

102D CONGRESS
1ST SESSION

S. 758

To clarify that States, instrumentalities of States, and officers and employees of States acting in their official capacity, are subject to suit in Federal court by any person for infringement of patents and plant variety protections, and that all the remedies can be obtained in such suit that can be obtained in a suit against a private entity.

IN THE SENATE OF THE UNITED STATES

MARCH 21 (legislative day, FEBRUARY 6), 1991

Mr. DECONCINI (for himself and Mr. HATCH) introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To clarify that States, instrumentalities of States, and officers and employees of States acting in their official capacity, are subject to suit in Federal court by any person for infringement of patents and plant variety protections, and that all the remedies can be obtained in such suit that can be obtained in a suit against a private entity.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the "Patent and Plant Vari-
5 ety Protection Remedy Clarification Act".

1 **SEC. 2. LIABILITY OF STATES, INSTRUMENTALITIES OF**
2 **STATES, AND STATE OFFICIALS FOR IN-**
3 **FRINGEMENT OF PATENTS.**

4 (a) **LIABILITY AND REMEDIES.**—(1) Section 271 of
5 title 35, United States Code, is amended by adding at the
6 end the following:

7 “(h) As used in this section, the term ‘whoever’ in-
8 cludes any State, any instrumentality of a State, and any
9 officer or employee of a State or instrumentality of a State
10 acting in his official capacity. Any State, and any such
11 instrumentality, officer, or employee, shall be subject to
12 the provisions of this title in the same manner and to the
13 same extent as any nongovernmental entity.”.

14 (2) Chapter 29 of title 35, United States Code, is
15 amended by adding at the end the following new section:

16 **“§ 296. Liability of States, instrumentalities of States,**
17 **and State officials for infringement of**
18 **patents**

19 “(a) **IN GENERAL.**—Any State, any instrumentality
20 of a State, and any officer or employee of a State or in-
21 strumentality of a State acting in his official capacity,
22 shall not be immune, under the eleventh amendment of
23 the Constitution of the United States or under any other
24 doctrine of sovereign immunity, from suit in Federal court
25 by any person, including any governmental or non-

1 governmental entity, for infringement of a patent under
2 section 271, or for any other violation under this title.

3 “(b) REMEDIES.—In a suit described in subsection
4 (a) for a violation described in that subsection, remedies
5 (including remedies both at law and in equity) are avail-
6 able for the violation to the same extent as such remedies
7 are available for such a violation in a suit against any pri-
8 vate entity. Such remedies include damages, interest,
9 costs, and treble damages under section 284, attorney fees
10 under section 285, and the additional remedy for infringe-
11 ment of design patents under section 289.”.

12 (b) CONFORMING AMENDMENT.—The table of sec-
13 tions at the beginning of chapter 29 of title 35, United
14 States Code, is amended by adding at the end the fol-
15 lowing new item:

“Sec. 296. Liability of States, instrumentalities of States, and State officials for
infringement of patents.”.

16 **SEC. 3. LIABILITY OF STATES, INSTRUMENTALITIES OF**
17 **STATES, AND STATE OFFICIALS FOR IN-**
18 **FRINGEMENT OF PLANT VARIETY PROTEC-**
19 **TION.**

20 (a) INFRINGEMENT OF PLANT VARIETY PROTEC-
21 TION.—Section 111 of the Plant Variety Protection Act
22 (7 U.S.C. 2541) is amended—

23 (1) by inserting “(a)” before “Except as other-
24 wise provided”; and

1 (2) by adding at the end thereof the following
2 new subsection:

3 “(b) As used in this section, the term ‘perform with-
4 out authority’ includes performance without authority by
5 any State, any instrumentality of a State, and any officer
6 or employee of a State or instrumentality of a State acting
7 in his official capacity. Any State, and any such instru-
8 mentality, officer, or employee, shall be subject to the pro-
9 visions of this Act in the same manner and to the same
10 extent as any nongovernmental entity.”.

11 (b) **LIABILITY OF STATES, INSTRUMENTALITIES OF**
12 **STATES, AND STATE OFFICIALS FOR INFRINGEMENT OF**
13 **PLANT VARIETY PROTECTION.**—Chapter 12 of the Plant
14 Variety Protection Act (7 U.S.C. 2561 et seq.) is amended
15 by adding at the end thereof the following new section:

16 **“SEC. 130. LIABILITY OF STATES, INSTRUMENTALITIES OF**
17 **STATES, AND STATE OFFICIALS FOR IN-**
18 **FRINGEMENT OF PLANT VARIETY PROTEC-**
19 **TION.**

20 “(a) Any State, any instrumentality of a State, and
21 any officer or employee of a State or instrumentality of
22 a State acting in his official capacity, shall not be immune,
23 under the eleventh amendment of the Constitution of the
24 United States or under any other doctrine of sovereign
25 immunity, from suit in Federal court by any person, in-

1 cluding any governmental or nongovernmental entity, for
2 infringement of plant variety protection under section 111,
3 or for any other violation under this title.

4 “(b) In a suit described in subsection (a) for a vio-
5 lation described in that subsection, remedies (including
6 remedies both at law and in equity) are available for the
7 violation to the same extent as such remedies are available
8 for such a violation in a suit against any private entity.
9 Such remedies include damages, interest, costs, and treble
10 damages under section 124, and attorney fees under sec-
11 tion 125.”.

12 **SEC. 4. EFFECTIVE DATE.**

13 The amendments made by this Act shall take effect
14 with respect to violations that occur on or after the date
15 of the enactment of this Act.

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