* doctrine and found tribes amenable to suit under federal statutes of general applicability
- The Eighth and Tenth Circuits require a clear Congressional waiver of tribal immunity
- The D.C. Circuit created its own test that looked at the tribe's "traditional customs and practices" to determine suit could be brought under a federal statute
- However, the Second and Eleventh Circuits have found that tribes, even if amenable to the federal statute, remain immune to private enforcement suits



Immunity to Suit for Patent Infringement; Waiver

- The N.D.N.Y. and N.D. Okla. have both found tribes immune from patent infringement suits: *Home Bingo; Specialty House.*

However, very recently:

- The PTAB ruled that although state sovereign immunity applies in *inter partes* review, a state entity was found to have waived that immunity by filing a patent infringement lawsuit in district court: *Ericsson v. Univ. of Minnesota.*
- The Supreme Court granted certiorari in *Upper Skagit Indian Tribe v. Lundgren* to consider whether a court's *in rem* jurisdiction trumps tribal sovereign immunity – another circuit split.

The Federal Circuit Has Never Opined on Tribal Immunity

Thank You!

James R. Klaiber is Counsel in the Intellectual Property Group of Hughes Hubbard & Reed. His practice is focused on patent litigation, prosecution, and transactions, including medical devices, automotive, telecommunication, semiconductors, and packaging. He is a former AT&T Bell Laboratories Member of Technical Staff, where his work included research and development of high speed undersea cable systems.

He has mechanical engineering degrees from MIT, the University of California at Berkeley, and the University of Michigan, and his law degree is from Fordham University Law School. Jim recently stepped down as Chair of the ABCNY Committee on Patents, and is a board member and former Chair of the MIT Enterprise Forum of New York City.

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