
INTELLECTUAL PROPERTY

STATE SOVEREIGN IMMUNITY AND THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

BY STEVEN TEPP*

“If angels were to govern men, neither external nor internal controls on government would be necessary.” - Federalist #51

The doctrine of sovereign immunity is an ancient legal principle, dating back to feudal Europe, when power flowed from the King down through the nobility and very little trickled down to the peasantry. It is rooted in the premise that to submit to the jurisdiction of a court implies that one is subservient or inferior to the power of that court.

Because the American model of government is founded on a premise opposite to that of feudal structures, that power flows up from the people to the States and then to the Federal Government, the application of sovereign immunity is far less intuitive. Indeed, the modern application of this doctrine is controversial precisely because it is fundamental to the relationship of the government to the people and of the Federal Government to the States.

It is the latter relationship that this article considers. Despite the philosophical inconsistencies, sovereign immunity is unquestionably a component of our legal tradition and, indeed, our Constitution. It is not the existence of state sovereign immunity, but its scope and the circumstances under which it may be overcome that are discussed. This article reviews the evolution of the application of this legal principle to the enforcement of intellectual property, particularly copyright. This article concludes that the Court’s recent decisions rest on newly tilled and possibly unstable ground, and that the practical effects of these decisions is inequitable by any measure.

I. Background

In the United States, state sovereign immunity is articulated by the Eleventh Amendment to the Constitution,¹ but its meaning remains the subject of much discussion. In June of 1999, the Supreme Court handed down a trio of rulings that, taken together, dramatically altered the landscape of the enforceability of federal law with regard to States.² In order to fully appreciate the context of these rulings, it is necessary to review the prior precedent and developments in the law.

The Eleventh Amendment was adopted in 1795 as a direct response to the Supreme Court’s ruling in *Chisholm v. Georgia* (2 Dallas 419 (1793)). In that case, the Court permitted a suit by a citizen of South Carolina against the unwilling State of Georgia. The ruling generated political controversy. Many of the States were substantially in debt and the fiscal implication of being subject to suit for overdue loans was dire. The

Eleventh Amendment was adopted less than two years later and specifically reversed the ruling of the Court.³

The United States passed its first Copyright Act in 1790. There is no decision in the ensuing 172 years that failed to subject States to the full range of remedies available under the Copyright Act on the grounds of sovereign immunity.⁴

In 1962, the Eighth Circuit dismissed a copyright infringement suit against a state agency on sovereign immunity grounds.⁵ The court held that the defendant school district was an instrumentality of the State of Iowa and that as such it was immune from suit in federal court for its infringement of musical compositions.⁶ The period of apparent immunity did not last long.

Just two years later, the Supreme Court issued its ruling in *Parden v. Terminal Railway of Alabama*.⁷ In that case, employees of a state-owned railroad sued the State of Alabama in federal court under the Federal Employees’ Liability Act (FELA). FELA specifically created a cause of action in federal court against “every common carrier by railroad” for damages suffered by employees from job-related personal injuries.

The Court engaged in a three-step analysis. First, the Court discussed whether Congress intended to subject States to suit under FELA. The Court reasoned that the express language of the statute created a cause of action against “every common carrier,” and absent express language to the contrary, a statutory exception should not be presumed. Thus, the Court determined that Congress did intend to subject States to suit in federal court under FELA.

Second, the Court considered whether Congress had the power to subject a State to suit in federal courts notwithstanding the Eleventh Amendment. The Court found that in giving Congress the power to regulate interstate commerce, the States had surrendered any sovereign immunity that would impede that regulation. Therefore, in acting under its Commerce Clause power, Congress could abrogate state sovereign immunity.

Finally, the Court queried whether Alabama’s operation of a railroad in interstate commerce after its waiver of sovereign immunity implied that the State had consented to suit in federal court under FELA. Finding that it did, the Court held that “when a State leaves the sphere that is exclusively its own and enters into activities subject to congressional regulation, it

subjects itself to that regulation as fully as if it were a private person or corporation.”⁸

Because the Copyright Act, in language very similar to FELA, provided for suit against “any person”⁹ who infringed a copyright, the decision in *Parden* left little doubt that States could be sued for copyright infringement. Further, despite the existence of copyright and/or patent laws in many States, all the States agreed to allow Congress to provide exclusively federal protection for those forms of intellectual property.¹⁰ Thus, just as in *Parden*, the States had surrendered any sovereign immunity that would impede that protection.

More than twenty years after *Parden*, in *Atascadero State Hospital v. Scanlon*,¹¹ the Court reversed itself on the legislative requirements necessary to find congressional intent to abrogate state sovereign immunity. In that case a disabled person sued a state hospital in federal court for alleged employment discrimination. The suit was brought pursuant to the Rehabilitation Act of 1973, which provided for remedies against “any recipient of Federal assistance,” a class that arguably included States.

The Court held that in the instant case, the Eleventh Amendment barred recovery from the State because a “general authorization for suit in federal court is not the kind of unequivocal language sufficient to abrogate the Eleventh Amendment.”¹² Rather, what is required for congressional abrogation of state sovereign immunity is that the federal statute be “unmistakably clear” that States are included in the defendant class.

Under this more stringent test, the language of the Copyright Act failed to abrogate state sovereign immunity.¹³ Thus, there was reason to believe that States might be immune to suits for damages under the Copyright Act.

As a result of that uncertainty, Congress acted. In 1990 Congress enacted the descriptively-named Copyright Remedy Clarification Act (CRCA).¹⁴ That law added to Title 17 a provision which states in clear terms that States “shall not be immune, under the Eleventh Amendment of the Constitution...or any other doctrine of sovereign immunity, from suit in Federal Court...for a violation of the exclusive rights of a copyright owner...”¹⁵ Two years later, similar legislation was also enacted with regards to patents and trademarks.¹⁶ Thus, once again, the apparent immunity was removed.

The Supreme Court issued another significant ruling in 1989 in *Pennsylvania v. Union Gas Co. (Union Gas)*.¹⁷ That case involved a suit by a private company against Pennsylvania for third-party liability under the Comprehensive Environmental Response, Compensation, and Liability Act of 1980 (CERCLA) to recover certain costs to clean a spill of coal tar into a creek.

The Court considered two questions. First, did

CERCLA clearly abrogate state sovereign immunity? The Act provided for the liability of “persons” and included within its definition of that term, “States.” This provision, along with the presence in the Act of language excepting States from liability in particular circumstances, satisfied the Court that the law was unmistakably clear in its intent to make States liable in all but the excepted instances. Thus, the Court quickly concluded that CERCLA did properly purport to abrogate state sovereign immunity.

The second question the Court considered was whether Congress had authority to enact such an abrogation. CERCLA was enacted pursuant to Congress’ Article I, sec. 8 authority, specifically, the Commerce Clause. A plurality of the Court found that “to the extent that the States gave Congress the authority to regulate commerce, they also relinquished their immunity where Congress found it necessary, in exercising this authority, to render them liable.”¹⁸

This ruling strengthened the hand of copyright owners. By direct analogy the CRCA and its patent and trademark analogs, which were, of course, also adopted pursuant to Article I, sec. 8 authority, would be upheld as a valid exercise of congressional authority and effectively abrogate state sovereign immunity from damages for copyright infringement.

The series of positive developments for copyright owners ended with the *Union Gas* decision. Seven years later, the Court handed down its ruling in *Seminole Tribe of Florida v. Florida. (Seminole Tribe)*.¹⁹ That case involved a suit by an Indian Tribe under the Indian Gaming Regulatory Act to compel the State of Florida to engage in good faith negotiations with the Tribe. The Act was adopted pursuant to Congress’ Article I, sec. 8 authority, the Indian Commerce Clause.

The Court considered the same two issues it had considered in *Union Gas*. The first was whether Congress has “unequivocally expresse[d] its intent to abrogate [state] immunity.”²⁰ The Act left little room for discussion. It instructed that district courts would have jurisdiction to hear cases arising from the failure of a State to engage in good faith negotiations. Obviously, only States could be defendants in such an action and therefore Congress, in enacting this provision, intended the States’ immunity to be abrogated.

The second issue was whether Congress had authority to enact such an abrogation? Because the Act was adopted pursuant to Article I authority, the *Union Gas* decision was strong support for the constitutionality of the Act in this case. However, the Court overruled *Union Gas*, finding that “the background principle of state sovereign immunity embodied in the Eleventh Amendment is not so ephemeral as to dissipate when the subject of the suit is an area, like the regulation of Indian commerce, that is under the exclusive control of the Federal Government.”²¹ After *Seminole Tribe*, congressional authority to abrogate state sovereign immunity could be found in section five of the Fourteenth Amendment.

This ruling cast a shadow on the constitutionality of the CRCA. That Act was most intuitively an exercise of Congress' Article I power. Now, in order to sustain the CRCA, it was necessary to find sufficient authority in the Fourteenth Amendment.

It was to the scope of Congress' Fourteenth Amendment authority that the Supreme Court turned the following year in *City of Boerne v. Flores*.²² In that case the Supreme Court considered the constitutionality of the Religious Freedom Restoration Act.²³ Congress had enacted RFRA to overrule a previous Court decision and apply the strict scrutiny test to State and local laws of general applicability with an incidental effect on the free exercise of religion. RFRA had been enacted pursuant to Congress' power under section five of the Fourteenth Amendment. The case was brought under RFRA by the Archbishop of a Catholic Church who was denied a permit to expand the church building by the Historic Landmark Commission of the city of Boerne.

The issue before the Court was whether RFRA was a valid exercise of Congress' Fourteenth Amendment authority. The Court found that it was not because it read RFRA as seeking to alter the substantive meaning of the Fourteenth Amendment and the Free Exercise Clause of the First Amendment.

"The design of the Amendment and the text of Section 5 are inconsistent with the suggestion that Congress has the power to decree the substance of the Fourteenth Amendment's restrictions on the States. Legislation which alters the meaning of the Free Exercise Clause cannot be said to be enforcing the Clause. Congress does not enforce a constitutional right by changing what the right is. It has been given the power "to enforce," not the power to determine what constitutes a constitutional violation."²⁴

The Court went on to expound upon what standards Congress must adhere to in order to remain within the bounds of its Fourteenth Amendment power. The key to this analysis is that "[t]here must be a congruence and proportionality between the injury to be prevented or remedied and the means adopted to that end."²⁵

While this was not a sovereign immunity case, it is crucial to sovereign immunity analysis because, after *Seminole Tribe*, Congress could abrogate state sovereign immunity only pursuant to the Fourteenth Amendment. Thus, this case set the stage for the courts to review the constitutionality of the CRCA or parallel legislation concerning patents and trademarks.

II. The 1999 Decisions

The Supreme Court did just that in a triad of 5-4 decisions on June 23, 1999. The decision in *Alden*²⁶ undergirded the other two decisions. In that case, John Alden and other employees of the State of Maine filed suit in federal court against

that state for violation of the overtime provisions of the Fair Labor Standards Act, a federal law. In light of the Supreme Court's decision in *Seminole Tribe*, the District Court dismissed the action. The dismissal was upheld by the Court of Appeals.

Petitioners then filed the same action in state court in Maine. The state trial court dismissed the suit on grounds of sovereign immunity and the Maine Supreme Judicial Court affirmed. The United States Supreme Court also affirmed.²⁷

The Court's holding in this case went well beyond the routine recognition that a State is a sovereign entity that maintains an immunity to lawsuits by private parties to which it has not consented. The importance of the Court's holding is the broad applicability of state sovereign immunity to the State's own courts as well as to federal courts.

Specifically, the Court reasoned that the Eleventh Amendment was not the origin of state sovereign immunity. Rather,

the States' immunity from suit [in the State's own courts and in federal courts] is a fundamental aspect of the sovereignty which the States enjoyed before the ratification of the Constitution, and which they retain today...except as altered by the plan of the Convention or certain constitutional Amendments.²⁸

In this view, then,

[t]he Eleventh Amendment confirmed rather than established sovereign immunity as a constitutional principle; it follows that the scope of the States' immunity from suit is demarcated not by the text of the Amendment alone but by fundamental postulates implicit in the constitutional design.²⁹

In light of this interpretation, it is fair to ask whether the Eleventh Amendment retains any operational effect?

The Court concluded its opinion with an implicit recognition of the potential for states to unfairly profit from its ruling, noting several limits on its holding. First, states may waive their immunity and Congress may provide incentives for such waiver, as provided in *South Dakota v. Dole* (483 U.S. 203 (1987)).³⁰ Second, the immunity "bars suits against States, but not lesser entities. The immunity does not extend to suits prosecuted against a municipal corporation or other governmental entity which is not an arm of the State."³¹ Additionally, injunctive and declaratory relief are not precluded by state immunity.³²

These limitations fail to offset the violence done to the ability of intellectual property right owners to vindicate their rights. As will be discussed below, the Court's rules for congressional incentives for States to waive their immunity place make it difficult for this avenue to be effective. The no-

tion that the sovereign immunity of States does not extend to entities that are not States is hardly a limitation. And while injunctive and declaratory relief can prevent future infringement of a particular work, they do nothing to compensate the right holder or deter future infringement of other works. Thus, owners of intellectual property can take little comfort in the Court's high-minded but unrealistic declaration that "[w]e are unwilling to assume the States will refuse to honor the Constitution or obey the binding laws of the United States."³³

In the second of the June 23 cases, the Court applied the principles of its recent decisions to the trademark parallel of the CRCA in *College Savings*.³⁴ In that case, College Savings Bank sued the State of Florida in federal court under Section 43(a) of the Lanham Act for alleged misrepresentations made by Florida concerning its college tuition savings plans.³⁵ In light of the Supreme Court's decision in *Seminole Tribe*, the District Court granted Florida's motion to dismiss on sovereign immunity grounds. The Third Circuit affirmed. The Supreme Court also affirmed.

The Court first turned to the question of whether the Trademark Remedy Clarification Act (TRCA) abrogated state sovereign immunity. As already noted, Supreme Court precedent admits only one source of constitutional authority from which Congress may abrogate state immunity; the enforcement power in section five of the Fourteenth Amendment.³⁶

The Fourteenth Amendment instructs in relevant part that "No State shall...deprive any person of...property, without due process of law."³⁷ Because the Court held that College Savings did not allege deprivation of a property right within the meaning of the Fourteenth Amendment, the avenue of congressional abrogation of state immunity was closed.³⁸ The Court did not hold that trademarks are not property. Just the opposite, in fact:

The Lanham Act may well contain provisions that protect constitutionally cognizable property interests—notably, its provisions dealing with infringement of trademarks, which are the "property" of the owner because he can exclude others from using them.³⁹

However, the Court recognized that College Savings was not suing for trademark infringement, but for misrepresentation. The right to be free from misrepresentation is not, the Court held, a property right within the meaning of the Fourteenth Amendment.⁴⁰

Next, the Court turned to the question of implied state waiver of its immunity.⁴¹ Invoking the precedent of *Parden*, College Savings sought to demonstrate that Florida had impliedly waived its immunity by participating in a scheme that is enforceable in federal court.⁴² The Court not only rejected this argument, it overruled *Parden* and renounced the doctrine of implied waiver of state immunity as "ill conceived."⁴³

The Court's holding requires that a state's waiver be explicit and voluntary in order to be effective. However, Congress may provide incentives to the State by conditioning use of discretionary authority such as the Spending Clause and the Compact Clause on state waiver.⁴⁴ Nonetheless, the Court apparently disapproves of the use of at least some Commerce Clause authority in this manner:

In the present case, however, what Congress threatens if the State refuses to agree to its condition is not the denial of a gift or gratuity, but a sanction: exclusion of the State from otherwise permissible activity....[W]e think where the constitutionally guaranteed protection of the States' sovereign immunity is involved, the point of coercion is automatically passed- and the voluntariness of waiver destroyed- when what is attached to the refusal to waive is the exclusion of the State from otherwise lawful activity.⁴⁵

In the third of the three opinions issued on June 23, *Florida Prepaid*,⁴⁶ College Savings Bank sued the State of Florida in federal court, claiming infringement of its patent on its methodology of financing college tuition. Despite the Supreme Court's ruling in *Seminole Tribe*, the District Court denied Florida Prepaid's motion to dismiss. The District Court held that Congress had abrogated the State's immunity in this case by virtue of the Patent and Plant Variety Protection Remedy Clarification Act (PRCA). The Federal Circuit affirmed. The Supreme Court reversed.

The question presented was whether Congress' attempt to abrogate state sovereign immunity was valid. The Court considered this question under the two-part test articulated in *Seminole Tribe*:

first, whether Congress has "unequivocally expresse[d] its intent to abrogate the immunity," ...and second, whether Congress has acted "pursuant to a valid exercise of power."⁴⁷

The first part of the test was met easily, as the statute was very clear on the point. The second part of the test, however, was not met to the Court's satisfaction.

As noted above, current Supreme Court precedent admits only one source of constitutional authority from which Congress may abrogate state immunity: the enforcement power in section five of the Fourteenth Amendment. It was on this basis that College Savings Bank sought to have the statute upheld. The Court acknowledged that patents are property within the meaning of the Fourteenth Amendment.⁴⁸ However, the Court held that the legislative enactment at issue in this case did not fall within Congress' Fourteenth Amendment power for several reasons.

First, as the Court held in *City of Boerne*, Congress "must identify conduct transgressing the Fourteenth

Amendment's substantive provisions, and must tailor its legislative scheme to remedying or preventing such conduct."⁴⁹ The Court found that Congress failed to meet this burden because it did not identify a pattern of patent infringement by states.⁵⁰

Second, the Court recognized that patent infringement by a state is not a violation of the Fourteenth Amendment if the state provides a remedy, that is, due process.⁵¹ Because the statute was drafted to apply to all states, without regard to state-provided remedies, the Court held that it went beyond the power conveyed by the Fourteenth Amendment.⁵²

Third, the Court noted that "a state actor's negligent act that causes unintended injury to a person's property does not 'deprive' that person of property within the meaning of the Due Process Clause."⁵³ Because a claim for patent infringement requires no showing of intent in order for the plaintiff to prevail, the Court held that the legislative enactment at issue in this case was again overbroad.⁵⁴

This decision applied the general rule articulated in *City of Boerne* and the high barriers erected by that application spelled almost certain doom for the CRCA, which is closely analogous to the PRCA that the Court struck down.

Although the Supreme Court has not ruled directly on the constitutionality of the CRCA, the Fifth Circuit applied the Supreme Court's recent rulings in *Chavez v. Arte Publico Press*.⁵⁵ That case involved a suit by an author claiming copyright infringement of her book by the University of Houston, a state university.

The court followed the analysis in *Florida Prepaid*, first inquiring whether Congress identified a pattern of infringement by States. While noting that the legislative history in support of the CRCA was somewhat more substantial than that of the PRCA, the court found that the record was still inadequate to support the legislative enactment. Second, the court noted that in adopting the CRCA Congress "barely considered the availability of state remedies for infringement. Thus, the Fifth Circuit refused to enforce the CRCA.

The same result was reached in another Fifth Circuit case, *Rodriguez v. Texas Comm'n on the Arts*,⁵⁶ in a laconic opinion that presumably is based upon the same rationale as that circuit's decision in *Chavez*. Given the current Supreme Court precedent, it is likely that *Chavez* was properly decided and that the CRCA is no longer effective.

III. The Current Situation

Owners of intellectual property have but one arrow left in their quiver to prevent or deter infringement of their intellectual property rights by States. That arrow is injunctive relief against particular employees of the State. Although the doctrine of state sovereign immunity has been dramatically strengthened in recent years, the Court has thus far retained the injunc-

tive relief available under the reasoning of a 1908 case, *Ex parte Young*.⁵⁷ The reasoning behind this rule is that when a state official acts in violation of valid federal law, that official is by definition acting outside the scope of his official duties. For, clearly, a State cannot lawfully authorize one of its employees to act in violation of valid federal law. And, an employee of a State is cloaked with the State's immunity only when acting within the scope of his duties. Therefore, an employee of a State who acts in violation of a valid federal law is not immune and may be enjoined from that activity.

The *Ex parte Young* doctrine provides only very limited relief however, because it provides no compensation for the damages already inflicted upon a copyright owner due to past infringement by a State. Nor is it clear, given the Court's movement in recent years, that this doctrine will remain in force.

The practical question that is begged by the legal analysis is; are the States taking advantage of their immunity to infringe copyrights? Given the legal structure that the Supreme Court has erected, one might very well expect the answer to be in the affirmative. And it may very well be so. Unfortunately, the extent of State infringements is largely unknown at this time. That information has not traditionally been collected, nor is it conveniently available from a single or few sources.

The General Accounting Office, at the request of Senator Hatch, sought to answer this question by researching how many cases of alleged infringement by states have occurred since 1985. It identified 58 lawsuits out of 105,000 cases filed in district court during that time.⁵⁸ It is highly unlikely that this represents the true number of disputes. As the GAO itself conceded,

[I]dentifying all past accusations of intellectual property infringement against states over any period is difficult, if not impossible, because there are no summary databases providing such information. The published case law is an incomplete record, because (1) both the federal and state courts report only those cases in which decisions were rendered and (2) state courts usually report only appellate decisions...Furthermore, accusations that are made through such mechanisms as cease-and-desist letters that were resolved administratively without a lawsuit being filed would not appear in the published case law.⁵⁹

The GAO failed to mention perhaps the most important factor; prior to 1999 States had good reason to believe that they were subject to the full range of remedies for infringement of intellectual property and likely regulated their behavior accordingly. What appears certain is that so long as States remain immune from suits for damages from copyright infringements, the number of infringements by States is likely to increase.

Without this information, it will be impossible to fulfill the Court's mandate to Congress to show a pattern of infringements by States. In subsequent cases, the Court has not hesitated to, under the rubric of this new requirement, reopen the legislative record of laws enacted years before the *Florida Prepaid* decision and second-guess Congress' use of its Fourteenth Amendment authority.⁶⁰ In effect, it may be logistically impossible to satisfy the Court's demands for legislative findings to support abrogation of state sovereign immunity.

IV. Legislative Responses

The Court's rulings have not escaped the notice of Congress. Just as the CRCA and its patent and trademark counterparts were enacted to counter the Court's ruling in *Atascadero*, Congress has begun consideration of legislation to reverse the effect of the 1999 rulings.

The first such legislation was S. 1835, the Intellectual Property Protection Restoration Act. It was introduced by Senator Leahy in the 106th Congress. The centerpiece of this bill was an attempt to provide an incentive for States to waive their sovereign immunity. Specifically, the provision would have withheld from States the ability to enforce their intellectual property in the absence of a waiver by that State of its immunity from suits for damages under federal intellectual property laws. In light of the Court's reassertion in *College Savings* that Congress may condition the receipt of a gratuity, such as federal spending, in order to give States an incentive to waive their immunity, this approach appears sound.⁶¹

S. 1835 was the subject of discussion during a hearing in the House Judiciary Committee's Intellectual Property Subcommittee on July 20, 2000. It was not enacted, but was introduced by Senator Leahy in substantially similar form in the 107th Congress as S. 1611. The Senate Judiciary Committee held a hearing on that bill on February 27, 2002. The bill engendered substantial discussion and negotiations among interested parties without a consensus emerging. In the 108th Congress, Representatives Lamar Smith and Howard Berman have taken the lead, introducing virtually the same legislation again in the form of H.R. 2344. They held a hearing on the bill on June 17, 2003 in the House Judiciary Committee's Intellectual Property Subcommittee, of which they are Chairman and Ranking Member, respectively.

While the political obstacles of this legislation are daunting, it is clear that those in Congress who recognize the need to support private property rights in intellectual property will not abandon the issue.

V. Conclusion

It is only logical that without an alteration the status quo, infringements by States are likely to increase. One need not assume, as the Court implicitly did in *Alden*,⁶² that the only

scenario for such an increase is an affirmative decision by States to flaunt the law of the land. More likely is the scenario that States and state employees will simply become more and more lax, secure in the knowledge that they can incur no penalty save an order to cease the infringing activity.

Barring a reversal of these 5-4 decisions, only Congress has the power to remedy the existing imbalance and it is appropriate that it do so. State's rights must surely be respected, but the current state of affairs is unjust and unacceptable. State sovereign immunity should not be allowed to become a tool of injustice.

* Steven Tepp is a Policy Planning Advisor with the U.S. Copyright Office. The views expressed in this article are entirely those of the author and do not necessarily represent the views of the Copyright Office. Special thanks to Jule Sigall and David Carson for their editorial assistance and guidance. Any remaining errors are solely the fault of the author.

Footnotes

¹ "The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State." U.S. Const., Amend. XIV.

² *College Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999)(*College Savings*), *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*, 527 U.S. 627 (1999)(*Florida Prepaid*), *Alden v. Maine*, 527 U.S. 706 (1999)(*Alden*).

³ See *Alden* for an in-depth discussion of the circumstances surrounding the adoption of the Eleventh Amendment.

⁴ *Copyright Liability of States and the Eleventh Amendment*, A Report of the Register of Copyrights, p. 90, (June, 1988).

⁵ *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962).

⁶ *Id.* at 783.

⁷ 377 U.S. 184 (1964)(*Parden*).

⁸ *Id.* at 196.

⁹ 17 U.S.C. '101 (1909).

¹⁰ See U.S. CONST., Art. I, Sec. 8, Cl. 8.

¹¹ 473 U.S. 234 (1985)(*Atascadero*).

¹² *Id.* at 246.

¹³ In 1976, between the *Parden* decision in 1964 and the *Atascadero* decision in 1985, Congress enacted major revisions to the Copyright Act for the first time since 1909. As part of those amendments, the relevant language was moved from section 101 to section 510(a), and changed from "any person" to "anyone." In either case, it is clear that this was not the type of highly specific language the *Atascadero* Court demanded in order to find abrogation of state sovereign immunity.

¹⁴ Pub. L. 101-553.

¹⁵ 17 U.S.C. 511.

¹⁶ 35 U.S.C. 271(h), 296; 15 U.S.C. '1122, 1125(a)(2).

¹⁷ 491 U.S. 1 (1989).

¹⁸ *Id.* at 19-20.

¹⁹ 517 U.S. 44 (1996).

²⁰ *Id.* at 55 quoting *Green v. Mansour*, 474 U.S. 64, 68 (1985).

²¹ *Id.* at 72.

²² 521 U.S. 507 (1997)(*City of Boerne*).

²³ 42 U.S.C. 2000bb et seq.(RFRA).

²⁴ *Id.* at 519.

²⁵ *Id.* at 520.

²⁶ 527 U.S. 706 (1999).

²⁷ *Id.* at 711.

²⁸ *Id.* at 713.

²⁹ *Id.* at 728, 29.

³⁰ *Id.* at 755.

³¹ *Id.* at 756.

³² *Id.* at 757.

³³ *Id.* at 755.

³⁴ 527 U.S. 666 (1999).

³⁵ College Savings Bank alleged that Florida’s tuition savings plans were infringing its patent on it plan. That claim was addressed by the Court in the *Florida Prepaid* decision, discussed below.

³⁶ *Id.* at 672.

³⁷ U.S. Const., Amend. XIV.

³⁸ *College Savings* at 675.

³⁹ *Id.* at 673.

⁴⁰ *Id.*

⁴¹ *Id.* at 675-87.

⁴² *Id.* at 676.

⁴³ *Id.* at 680.

⁴⁴ *Id.* at 686.

⁴⁵ *Id.* at 687.

⁴⁶ 527 U.S. 627 (1999).

⁴⁷ *Id.* at 635.

⁴⁸ *Id.* at 637.

⁴⁹ *Id.* at 639.

⁵⁰ *Id.* at 640.

⁵¹ *Id.* at 643.

⁵² *Id.*

⁵³ *Id.* at 645(citing *Daniels v. Williams*, 474 U.S. 327, 328 (1986)).

⁵⁴ *Id.* at 646.

⁵⁵ 204 F.3d 601 (5th Cir. 2000).

⁵⁶ 199 F.3d 279 (5th Cir. 2000).

⁵⁷ 209 U.S. 123 (1908).

⁵⁸ *Intellectual Property, State Immunity in Infringement Actions*, GAO-01-811, p. 66 (Sept., 2001).

⁵⁹ GAO at 7-8.

⁶⁰ See *Kimel v. Florida Board of Regents*, 586 U.S. 62 (2000)(holding that the legislative record of the Age Discrimination in Employment Act of 1967 did not justify the act’s abrogation of state sovereign immunity); *Board of Trustees of the University of Alabama v. Garrett*, 513 U.S. 356 (2001) (holding that the legislative record of the Americans with Disabilities Act of 1990 did not justify the act’s abrogation of state sovereign immunity); *Nevada Dept. of Human Resources v. Hibbs*, 123 S. Ct. 1972 (2003) (holding that the legislative record of the Family and Medical Leave Act of 1993 did justify the act’s abrogation of state sovereign immunity).

It is acknowledged that the Court in each of the above cited cases couched its analysis in terms of the scope of Congress’ authority under the Fourteenth Amendment, not in terms of second-guessing Congress’ legislative policy judgments. Of course, the Court has in the past believed it was not “substituting the judgment of the court for that of the legislature” only to be viewed differently in historical perspective. *Lochner v. New York*, 198 U.S. 45, 56-57 (1905).

⁶¹ See note 31, *supra*.

⁶² See note 34, *supra*.