
The Plenary Power of States to Infringe Intellectual Property Under the Cloak of Sovereign Immunity

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Introduction

The Eleventh Amendment to the United States Constitution immunizes the states from suits that are brought in federal court by citizens of foreign nations and other states.² Although this may seem like a straightforward limitation on the jurisdiction of the federal courts, its scope has been evolving for over two centuries. Part I of this note discusses *State Contracting & Engineering Corp. v. Florida*³ [*State Contracting I*] in which a Florida district court, and subsequently the Court of Appeals for the Federal Circuit,⁴ concluded that Florida was immune from suit for patent infringement. Part II reviews the history and development of state sovereign immunity jurisprudence, with emphasis placed upon recent Supreme Court cases addressing the issue in the context of patent and copyright infringement. Part III presents several unsuccessful attempts by Congress to overcome the sovereign immunity hurdle and subject states to suit in federal courts for intellectual property infringement. And finally, Part IV concludes by presenting several alternatives to

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2. U.S. CONST. amend. XI. "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." *Id.*

3. *State Contracting & Eng'g Corp. v. Florida*, 2000 WL 34220818 (S.D. Fla.).

4. *State Contracting & Eng'g Corp. v. Florida*, 258 F.3d 1329 (Fed. Cir. 2001) [*State Contracting II*]; *State Contracting & Eng'g Corp. v. Condotte Am., Inc.*, 346 F.3d 1057 (Fed. Cir. 2003) [*State Contracting III*].

traditional patent and copyright infringement suits that aggrieved parties, such as the plaintiffs in the *State Contracting* case, may use to protect their intellectual property rights from state infringement.

I. The *State Contracting* Facts and Procedural History

In 1989, State Paving Corp., a Florida construction company, entered into a contract with the State of Florida to construct highway sound barrier walls.⁵ During construction, State Paving devised a new method of constructing the sound barrier walls and proposed the new method to the State of Florida in a Value Engineering Change Proposal (VECP).⁶ The State of Florida agreed to the VECP, and the parties signed a supplemental agreement to govern its use.⁷ In June of 1990, State Paving submitted patent applications,⁸ and in 1997 it assigned its rights in the applications to State Contracting & Engineering Corp. (State Contracting).⁹

Unbeknownst to State Paving, the State of Florida began using the VECP data in bid requests for other projects.¹⁰ When State Paving learned of this in 1992, it notified “potential bidders [of those projects], advising them of the pending patent application and seeking a patent royalty.”¹¹ At the same time, State Paving also sought additional compensation from the State of Florida for the continued use of the VECP technology in these other projects that did not involve State Paving.¹² In 1997, after negotiations proved unsuccessful, State Contracting and State Paving filed suit in the District Court for the Southern District of Florida against the State of Florida and seven private contractors, based on claims of patent infringement, unconstitutional takings, breach of contract, and

5. *State Contracting II*, 258 F.3d at 1331.

6. *Id.*

7. *Id.* at 1332. The agreement stated that “the contract adjustment and sum agreed to ‘constitutes a full and complete settlement’ and that State Paving ‘accepts the terms of this Supplemental Agreement as full compensation for all costs . . . related to the issues set forth in this Agreement.’” *Id.*

8. *Id.* The first application was filed on August 29, 1991, as a continuation of the abandoned June 29, 1990, application for the method of construction that embodies the VECP. U.S. Patent No. 5,234,288 (issued Aug. 10, 1993). *State Contracting II*, 258 F.3d at 1332. The second application was filed on June 28, 1993, as a divisional application of the August 29, 1991, continuation; it was for the apparatus that is created by using the method patent. U.S. Patent No. 5,429,455 (issued July 4, 1995). *Id.*

9. *State Contracting III*, 346 F.3d at 1061.

10. *State Contracting II*, 258 F.3d at 1332.

11. *Id.*

12. *Id.*

Lanham Act violations.¹³ Although the proceedings were temporarily stayed¹⁴ pending the Supreme Court's rulings in the *Florida Prepaid* cases,¹⁵ twin cases dealing with sovereign immunity in a patent infringement suit,¹⁶ the district court eventually granted the summary judgment motions of the defendants on all counts.¹⁷ State Contracting then appealed the rulings to the Federal Circuit.¹⁸

In its first review of the case, the Federal Circuit affirmed the summary judgment on the patent infringement and Lanham Act claims against the State of Florida based on sovereign immunity¹⁹ and also affirmed the summary judgment on the takings and breach of contract claims.²⁰ The Federal Circuit did, however, reinstate the patent infringement claims against the contractors and remanded the case.²¹ In affirming the district court's sovereign immunity determination, the Federal Circuit, citing recent Supreme Court rulings,²² noted that "Florida enjoys sovereign immunity with respect to the patent infringement and Lanham Act claims unless Florida has waived sovereign immunity."²³ The Federal Circuit further noted that "any waiver of sovereign immunity... must be express and

13. *State Contracting I*, 2000 WL 34220818, at *1. The complaint contained seven counts: 1) a direct infringement claim against the State of Florida based on the method patent, 2) a direct infringement claim against the State of Florida based on the apparatus patent, 3) direct infringement claims against each of the seven contractors based on their use of both patents through their contracts with the State of Florida, 4) a Lanham Act claim against the State of Florida for its misrepresentation that the VECP information in its bid requests was not patented, 5) an unconstitutional takings claim against the State of Florida for using State Contracting's proprietary and patent rights, 6) a breach of contract claim against the State of Florida for not compensating State Paving pursuant to the Supplemental Agreement, and 7) a contributory patent infringement claim against one of the contractors for making, using, and selling posts specifically made as a component of the patented apparatus and method. *Id.*

14. *State Contracting & Eng'g Corp. v. Florida*, 217 F.3d 850 (Fed. Cir. 1999) [*State Contracting IV*].

15. *See infra* notes 82-111.

16. *See infra* notes 82 and 83.

17. *State Contracting I*, 2000 WL 34220818, at *7.

18. *State Contracting II*, 258 F.3d at 1333.

19. *Id.* at 1335-37.

20. *Id.* at 1337-38.

21. *Id.* at 1338-40. The Federal Circuit found that the Supplemental Agreement governing the use of the VECP "does not provide a license for patent rights to the private contractors" and that it "only conveyed rights to use 'data' in future contracts, and did not in terms convey the right to manufacture the sound barriers using plaintiffs' design or to use plaintiffs' manufacturing method." *Id.* Importantly, the Supplemental Agreement "did not explicitly convey any patent rights, require the contractor to surrender its rights to the technology, or bar the contractor from securing a patent on the invention." *Id.* at 1340.

22. *See infra* notes 82-111, in particular notes 82 and 83.

23. *State Contracting II*, 258 F.3d at 1336.

voluntary, and cannot be implied or constructive.”²⁴ In *State Contracting*, there was no express waiver by Florida.²⁵ In addition, the implied waiver arguments based on Florida’s defense of the litigation²⁶ and filing of a counterclaim did not satisfy the ‘express and voluntary’ requirement.²⁷ To have held otherwise would imply that Florida had waived sovereign immunity even though it believed such a defense was unavailable at the time of the filing.²⁸

On remand, the district court denied the contractors’ motion to dismiss for lack of standing based on their allegation that State Paving’s patent assignment to State Contracting was not valid.²⁹ The contractors then stipulated to “literal infringement of both... patents, subject to their affirmative defenses.”³⁰ In the end, “the district court ruled as a matter of law that the contractors’ infringement was not willful, that the asserted patent claims were not invalid, and that the contractors did not have a valid defense of laches.”³¹ State Contracting then appealed the willfulness determination, and the contractors cross-appealed by challenging the standing, laches, patent validity, and damages determinations.³² The Federal Circuit affirmed the district court’s findings with the exception of validity, for which it remanded the case for a second time to determine obviousness relative to the prior art.³³ Shortly thereafter, the issues became moot following the parties’ agreement to dismiss the action.³⁴

24. *Id.*

25. *Id.* at 1336-37.

26. “It is quite clear that [defending the litigation] do[es] not amount to a waiver.” *Id.* at 1336.

27. *Id.* The timing was important since, at the time Florida filed its counterclaim, “Congress had abrogated the state’s patent infringement immunity;” as a consequence, “Florida could not have reasonably expected to prevail on its sovereign immunity defense.” *Id.* at 1337.

28. The Court announced that the test for finding that a state has waived its sovereign immunity “should be one of ‘reasonable expectation’ rather than ‘reasonable possibility,’ thus allowing some greater latitude for the filing of protective counterclaims . . . without waiving immunity.” *Id.* at 1337. The *Seminole Tribe* decision “did not create a reasonable expectation that the state would prevail on its sovereign immunity claim with respect to the patent infringement counts;” therefore, “the filing of a counterclaim during a period when the State was reasonably unsure about the availability of an immunity defense was not a waiver” of its sovereign immunity since a State cannot waive what it does not have. *Id.*

29. *State Contracting III*, 346 F.3d at 1061.

30. *Id.*

31. *Id.* at 1062.

32. *Id.* at 1060.

33. *Id.*

34. *State Contracting & Eng’g Corp. v. Condotte Am. Inc.*, 2003 WL 22718029 (Fed. Cir.). This was not the end of the story though; issues later arose over why the State of Florida was paying the legal fees of the contractors. *See Dan*

II. Sovereign Immunity Under the Eleventh Amendment

A. The Catalyst for Passage of the Eleventh Amendment

Shortly after the ratification of the Constitution, an early Supreme Court case spurned the passage of the Eleventh Amendment. In 1793 in *Chisholm v. Georgia*, the Court found that a private citizen of South Carolina could sue Georgia in federal court.³⁵ Nearly a century later, the Supreme Court retrospectively observed that its decision in *Chisholm* “created such a shock of surprise throughout the country that, at the first meeting of Congress thereafter, the Eleventh Amendment to the Constitution was almost unanimously proposed, and was in due course adopted.”³⁶

B. The Supreme Court’s Sovereignty Interpretations

The Eleventh Amendment effectively overruled the *Chisholm* decision.³⁷ The wording of the Eleventh Amendment states that the jurisdiction of the federal courts “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.”³⁸ Yet in spite of its wording, subsequent “judicial interpretation has broadened the Amendment’s scope far beyond its text.”³⁹ An early expansion of Eleventh

Christensen, *Patently Unusual: Companies That Infringed on Noise-Barrier Patent Have Their Legal Fees Paid by Transportation Department*, MIAMI DAILY BUS. REV., Feb. 28, 2003, at 1. It appears that the contracts between Florida and the contractors contained a provision which stated that “if any patent or license fees are . . . required . . . for use of the sound barrier wall called for by the plans, [then] any such fees or royalties required and paid by the contractor will be reimbursed by the [Florida] department” of transportation. *Id.*

35. *Chisholm v. Georgia*, 2 U.S. (2 Dall.) 419 (1793). Writing for the majority, Justice Iredell stated that the States “are subordinate to the authority of the United States, and their individual sovereignty is in this respect limited. But it is limited no farther than the necessary execution of such authority requires.” *Id.* at 436.

36. *Hans v. Louisiana*, 134 U.S. 1, 11 (1890).

37. *See id.* The Eleventh Amendment “actually reversed the decision of the Supreme Court” in *Chisholm*. *Id.*

38. U.S. CONST. amend. XI. The Court avoided a literalist interpretation of this wording in 1821 when it held that the Eleventh Amendment’s silence in regard to suits between a State and one of its citizens was “proof that the federal Courts never had [such] jurisdiction.” *Cohens v. Virginia*, 19 U.S. (6 Wheat.) 264, 315 (1821).

39. Jennifer Polse, Comment, *Holding the Sovereign’s Universities Accountable for Patent Infringement after Florida Prepaid and College Savings Bank*, 89 CAL. L. REV. 507, 513 (2001).

Amendment sovereign immunity occurred in the 1890 case of *Hans v. Louisiana*.⁴⁰ In *Hans*, the Supreme Court initially conceded that “where the jurisdiction depends alone upon the character of the parties, a controversy between a state and its own citizens is not embraced” by the Eleventh Amendment’s text.⁴¹ Yet the Court, after recognizing the circumstances surrounding the drafting of the U.S. Constitution and passage of the Eleventh Amendment,⁴² concluded that federal jurisdiction does not extend to suits against a state by its own citizens, unless the state consents to the suit.⁴³ In so holding, the Court recognized that the Eleventh Amendment was “an affirmation of original constitutional design... [which] preserve[s] absolute state sovereign immunity from suits brought by individuals without a state’s consent.”⁴⁴

Nearly seventy-five years later, the Supreme Court addressed the issue of state consent when it rendered its decision in *Parden v. Terminal Railway of Alabama State Docks Department*.⁴⁵ In *Parden*, the issue was whether the State of Alabama was subject to federal railroad regulations as a result of its ownership of a railroad that was regulated by Congress.⁴⁶ The Court held that “the States surrendered a portion of their sovereignty when they granted Congress the power to regulate commerce;”⁴⁷ therefore, when a State operates a railroad in interstate commerce, it does so “in subordination to [Congress’s] power to regulate interstate commerce.”⁴⁸ The holding in *Parden* created the implied waiver exception, which states 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.”⁴⁹

A dozen years after *Parden*, the Court in *Fitzpatrick v. Bitzer* again questioned the scope of the Eleventh Amendment.⁵⁰ But unlike

40. *Hans*, 134 U.S. at 1.

41. *Id.* at 9-10.

42. *See generally id.* at 10-20.

43. *Id.* at 21 (Harlan, J., concurring). As a result, “states enjoyed absolute immunity from all unconsented suits in federal court, whether brought by resident or non-resident citizens.” Brandon White, Comment, *Protecting Patent Owners from Infringement by the States: Will the Intellectual Property Rights Restoration Act of 1999 Finally Satisfy the Court?*, 35 AKRON L. REV. 531, 538 (2002).

44. Steve Malin, *The Protection of Intellectual-Property Rights in a Federalist Era*, 6 COMP. L. REV. & TECH. J. 137, 144 (2002).

45. *Parden v. Terminal Ry. of Ala. State Docks Dep’t*, 377 U.S. 184 (1964).

46. *Id.*

47. *Id.* at 191.

48. *Id.* (quoting *United States v. California*, 297 U.S. 175, 184-85 (1936)).

49. *Id.* at 196.

50. *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976).

Parden, where Congress's legislative power was grounded in the Commerce Clause, the *Fitzpatrick* case asked whether Eleventh Amendment sovereign immunity may be "asserted in the context of legislation passed... under § 5 of the Fourteenth Amendment."⁵¹ In its analysis, the Court began by turning to its opinion in a late Nineteenth Century case, *Ex parte Virginia*,⁵² that dealt with the Civil War Amendments.⁵³ In *Fitzpatrick*, Justice Strong, writing for the Court, observed that the Thirteenth and Fourteenth Amendments

were intended to be... limitations of the power of the States and enlargements of the power of Congress. ... The prohibitions of the Fourteenth Amendment are directed to the States, and they are to a degree restrictions of State Power. ... Indeed, every addition of power to the general government involves a corresponding diminution of the governmental powers of the States. It is carved out of them. ... [T]he Constitution now expressly gives authority for congressional interference and compulsion in the cases embraced within the Fourteenth Amendment.⁵⁴

Embracing this nearly 100-year-old declaration, the Court held that the enforcement provisions of the Fourteenth Amendment limit the Eleventh Amendment.⁵⁵ In so holding, the Court noted that Congress was doing more than merely legislating under a plenary power. Rather, it was acting pursuant to authority granted by an Amendment which itself imposes limitations on state authority.⁵⁶

C. The Rehnquist Court: Steroids for Sovereign Immunity

51. *Id.* at 452-53. Section 5 of the Fourteenth Amendment provides that "Congress shall have power to enforce, by appropriate legislation, the provisions" of the Amendment. U.S. CONST. amend. XIV § 5. The *Fitzpatrick* case specifically dealt with whether a federal court could order a state to pay damages to an individual for violating the Civil Rights Act of 1964. *Fitzpatrick*, 427 U.S. at 447.

52. *Ex parte Virginia*, 100 U.S. 339 (1880).

53. *Id.* In summary, the Civil War Amendments, which are the Thirteenth through Fifteenth Amendments, abolish slavery, recognize the citizenship of individuals born or naturalized in the U.S. and subject to its jurisdiction, and guarantee the right to vote independent of race or prior slave status. U.S. CONST. amends. XIII – XV.

54. *Fitzpatrick*, 427 U.S. at 454-55 (quoting *Ex parte Virginia*, 100 U.S. at 345-48 (1880)). The Thirteenth and Fourteenth Amendments represent a "shift in the federal-state balance." *Id.* at 455.

55. *Id.* at 456. "[W]e think that the Eleventh Amendment . . . [is] necessarily limited by the enforcement provisions of § 5 of the Fourteenth Amendment." *Id.*

56. *Id.* "When Congress acts pursuant to § 5, not only is it exercising legislative authority that is plenary within the terms of the constitutional grant, it is exercising that authority under one section of a constitutional amendment whose other sections by their own terms embody limitations on state authority." *Id.*

The Fourteenth Amendment exception to state sovereign immunity has fared well over the years; however, *Parden's* implied waiver exception has not been as fortunate.⁵⁷ In 1985, the Supreme Court revisited the waiver issue in *Atascadero State Hospital v. Scanlon*.⁵⁸ In *Atascadero*, the plaintiff sought compensation under the Rehabilitation Act of 1973 for alleged discrimination by California State Hospital.⁵⁹ The district court dismissed the claim under the Eleventh Amendment, and the Ninth Circuit affirmed the dismissal on other grounds,⁶⁰ but the Supreme Court vacated the Ninth Circuit's ruling and remanded the case based on an earlier holding that contradicted the Ninth Circuit's rationale.⁶¹ On remand, the Ninth Circuit reversed the district court's dismissal and held that California's "consent to suit in federal court could be inferred from its participation in programs funded by the [Rehabilitation] Act."⁶² Recognizing that the Ninth Circuit was now in conflict with the First and Eighth Circuits, the Supreme Court granted certiorari to resolve the matter and proceeded to reverse the Ninth Circuit, declaring that "when acting pursuant to § 5 of the Fourteenth Amendment, Congress can abrogate the Eleventh Amendment without the States' consent."⁶³ This new, more stringent rule required that there be "an unequivocal expression of congressional intent to 'overturn the constitutionally guaranteed immunity of the several States'" and demanded that Congress "express its intention to abrogate the Eleventh Amendment in unmistakable language in the statute itself."⁶⁴

57. Malin, *supra* note 44, at 147.

58. 473 U.S. 234 (1985).

59. *Id.* at 236.

60. *Id.* The Ninth Circuit found that the plaintiff "failed to allege an essential element of a claim under § 504" of the Rehabilitation Act. *Id.* This essential element, in the Ninth Circuit's view, was that "a primary objective of the federal funds received by the defendants was to provide employment." *Id.*

61. *Id.* at 237. A year earlier, in *Consolidated Rail Corp. v. Darrone*, the Supreme Court "held that § 504's bar on employment discrimination is not limited to programs that receive federal aid for the primary purpose of providing employment. *Id.*; see also *Consol. Rail Corp. v. Darrone*, 465 U.S. 624 (1984).

62. *Atascadero*, 473 U.S. at 237. "The court based its view on the fact that the Act provided remedies, procedures, and rights against 'any recipient of Federal assistance' while implementing regulations expressly defined the class of recipients to include the States." *Id.*

63. *Id.* at 238. This was a natural result of the Court's holding in *Fitzpatrick*. *Id.*

64. *Id.* at 240, 243 (citing *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 99 (1984)). Yet it seems anomalous to say that Congress can overturn anything that is constitutionally guaranteed.

Four years later, in *Pennsylvania v. Union Gas Co.*,⁶⁵ the Supreme Court considered whether Congress can abrogate the States' sovereign immunity when it creates a cause of action against the States based upon its Commerce Clause powers.⁶⁶ In *Union Gas*, the Court "equated Congress's right to abrogate state sovereign immunity under the Fourteenth Amendment with [Congress's] right under the Commerce Clause"⁶⁷ and found that the difference between them was immaterial.⁶⁸ In support of its ruling that the Commerce Clause power permits abrogation,⁶⁹ the Court stated 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."⁷⁰

In 1996, the *Seminole Tribe* case⁷¹ dramatically curtailed Congress's power to abrogate when the Court affirmed an Eleventh Circuit holding and overruled *Union Gas*, declaring its decision in that case to be "a solitary departure from established law."⁷² Previously, the Court ruled that Congress has the power "to abrogate under only two constitutional provisions: the Fourteenth Amendment... and, in a plurality opinion, the Interstate Commerce Clause."⁷³ The test to determine whether the abrogation is valid has two elements, first, the intent of Congress to abrogate must be unequivocal and second, Congress must act pursuant to a valid exercise of power.⁷⁴

65. 491 U.S. 1 (1989).

66. *Id.* at 5.

67. Malin, *supra* note 44, at 149. "Like the Fourteenth Amendment, the Commerce Clause with one hand gives power to Congress while, with the other, it takes power away from the States." *Union Gas*, 491 U.S. at 16.

68. *Union Gas*, 491 U.S. at 16-17. "It cannot be relevant that the Fourteenth Amendment accomplishes this exchange [of power from the States to Congress] in two steps . . . , while the Commerce Clause does it in one." *Id.*

69. *Id.* at 19.

70. *Id.* at 19-20. Since the Commerce Clause can displace state authority absent Congressional action, "and it sometimes precludes state regulation even though existing federal law does not pre-empt it, . . . a conclusion that Congress may not create a cause of action for money damages against the States would mean that no one could do so." *Id.* at 20.

71. *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996).

72. *Id.* at 66.

73. *Id.* at 44-45, 59-60. The power to abrogate under the 14th Amendment was upheld in *Fitzpatrick*. See *supra* notes 50-56 and accompanying text. The power to abrogate under the Commerce Clause was upheld in *Union Gas*. See *supra* notes 65-70 and accompanying text.

74. *Seminole Tribe*, 517 U.S. at 55 (quoting *Green v. Mansour*, 474 U.S. 64 (1985)). "States may not be sued in federal court . . . unless Congress, pursuant to a valid exercise of power, unequivocally expresses its intent to abrogate the immunity." *Green v. Mansour*, 474 U.S. 64, 68 (1985).

After agreeing with the parties and the lower courts that the intent of Congress was unequivocal,⁷⁵ the Court moved on to the second element and looked to Justice Scalia's dissenting opinion in *Union Gas*.⁷⁶ In that case, Justice Scalia observed that Article III of the Constitution defines the extent of federal court jurisdiction⁷⁷ and stated that any attempt to expand Article III's scope by "thumbing through the Constitution, to see what *other* original grants of authority... might justify elimination of state sovereign immunity... is not the regime the Constitution establishes."⁷⁸ Such an approach, in Justice Scalia's words, is "contrary to the clear understanding of a century of cases regarding the Eleventh Amendment [and] contradicts our unvarying approach to Article III."⁷⁹ Chief Justice Rehnquist, writing for the majority in *Seminole Tribe*, announced that the Court was reconfirming that "the background principle of state sovereign immunity... is not so ephemeral as to dissipate when the subject [matter] of the suit... is under the exclusive control of the Federal Government."⁸⁰

Even when the Constitution vests in Congress the complete law-making authority over a particular area, the Eleventh Amendment prevents congressional authorization of suits by private parties against unconsenting States. The Eleventh Amendment restricts the judicial power under Article III, and Article I cannot be used to circumvent the constitutional limitations placed upon federal jurisdiction.⁸¹

75. *Seminole Tribe*, 517 U.S. at 56-57. The Congress has "provided an 'unmistakably clear' statement of its intent to abrogate." *Id.* at 56.

76. *Union Gas*, 491 U.S. at 29-45 (Scalia, J., dissenting).

77. *Id.* at 39. "Article III [sets] forth the *exclusive* catalog of permissible federal-court jurisdiction." *Id.*

78. *Id.* at 40. Expounding upon the Constitutional regime, Justice Scalia quotes Chief Justice Hughes from the 1934 case of *Principality of Monaco v. Mississippi*. *Seminole Tribe*, 517 U.S. at 68.

Behind the words of the constitutional provisions are postulates which limit and control. There is the essential postulate that the controversies, as contemplated, shall be found to be of a justiciable character. There is also the postulate that States of the Union, still possessing attributes of sovereignty, shall be immune from suits, without their consent, save where there has been a surrender of this immunity in the plan of the convention.

Id. (quoting *Principality of Monaco v. Mississippi*, 292 U.S. 313, 322-23 (1934), internal quotations omitted).

79. *Union Gas*, 491 U.S. at 39. "[B]oth the result in *Union Gas* and the plurality's rationale depart from our established understanding of the Eleventh Amendment and undermine the accepted function of Article III." *Seminole Tribe*, 517 U.S. at 66.

80. *Seminole Tribe*, 517 U.S. at 72.

81. *Id.* at 72-73.

D. Intellectual Property Yields to the States' Sovereign Immunity

On June 23, 1999, the state sovereign immunity issue in the context of intellectual property rights finally came to a head in twin cases: *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*⁸² [*Florida Prepaid I*] and *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*⁸³ [*Florida Prepaid II*]. As the case names suggest, both cases arose from the same underlying facts. College Savings Bank “marketed and sold certificates of deposit known as the CollegeSure CD [and]... obtained a patent for [this] financing methodology.”⁸⁴ The State of Florida created Florida Prepaid Postsecondary Expense Board (Florida Prepaid) to “administer[] similar tuition prepayment contracts available to Florida residents and their children.”⁸⁵ As a result of Florida Prepaid’s tuition repayment program, College Savings Bank filed suit in the District Court for the District of New Jersey, claiming that Florida Prepaid infringed the patent⁸⁶ and “violated § 43(a) of the Lanham Act by making misstatements about its own tuition savings plans in its brochures and annual reports.”⁸⁷

Florida Prepaid moved to dismiss both claims under the Eleventh Amendment.⁸⁸ The district court granted Florida Prepaid’s motion with regard to the Lanham Act claim⁸⁹ but ruled that Congress had abrogated the States’ sovereign immunity in the Patent and Plant Variety Protection Remedy Clarification Act⁹⁰ (Patent Remedy Act)

82. 527 U.S. 627 (1999).

83. 527 U.S. 666 (1999).

84. *Florida Prepaid I*, 527 U.S. at 630-31. The patent is entitled “Methods and Apparatus for Funding Liability of Uncertain Cost.” U.S. Patent No. 4,722,055 (issued Jan. 26, 1988); *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Bd.*, 948 F. Supp. 400, 401 (D.N.J. 1996) [*College Savings Bank*].

85. *Florida Prepaid I*, 527 U.S. at 631.

86. *Id.*

87. *Florida Prepaid II*, 527 U.S. at 671.

88. *College Savings Bank*, 948 F. Supp. at 401.

89. *Id.* The district court found that “the false advertising prong of the Lanham Act essentially protects the ‘right to be free from false advertising,’ that “being free from alleged false advertising simply does not qualify as a property right for purposes of the Due Process Clause of the Fourteenth Amendment,” and that “the false advertising prong of the Lanham Act . . . cannot be the basis for the abrogation of Eleventh Amendment immunity.” *Id.* at 426-27.

90. Patent and Plant Variety Protection Remedy Clarification Act, Pub. L. No. 102-560, 106 Stat. 4230 (1992) (codified at 35 U.S.C. §§ 271(h), 296).

and, as a result, the infringement claim could go forward.⁹¹ Florida Prepaid appealed the patent claim ruling to the Federal Circuit, and College Savings bank appealed the dismissal of the Lanham Act claim to the Third Circuit.⁹² The appellate courts each affirmed the district court rulings,⁹³ and both parties appealed to the Supreme Court which granted certiorari in both instances.⁹⁴

1. Trademarks vs. Sovereign Immunity - Sovereign Immunity Wins

Turning first to *Florida Prepaid II*, the Lanham Act case, the Supreme Court had to determine the validity of the Trademark Remedy Clarification Act⁹⁵ (TRCA), which subjects the States to suits in federal courts under the Lanham Act for false and misleading advertising.⁹⁶ The Court had two options for upholding the validity of the TRCA: either the statute is “a constitutionally permissible abrogation of state sovereign immunity” or it is “an invitation to waiver of such immunity which is automatically accepted by a State’s engaging in the activities regulated by the Lanham Act.”⁹⁷ Under *Seminole Tribe* the TRCA could not be upheld on the basis of Congress’s Commerce Power, however, College Savings Bank approached the issue by framing it in a way that would satisfy the *Fitzpatrick* decision.⁹⁸ College Savings Bank claimed that “Congress enacted the TRCA to remedy and prevent state deprivations without due process of... (1) a right to be free from a business competitor’s

91. *College Savings Bank*, 948 F. Supp. at 401, 420-26.

92. *Florida Prepaid I*, 527 U.S. at 627; *Florida Prepaid II*, 527 U.S. at 666.

93. The Federal Circuit concluded that “[b]ecause Congress clearly expressed its intent to abrogate the sovereign immunity of the states to suit for patent infringement [and] exercised its intent pursuant to a valid exercise of power, the decision of the district court denying Florida Prepaid’s motion to dismiss the claim as barred by the Eleventh Amendment” should be affirmed. *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Bd.*, 148 F.3d 1343, 1355 (Fed. Cir. 1998). The Third Circuit concluded that the Trademark Remedy Clarification Act [TRCA] exceeded the “clear limitations [of *Seminole Tribe*] on Congress’ power to abrogate a state’s Eleventh Amendment immunity” and that the district court’s dismissal should be affirmed. *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Bd.*, 131 F.3d 353, 366 (3d Cir. 1997). The Third Circuit also went on to “affirm the district court’s determination that Florida Prepaid did not waive its immunity either under *Parden* or through its participation in th[e] litigation.” *Id.*

94. *Florida Prepaid I*, 527 U.S. at 633-34; *Florida Prepaid II*, 527 U.S. at 671-72.

95. TRCA, Pub. L. No. 102-542, 106 Stat. 3567 (1992).

96. *Florida Prepaid II*, 527 U.S. at 668-69.

97. *Id.* at 669.

98. See *supra* notes 50-56 and accompanying text.

false advertising about its own product, and (2) a more generalized right to be secure in one's business interests."⁹⁹ The Court was not swayed by this legal craftsmanship and found that neither of these asserted rights qualified as property rights that were subject to the protection of the Due Process Clause.¹⁰⁰

Turning now to the issue of waiver, College Savings Bank, perhaps aware of *Parden's* shaky footing, proffered an alternative in an effort to salvage part of the holding. The bank suggested that Florida Prepaid had constructively waived its sovereign immunity.¹⁰¹ College Savings Bank argued that the constructive waiver occurred when Florida Prepaid voluntarily chose to sell and advertise its for-profit CDs in interstate commerce¹⁰² in spite of "being put on notice by the clear language of the TRCA that it would be subject to Lanham Act liability."¹⁰³ Forced to again confront its *Parden* holding, the Court characterized *Parden* as "an elliptical opinion... at the nadir of [its] waiver (and, for that matter, sovereign immunity) jurisprudence."¹⁰⁴ The Court then laid *Parden* to rest, stating that "the constructive-waiver experiment... was ill conceived" and there was "no merit in attempting to salvage any remnant of it."¹⁰⁵

99. *Florida Prepaid II*, 527 U.S. at 672.

100. *Id.* With regard to being free from false advertising, the Court noted that "[t]he hallmark of a protected property interest is the right to exclude others" as compared to the "false-advertising provisions [which] bear no relationship to any right to exclude." *Id.* at 673. The Court concluded that placing "within the Fourteenth Amendment the elusive property interests that are 'by definition' protected by unfair-competition law would violate [the Court's] frequent admonition that the Due Process Clause is not merely a 'font of tort law.'" *Id.* at 674. With regard to being secure in one's business interests, the Court found that such an argument "suffers from the same flaw" as the first because "business in the sense of *the activity of doing business*, or *the activity of making a profit* is not property in the ordinary sense -- and it is only *that*, and not any business asset, which is impinged upon by a competitors' [sic] false advertising." *Id.* at 675.

101. *Id.* at 676. College Savings Bank, and the United States as an intervenor defending the TRCA's constitutionality, maintained that "constructive waiver is appropriate where a State runs an enterprise for profit, operates in a field traditionally occupied by private persons or corporations, engages in activities sufficiently removed from 'core [state] functions,' . . . or otherwise acts as a 'market participant' in interstate commerce." *Id.* at 680.

102. *Id.* "Florida Prepaid constructively waived its immunity from suit by engaging in the voluntary and nonessential activity of selling and advertising a for-profit educational investment vehicle in interstate commerce." *Id.*

103. *Id.* This was intended to satisfy the for-profit distinction made by the Court in *Employees of Dept. of Pub. Health and Welfare of Mo. v. Dept. of Pub. Health and Welfare of Mo.*, 411 U.S. 279 (1973), and the express language requirement of *Edelman v. Jordan*, 415 U.S. 651, 673 (1974). *Florida Prepaid II*, 527 U.S. at 677-78.

104. *Id.* at 676.

105. *Florida Prepaid II*, 527 U.S. at 680.

Hammering the nail in *Parden*'s coffin, Justice Scalia, writing for the majority, stated that the Court's opinion in *Parden*

broke sharply with prior cases, and is fundamentally incompatible with later ones. We have never applied the holding of *Parden* to another statute, and in fact have narrowed the case in every subsequent opinion in which it has been under consideration. In short, *Parden* stands as an anomaly in the jurisprudence of sovereign immunity, and indeed in the jurisprudence of constitutional law. Today, we drop the other shoe: Whatever may remain of our decision in *Parden* is expressly overruled.¹⁰⁶

2. Patents vs. Sovereign Immunity - Sovereign Immunity Wins (again)

Having disposed of *Parden* and its implied-waiver doctrine, we now turn to *Florida Prepaid I*, in which the Court addressed the patent infringement claim permitted by the lower courts on the basis of the Patent Remedy Act.¹⁰⁷ The Court began by reiterating that, under its holding in *Seminole Tribe*, Congress may only abrogate the States' sovereign immunity by expressing an unequivocal intent to do so and by acting pursuant to a valid exercise of power.¹⁰⁸ Based upon the wording of the Patent Remedy Act, which provided that States would not have any form of immunity,¹⁰⁹ the Court agreed with the parties and the Federal Circuit that Congress's intent to abrogate was unmistakably clear.¹¹⁰ Whether Congress had acted pursuant to a valid exercise of power, however, remained to be seen and required an examination of the Patent Remedy Act in light of the Court's 1997 decision in *City of Boerne v. Flores*.¹¹¹

In *Boerne*, the Court considered whether the provisions of the

106. *Id.* Justice Scalia noted that "in formally overruling *Parden* we do no more than make explicit what [*Seminole Tribe*] implied." *Id.* at 683.

107. *See supra* notes 91 and 93 and accompanying text.

108. *Florida Prepaid I*, 527 U.S. at 635.

109. 35 U.S.C. § 296(a) (2000). The full text of the provision is as follows:

In general. Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for infringement of a patent under section 271, or for any other violation under this title.

Id.

110. *Florida Prepaid I*, 527 U.S. at 635.

111. 521 U.S. 507 (1997).

Religious Freedom Restoration Act¹¹² (RFRA) fell within the constitutional limits on Congress's power under the Fourteenth Amendment to abrogate the States' sovereign immunity.¹¹³ The Court began its analysis by reviewing the text of the Fourteenth Amendment.¹¹⁴ It noted that Congress' § 5 power "extends only to 'enforcing' the provisions of the Fourteenth Amendment,"¹¹⁵ therefore, the power is remedial, not substantive, in nature.¹¹⁶ As such, Congress can only enforce the Amendment's provisions; Congress cannot define what a constitutional violation is.¹¹⁷ In exercising its enforcement power, Congress must provide "a congruence and proportionality between the injury to be prevented or remedied and the means adopted to that end [since without] such a connection, legislation may become substantive in operation and effect."¹¹⁸ The Court then observed that the legislative record of the RFRA contained no findings that laws were passed based on religious bigotry.¹¹⁹ Given that the RFRA did not appear to be directed towards a pattern of religiously biased legislation, the Court concluded that it was "so out of proportion to a supposed remedial or preventive object that it cannot be understood as responsive to, or designed to prevent, unconstitutional behavior."¹²⁰ The rule from *Boerne*, therefore, was that laws enacted pursuant to Congress's

112. Religious Freedom Restoration Act, 42 U.S.C. § 2000bb (1993). In summary, the RFRA prohibited substantial burdens on the exercise of religion even if it resulted from a rule of general applicability unless it was "in furtherance of a compelling governmental interest" and was "the least restrictive means" of furthering that interest. *Boerne*, 521 U.S. at 515-16.

113. *Boerne*, 521 U.S. at 512.

114. *Id.* at 516-24.

115. *Id.* at 519.

116. *Id.* at 520. "The Fourteenth Amendment's history confirms the remedial, rather than substantive, nature of the Enforcement Clause." *Id.*

117. *Id.* at 519. "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." *Id.*

118. *Id.* at 520.

119. *Boerne*, 521 U.S. at 530. The "RFRA's legislative record lacks examples of modern instances of generally applicable laws passed because of religious bigotry." *Id.*

120. *Id.* at 532. In support of this, the Court observed that the RFRA's "[s]weeping coverage ensures its intrusion at every level of government, displacing laws and prohibiting official actions of almost every description and regardless of subject matter." *Id.* "Any law is subject to challenge at any time by any individual who alleges a substantial burden on his or her free exercise of religion." *Id.* The RFRA's requirement that a State demonstrate "a compelling interest and show that it has adopted the least restrictive means of achieving that interest is the most demanding test known to constitutional law." *Id.* at 534.

enforcement powers under the Fourteenth Amendment are only valid to the extent that they operate as remedial legislation to curtail pre-existing violations of rights guaranteed under the Fourteenth Amendment.¹²¹

In an effort to fit the Patent Remedy Act within the confines of *Boerne*, College Savings Bank adapted its TRCA argument¹²² to the Patent Remedy Act by noting that patents were a form of property and asserting that the Act was a valid exercise of Congressional “power pursuant to § 5 of the Fourteenth Amendment to enforce the guarantees of the Due Process Clause.”¹²³ This was the same reasoning used by the Federal Circuit to affirm the district court’s denial of Florida Prepaid’s summary judgment motion.¹²⁴ The Federal Circuit also found that the Act “was a proportionate response to state infringement and an appropriate measure to protect patent owners’ property” under *Boerne*.¹²⁵ On appeal, the Supreme Court was not persuaded by the Federal Circuit’s reasoning and proceeded to re-evaluate the Act under the *Boerne* and *Seminole Tribe* holdings.¹²⁶

Applying *Boerne*’s standard to the Patent Remedy Act’s abrogation of state sovereign immunity, the Court began by seeking out the Fourteenth Amendment violation that Congress was attempting to remedy.¹²⁷ Clearly, the target of the Act was unremedied State infringement of patent rights; however, the Court was quick to observe that Congress had not identified any pattern of State infringement or of constitutional violations.¹²⁸ In fact, the Court noted that the Federal Circuit had only identified two instances of State infringement in 110 years¹²⁹ and pointed out that one of the Act’s sponsors even conceded that there was no “evidence of massive

121. *See generally id.* at 516-29.

122. *See supra* note 99 and accompanying text.

123. *Florida Prepaid I*, 527 U.S. at 633.

124. *Id.* The Federal Circuit “reasoned that patents are property subject to the protections of the Due Process Clause and that Congress’ objective in enacting the Patent Remedy Act was permissible because it sought to prevent States from depriving patent owners of this property without due process of law.” *Id.*

125. *Id.* at 634.

126. *Id.* at 634-48.

127. *Id.* at 639.

128. *Id.* at 640.

129. *Florida Prepaid I*, 527 U.S. at 640. This does, however, reveal a potential case of circular reasoning. The lack of patent infringement cases against States may be due to their sovereign immunity, either real or apparent, accorded to them under the Eleventh Amendment. The Court appears to be citing the absence of cases that have thus far been barred by the U.S. Constitution as evidence that the underlying basis for such cases rarely arises.

or widespread violation of patent laws by the States.”¹³⁰

College Savings Bank nevertheless maintained that a State’s patent infringement, coupled with an assertion of sovereign immunity, constituted a deprivation of property without due process of law and without just compensation required under the Fifth Amendment.¹³¹

Taking issue with this theory, the Court noted that the deprivation “is not in itself unconstitutional; what is unconstitutional is the deprivation... without due process of law.”¹³² The absence of due process of law will only be found to exist when a State’s remedies are either inadequate or are non-existent.¹³³ Congress did not make such a finding in passing the Patent Remedy Act; in fact, Congress “barely considered the availability of state remedies... and hence whether the States’ conduct might have amounted to a constitutional violation.”¹³⁴ To the extent that Congress did consider the available State remedies, it only viewed them as being less convenient than the federal remedies rather than being constitutionally inadequate.¹³⁵

The Patent Remedy Act’s proponents also argued that abrogation of sovereign immunity provides greater uniformity in patent law.¹³⁶ Although this is true, the Court observed that uniformity “is a factor which belongs to the Article I patent-power calculus, rather than to any determination of whether a state plea of sovereign immunity deprives a patentee of property without due process of law.”¹³⁷ The merits of having uniformity need not be questioned, but under the Court’s analysis in *Seminole Tribe*, Congress does not have the power to abrogate the States’ sovereign immunity on the basis of its Article I powers.¹³⁸

130. *Florida Prepaid I*, 527 U.S. at 641.

131. *Id.* at 642-43.

132. *Id.* at 643 (quoting *Zinermon v. Burch*, 494 U.S. 113, 125 (1990)).

133. *Id.* When “challenging a property deprivation, the claimant must either avail himself of the remedies guaranteed by state law or prove that the available remedies are inadequate.” *Id.* (citing *Hudson v. Palmer*, 468 U.S. 517, 539 (1984) (O’Connor, J., dissenting)).

134. *Id.* Yet in his dissenting opinion, Justice Stevens found it “ironic that the Court should view [the failure to review the available State patent infringement remedies] as support for its holding. Given that Congress had long ago pre-empted state jurisdiction over patent infringement cases, it was surely reasonable for Congress to assume that such remedies simply did not exist.” *Id.* at 658 (Stevens, J., dissenting).

135. *Florida Prepaid I*, 527 U.S. at 644. “Congress itself said nothing about the existence or adequacy of state remedies in the statute or in the Senate Report, and made only a few fleeting references to state remedies in the House Report, essentially repeating the testimony of the witnesses.” *Id.*

136. *Id.*

137. *Id.*

138. See *supra* notes 77-81 and accompanying text. “The statute’s apparent and

The Court concluded that the legislative record of the Patent Remedy Act suggests that it was not enacted in response to “a history of ‘widespread and persisting deprivation of constitutional rights’ of the sort Congress ha[d] faced in enacting proper prophylactic § 5 legislation.”¹³⁹ Yet this shortcoming is not, in and of itself, dispositive of the matter since the targeted wrong may still exist.¹⁴⁰ However, given the lack of support in the record, the Court declared that the Act’s provisions were “so out of proportion to a supposed remedial or preventive object that [they] cannot be understood as responsive to, or designed to prevent, unconstitutional behavior.”¹⁴¹ As evidence of this defect, the Court pointed out that the Act was not limited to arguable cases of constitutional deprivations,¹⁴² to specific kinds of infringement,¹⁴³ or to suits involving States that provided questionable remedies or that frequently infringed patents.¹⁴⁴ Rather than limit the scope of the Act, Congress subjected every State to patent infringement suits in federal court for an indefinite period.¹⁴⁵ In summary, the Court found that “[t]he examples of States avoiding

more basic aims were . . . proper Article I concerns, [however] that Article does not give Congress the power to enact such legislation after *Seminole Tribe*.” *Florida Prepaid I*, 527 U.S. at 647-48

139. *Florida Prepaid I*, 527 U.S. at 645 (quoting *Boerne*, 521 U.S. at 526). “Instead, Congress appears to have enacted [the Patent Remedy Act] in response to a handful of instances of state patent infringement that do not necessarily violate the Constitution.” *Id.* at 645-46.

140. *Id.* at 646. “[T]he lack of support in the legislative record is not determinative.” *Id.*

141. *Id.* (quoting *Boerne*, 521 U.S. at 532). The expansive nature of the Act’s coverage is illustrated by the testimony in the House Report acknowledging the difficulty of “identify[ing] a patented product or process which might not be used by a state.” *Id.*

142. *Id.* at 646-7. An arguable case could be one in which “a State refuses to offer any state-court remedy for patent owners whose patents it had infringed.” *Id.*

143. *Id.* at 647. The Court hypothesized that suits could have been limited to instances “such as nonnegligent infringement or infringement authorized pursuant to state policy.” *Id.*

144. *Id.* “Remedial legislation . . . ‘should be adapted to the mischief and wrong which the [Fourteenth] Amendment was intended to provide against.’” *Boerne*, 521 U.S. at 532 (quoting *United States v. Stanley (Civil Rights Cases)*, 109 U.S. 3, 13 (1883)).

[T]he legislation which Congress is authorized to adopt . . . is not general legislation upon the rights of the citizen, but corrective legislation, that is, such as may be necessary and proper for counteracting such laws as the states may adopt or enforce, and which, by the amendment, they are prohibited from making or enforcing, or such acts and proceedings as the states may commit or take, and which by the amendment, they are prohibited from committing or taking.

United States v. Stanley (Civil Rights Cases), 109 U.S. 3, 13-14 (1883).

145. *Florida Prepaid I*, 527 U.S. at 647.

liability... by pleading sovereign immunity... are scarce enough, and any plausible argument that such action... deprived patentees of property and left them without a remedy under state law is scarcer still.”¹⁴⁶ Accordingly, the Supreme Court declared that “the Patent Remedy Act cannot be sustained under § 5 of the Fourteenth Amendment.”¹⁴⁷

III. Congressional Efforts to Abrogate the States’ Sovereign Immunity

In light of the Supreme Court’s determinations in *Seminole Tribe* and the *Florida Prepaid* cases, any effort by Congress to abrogate the States’ sovereign immunity will have to overcome several hurdles. First, Congress must unequivocally express its intent to abrogate.¹⁴⁸ Second, it must act pursuant to its enforcement powers under § 5 of the Fourteenth Amendment since the authority to abrogate has not been found elsewhere.¹⁴⁹ Third, in exercising its Fourteenth Amendment enforcement powers, Congress must make adequate findings regarding the unconstitutional activity of the States to support the remedial measures it adopts.¹⁵⁰ And fourth, it must narrowly craft its remedial measures such that they directly address the unconstitutional activity without unduly restricting otherwise constitutional State activity.¹⁵¹

The failure of the TRCA and the Patent Remedy Act in the *Florida Prepaid* cases, as well as the later failure of similar legislation directed towards copyright infringement,¹⁵² demonstrates the

146. *Id.*

147. *Id.*

148. *Seminole Tribe*, 517 U.S. at 55.

149. *Florida Prepaid II*, 527 U.S. at 670. In *Florida Prepaid II*, the Court pointed out that it “recognized only two circumstances in which an individual may sue a State. First, Congress may authorize such a suit . . . to enforce the Fourteenth Amendment Second, a State may waive its sovereign immunity by consenting to suit.” *Id.* (citations omitted).

150. *Florida Prepaid I*, 527 U.S. at 639. Congress “must identify conduct transgressing the Fourteenth Amendment’s substantive provisions.” *Id.*

151. *Id.* Congress “must tailor its legislative scheme to remedying or preventing such conduct.” *Id.* “[T]he object of valid § 5 legislation must be the carefully delimited remediation or prevention of constitutional violations.” *Florida Prepaid II*, 527 U.S. at 672.

152. Consistent with its approach in the TRCA and the Patent Remedy Act, Congress passed the Copyright Remedy Clarification Act (CRCA), 17 U.S.C. § 511 (2000), to subject the States to copyright infringement actions; however, the Fifth Circuit, applying the Supreme Court’s holdings in *Florida Prepaid I* and *Florida Prepaid II*, struck down the CRCA as unconstitutional. *Chavez v. Arte Publico Press*, 204 F.3d 601, 607 (5th Cir. 2000) (holding that the CRCA is, like the PRAC,

difficulties faced by Congress when it seeks to abrogate the States' sovereign immunity. In light of these efforts, on October 29, 1999, Senator Patrick Leahy introduced the Intellectual Property Protection Restoration Act of 1999 (IPPra) that again attempted to subject the States to patent infringement suits.¹⁵³ The IPPra contained three key elements: 1) it provided "policy arguments in favor of subjecting states to the federal intellectual property laws,"¹⁵⁴ 2) it contained "a provision requiring states to waive their sovereign immunity in order to receive the various forms of protection available under the federal intellectual property laws,"¹⁵⁵ and 3) it limited the direct abrogation of the States' sovereign immunity to constitutional, as opposed to statutory, violations by the States.¹⁵⁶

The 1999 draft of the IPPra was followed by a 2001 IPPra, which was a modified version proposed by Senator Leahy.¹⁵⁷ It eliminated the waiver-based participation provisions and replaced them with "a remedies equalization provision... that attempted to place states and private entities on the same footing by limiting relief available to a state that has not waived its sovereign immunity."¹⁵⁸ Less than a year later, this proposal was followed by the 2002

"an improper exercise of Congressional legislative power"); *Rodriguez v. Tex. Comm'n on the Arts*, 199 F.3d 279, 281 (5th Cir. 2000) (holding that the CRCA must fail because "[t]he interests Congress sought to protect in each statute are substantially the same and the language of the respective abrogation provisions are virtually identical").

153. S. 1835, 106th Cong. (1999). See Malin, *supra* note 44, at 177-89; Robert T. Neufeld, *Closing Federalism's Loophole in Intellectual Property Rights*, 17 BERKELEY TECH. L.J. 1295, 1309 (2002).

154. Neufeld, *supra* note 153, at 1309. The emphasis was upon the increasing involvement of States "in securing intellectual property rights and lawsuits concerning those rights, [yet the arguments] provided no factual findings or data to support" this assertion. *Id.*

155. *Id.* This provision "also contained penalties for states that apply for federal intellectual property protection and subsequently invoke the sovereign immunity defense to an intellectual property claim." *Id.*

156. *Id.* "For statutory violations, the . . . IPPra reaffirmed the existence of prospective relief against state officers available under the *Ex Parte Young* doctrine." *Id.* "For . . . infringement[s] that rise to the level of violations of the Fifth or Fourteenth Amendment, the . . . IPPra proposed reinstating abrogation of sovereign immunity by creating liability for states." *Id.*

157. *Id.* at 1310; S. 1611, 107th Cong. (2001). Parallel legislation was also proposed in the House. H.R. 3204, 107th Cong. (2001).

158. Neufeld, *supra* note 153, at 1310. The result of this provision was that "a state that relied on the protection of sovereign immunity could only recover the same relief a private entity could recover against such a state." *Id.* "Instead of requiring a waiver to participate . . . if a state chose to limit its liability, it would also assume a restriction on the potential relief it could seek in actions to protect its own intellectual property." *Id.*

IPPRAs,¹⁵⁹ which combined provisions from the previous IPPRAs and, in response to the Supreme Court's *Florida Prepaid* decisions, "contain[ed] factual support not available at the time Congress drafted the earlier legislation."¹⁶⁰

Congress has failed to enact the bills submitted in 1999, 2001 or 2002, but in 2003, when legislation was again proposed in both the House and the Senate,¹⁶¹ the House Committee on the Judiciary held a formal hearing to discuss the need to pass legislation to subject the States to patent infringement suits.¹⁶² The record of that hearing illuminates many of the issues that Congress must address in such legislation.¹⁶³ These issues include 1) clearly documenting State infringements,¹⁶⁴ such as those presented in the hearing,¹⁶⁵ 2)

159. S. 2031, 107th Cong. (2002).

160. Neufeld, *supra* note 153, at 1310. For a detailed analysis of the 2002 IPPRA, see *id.* at 1310-28.

161. S. 1191, 108th Cong. (2003). The Intellectual Property Protection Restoration Act of 2003 is essentially a resubmission of the bill from 2002. Compare S. 2031, 107th Cong. (2002) to S. 1191, 108th Cong. (2003). On June 5, 2003, Senator Patrick Leahy submitted the bill to the Senate, and Representative Lamar Smith submitted the bill to the House. S. 1191, 108th Cong. (2003); H.R. 2344, 108th Cong. (2003).

162. *Intellectual Property Protection Restoration Act of 2003: Hearing on H.R. 2344 Before the Subcomm. on Courts, the Internet, and Intellectual Prop., House Comm. on the Judiciary*, 108th Cong. (2003) [hereinafter *House IPPRA Hearing*]; available at http://commdocs.house.gov/committees/judiciary/hju87815.000/hju87815_of.htm.

163. See generally *id.*

164. *Id.* at 25. The need to include findings of State infringements is intended to address the Supreme Court's disappointment in the lack of such findings in the *Florida Prepaid I* case. "Congress identified no pattern of patent infringement by the States . . ." *Florida Prepaid I*, 527 U.S. at 640; see *supra* notes 127 and 128. A 2001 General Accounting Office report on "infringement actions against states . . . [found] that there are relatively few infringements of intellectual property rights by States." *House IPPRA Hearing*, *supra* note 162, at 26 (prepared statement of Ms. Marybeth Peters, Register of Copyrights, Copyright Office of the United States Library of Congress); *Intellectual Property: State Immunity in Infringement Actions*, GAO-01-811 (Sept. 2001). Later in the hearing, however, it was pointed out that "the GAO study, by relying exclusively on cases brought to court . . . fails to document the reality of this situation." *Id.* at 48 (statement of Mr. Mark Bohannon, General Counsel and Senior Vice President for Pub. Pol'y for the Software and Info. Indus. Ass'n). See also *supra* note 129.

165. "[H]undreds of pirated software programs were found on computers owned by a Maryland State hospital." *House IPPRA Hearing*, *supra* note 162, at 9 (opening statement of Rep. Lamar Smith, Member, House Comm. on the Judiciary). A California patent holder "allege[d] that the California Department of Health Services is infringing its patent for a method" related to prenatal screening and pointed out that "[t]he only large infringer of the patent is the California Department of Health Services which, under State law, has exclusive responsibility for prenatal screening." *Id.* at 11 (opening statement of Rep. Howard Berman, Member, House Comm. on the Judiciary). A New Hampshire community college that was allegedly engaged in software piracy "turned to the AG of New

recognizing that State institutions are increasingly involved in extremely profitable activities,¹⁶⁶ and 3) trying to avoid weakening the benefits that have been created through the Bayh-Dole Act.¹⁶⁷

IV. Plaintiff's Routes Around IP's Sovereign Immunity Impediment

Given the current impossibility of pursuing intellectual property infringement litigation directly against a State in federal court, an aggrieved rights holder (IP owner), like State Contracting from the introductory case, cannot pursue infringing States under the traditional mechanisms provided in 17 U.S.C. and 35 U.S.C.¹⁶⁸ An IP owner may, however, be able to obtain at least partial relief in a number of ways. The alternative mechanisms of relief include: seeking an injunction under the *Ex parte Young* doctrine, suing for inverse condemnation, utilizing state tort law, suing on a breach of license/contract theory, suing a municipality rather than a State, suing State officers directly, and having the United States sue the State on

Hampshire, who terminated negotiations and declared sovereign immunity." *Id.* at 49 (statement of Mr. Mark Bohannon, General Counsel and Senior Vice President for Pub. Pol'y for the Software and Info. Indus. Ass'n).

166. "According to the Association of University Technology Managers, the University of California system earned \$67 million in patent royalty income in 2001, the University of Florida \$62 million, [and the] University of Washington \$25 million." *Id.* at 11 (opening statement of Rep. Howard Berman, Member, House Comm. on the Judiciary). The NCAA "states that it expects to earn \$370 million in 2003 from licensing the exclusive rights to carry copyrighted broadcasts of NCAA sporting events. The public university members of the NCAA get their fair share of this broadcast money, which thus ends up in state coffers." *Id.* at 14 (prepared statement of Rep. Howard Berman, Member, House Comm. on the Judiciary). "The Association of University Technology Managers estimates that in 1999, tech transfer put \$40 billion in to the U.S. economy . . ." *Id.* at 37 (opening statement of Ms. Leslie Winner, General Counsel and Vice President, Univ. of N.C.).

167. 35 U.S.C. §§ 200-212 (2000). The Bayh-Dole Act, officially titled the Patent and Trademark Law Amendment Act of 1980, "gives public universities and the other universities the ability to retain patents from Federally-funded research grants." *House IPPRA Hearing, supra* note 162, at 36 (statement of Ms. Leslie Winner, General Counsel and Vice President, Univ. of N.C.). Equipped with ownership rights in the intellectual property developed using federal funds, universities now "depend on licensing these inventions to private existing or start-up companies. The incentive to these private companies . . . is [the] exclusivity that comes through the patent license." *Id.* at 37. The concern is that "[u]nder the proposed legislation, the universities cannot assure the exclusive use to the licensees unless the State waives immunity, and State universities . . . don't have the power to cause the State legislators to make this waiver." *Id.*

168. *See supra* Part III. Barring legislation that validly abrogates the immunity of the States, federal courts, which have exclusive jurisdiction over patent and copyright infringement suits, will never have jurisdiction over the States.

the right holder's behalf.¹⁶⁹

A. *Ex parte Young*

In *Ex parte Young*,¹⁷⁰ the Supreme Court was asked whether a federal court had the power to enjoin a State officer from actions that were unconstitutional when the officer maintains that such conduct was done under the State's authority.¹⁷¹ Answering in the affirmative, the Court stated that "the use of the name of the State to enforce an unconstitutional act... is a proceeding without the authority of and one which does not affect the state in its sovereign or governmental capacity."¹⁷² Under these conditions, the State cannot extend its immunity to the State officer and shield the officer from responsibility.¹⁷³ The effect of this ruling is that an IP owner may obtain "prospective injunctive relief... through a suit brought against the state official... which as a practical matter, binds the state itself."¹⁷⁴ Note, however, that this option only provides injunctive relief to prevent further infringement; it cannot yield damages since damages cannot be paid out of a State's treasury.¹⁷⁵

B. Inverse Condemnation

169. Malin, *supra* note 44, at 164-75. In his article, Mr. Malin also suggests introducing a Constitutional Amendment, but this is largely beyond the means of the average infringement litigant. *Id.* at 175.

170. 209 U.S. 123 (1908).

171. *Id.* at 149-50.

172. *Id.* at 159.

173. *Id.* at 160. If the conduct violates the U.S. Constitution, then the officer . . . comes into conflict with the superior authority of that Constitution, and he is in that case stripped of his official or representative character and is subjected in his person to the consequences of his individual conduct. The state has no power to impart to him any immunity from responsibility to the supreme authority of the United States. *Id.* at 159-60.

174. Roger C. Rich, *Can Congress Require that States Waive Their Immunity to Private Lawsuits in Exchange for Receiving Federal Patent Rights?*, 42 SANTA CLARA L. REV. 607, 617 (2002). The inapplicability of the State's sovereign immunity is premised on the theory that the infringing actions are "ultra vires of state-law authority [since] a state cannot enact a law violative of federal law." Malin, *supra* note 44, at 164.

175. White, *supra* note 43, at 562. The Eleventh Amendment "prevent[s] federal courts from ordering judgments to be paid to private parties out of state treasuries." *Id.* This rule, noted by the Court in *Edelman v. Jordan*, states "that a suit by private parties seeking to impose a liability which must be paid from public funds in the state treasury is barred by the Eleventh Amendment." *Edelman v. Jordan*, 415 U.S. 651, 663 (1974).

The second alternative, inverse condemnation, operates under a takings theory. It is called 'inverse' condemnation because the individual whose property has been taken is filing suit, as opposed to the traditional situation in which the State that is seeking the property files suit to obtain it.¹⁷⁶ The Supreme Court even mentioned this avenue of relief in its *Florida Prepaid I* opinion.¹⁷⁷ The basis for this suit lies in the protections that States have established for their citizens to prevent private property takings without due process.¹⁷⁸ To prevail, the claimant must establish: "(1) ownership of a property right, (2) that the defendant substantially participated in some activity for public use or benefit, (3) that the property was taken or damaged, thereby suffering loss or diminution in value, and (4) that the government's activity was the proximate or substantial cause of the taking or damage."¹⁷⁹ If, for some reason, this avenue cannot be pursued, then the State would have failed to provide an adequate remedy, and the IP owner would be able to pursue an action under the Fifth or Fourteenth Amendments.¹⁸⁰

C. State Tort Laws

State tort laws can provide a third avenue of relief. Under such laws, an IP owner may be able to assert "causes of action such as conversion, unjust enrichment, misappropriation, unfair competition, deceit, and misrepresentation" assuming that, like most States, the defendant State waived its sovereign immunity for tort claims.¹⁸¹ It is worth noting, however, that such a suit against a State may differ from suits against a private entity due to procedural requirements and limits on recovery that a State may impose, coupled with the requirement in most states that a claimant file a formal notice of the tort claim and exhaust all administrative remedies.¹⁸² Potential claimants should also be conscious of federal preemption

176. Malin, *supra* note 44, at 165.

177. *Florida Prepaid I*, 527 U.S. at 644 n.9. "[T]he State of Florida provides remedies to patent owners for alleged infringement on the part of the State. Aggrieved parties may pursue a legislative remedy through a claims bill for payment in full . . . or a judicial remedy through a takings or conversion claim." *Id.*; see also Peter S. Menell, Symposium on New Directions in Federalism, *Economic Implications of State Sovereign Immunity from Infringement of Federal Intellectual Property Rights*, 33 LOY. L.A. L. REV. 1399, 1414 (2000).

178. Menell, *supra* note 177, at 1414. "The constitutions of most states have analogs to the Fifth Amendment's Takings Clause." *Id.*

179. *Id.* at 1415.

180. *Id.* at 1417; see also *supra* notes 133-135 and accompanying text.

181. Menell, *supra* note 177, at 1417-18; Malin, *supra* note 44, at 167.

182. Menell, *supra* note 177, at 1418.

implications if the basis of the state tort claim is too analogous to the infringed federal right.¹⁸³

Applying the state tort law approach to the State Contracting case, the plaintiffs could turn to Florida's tort claims act.¹⁸⁴ The act waives the state's immunity for torts¹⁸⁵ and permits suit for property losses "caused by the negligent or wrongful act or omission of any [state] employee... while acting within the scope of the employee's office or employment."¹⁸⁶ But this may not necessarily provide full restitution to a plaintiff since the act caps recovery at \$100,000.¹⁸⁷ In addition to the limitation on recovery, the act requires the plaintiff to file the claim within four years of accrual and places limits on attorney fees,¹⁸⁸ and it shields state agents and employees from personal liability unless the individual "acted in bad faith or with malicious purpose or in a manner exhibiting wanton and willful disregard of... property."¹⁸⁹

D. Breach of License/Contract

Use of a breach of license/contract theory is only available when the IP owner has entered into an agreement with the State, and the State has breached the terms of the agreement. In such a situation, the State is often deemed to have waived its sovereign immunity.¹⁹⁰

183. *Id.* at 1418-19. "Federal law preempts . . . rights that are equivalent to any of the exclusive rights within the general scope of copyright and state laws that conflict with or undermine the comprehensive federal regime for protecting inventions." *Id.* (internal quotations omitted). *See generally id.* at 1418-22.

184. FLA. STAT. ANN. § 768.28 (West 2003).

185. § 768.28(1). "[T]he state, for itself and for its agents or subdivisions, hereby waives sovereign immunity for liability for torts." § 768.28(1).

186. § 768.28(1).

187. § 768.28(5). "Neither the state nor its agencies or subdivisions shall be liable to pay a claim or a judgment by any one person which exceeds the sum of \$100,000" or any aggregation of claims or judgments, "arising out of the same incident or occurrence, [that] exceeds the sum of \$200,000." § 768.28(1).

188. "Every claim . . . for damages for a negligent or wrongful act or omission pursuant to this section shall be forever barred unless the civil action is commenced . . . within 4 years after such claim accrues." § 768.28(14). "No attorney may charge, demand, receive, or collect, for services rendered, fees in excess of 25 percent of any judgment or settlement." § 768.28(8).

189. § 768.28(9)(a).

190. Menell, *supra* note 177, at 1425-28. "As with tort claims, intellectual property owners can bring contract claims against the state only if the state has waived its sovereign immunity and authorized suit for such claims. Many states expressly waive their sovereign immunity for contractual liability through their constitution or by state statute." *Id.* at 1425. Malin, *supra* note 44, at 167-68. A breach of license claim "depends on the state's agreement to waive sovereign immunity in such suits, but this is the norm. And many state courts infer that a state waives its sovereign immunity for contractual liability by validly entering into a

Although this theory may appear to be the now-defunct implied-waiver doctrine from *Parden*, it can be distinguished from *Parden* by observing that the State had voluntarily and unequivocally waived its immunity in the contract, even if the State attempts to assert immunity at trial.¹⁹¹ This proposition is supported by Justice Scalia's observation in *Florida Prepaid II* that the Court previously "held that a State may, *absent any contractual commitment to the contrary*, alter the conditions of its waiver and apply those changes to a pending suit."¹⁹² Therefore, once it is determined that the State's waiver was voluntary and unequivocal, the waiver "should be enforced, and the state should not be given an opportunity to reconsider its waiver at the time suit is brought against it to enforce its contractual obligations."¹⁹³

In *State Contracting*, the plaintiff's breach of contract theory, based on Florida's use of the VECP, was dismissed on a summary judgment motion;¹⁹⁴ however, the unique nature of the parties' contractual relationships may still create *de facto* infringement liability on the part of Florida. Recall that the infringement claims against Florida were dismissed on Florida's summary judgment motion, but that the infringement claims against the contractors were allowed to go forward.¹⁹⁵ Although the contract between Florida and the contractors required Florida to pay the contractor's legal fees,¹⁹⁶

contract." *Id.* at 168.

191. Christina Bohannon, *Beyond Abrogation of Sovereign Immunity: State Waivers, Private Contracts, and Federal Incentives*, 77 N.Y.U. L. REV. 273, 294 (2002).

192. *Id.* at 300 (emphasis added); *Florida Prepaid I*, 527 U.S. at 676 (citing *Beers v. Arkansas*, 61 U.S. 527 (1858)). Allowing a State to assert sovereign immunity at trial would frustrate two basic ideas. First, if the court can "ascertain that the state clearly waived its immunity by contract, there is no justification for additional inquiries [since] any waiver of immunity will be enforced only if given voluntarily and unequivocally." Bohannon, *supra* note 191, at 301. To allow a state to revoke a prior waiver would negate the court's jurisdiction and cause uncertainty in litigation. *Id.* And second, if the State could "revoke every contractual promise to waive its immunity," this would "pave the way for the systematic violation of vested contractual rights." *Id.* at 302.

193. *Id.* at 303. Procedural maneuvering, specifically removing a case to federal court, can also give rise to a voluntary and unequivocal waiver. *See Lapidus v. Bd. of Regents of the Univ. Sys. of Ga.*, 535 U.S. 613, 619 (2002) (noting that it is "anomalous or inconsistent for a State both (1) to invoke federal jurisdiction, thereby contending that the 'Judicial power of the United States' extends to the case at hand, and (2) to claim Eleventh Amendment immunity, thereby denying that the [power] extends to the case at hand").

194. *See supra* notes 12, 13, 17 and 20 and accompanying text.

195. *Supra* notes 19-21 and accompanying text; *State Contracting II*, 258 F.3d at 1335-40.

196. *Supra* note 34.

construction contracts often go further than that by indemnifying the contractors from patent and copyright infringement liability arising from their use of the plans and specifications.¹⁹⁷ Under such circumstances, an infringing state may find itself contractually liable for a third party's infringement, which effectively operates as an equivalent to induced infringement liability but without the sovereign immunity issue that arises in federal courts since the State's liability would arise under its contractual obligations rather than under 35 U.S.C.

E. Suing a Municipality

Suing the municipality is yet another option. Unlike the protection afforded to States by the Eleventh Amendment, the Supreme Court in *Lincoln County v. Luning*¹⁹⁸ observed that the amendment "does not protect state subdivisions or municipal corporations."¹⁹⁹ Therefore, such entities may be unable to assert sovereign immunity when faced with an infringement lawsuit.²⁰⁰ This is not, however, an absolute rule. The Supreme Court in *McMillan v. Monroe County*,²⁰¹ observed that a local official may, in fact, act on behalf of the state rather than the municipality.²⁰² As such, the actions of the local

197. See AM. INST. OF ARCHITECTS, *General Conditions of the Contract for Construction* (Construction Management Edition), AIA DOC. A201/CM (1980), at ¶ 4.17.1. "[T]he Owner . . . shall be responsible for [losses due to patent infringement] when a particular design, process or the product of a particular manufacturer or manufacturers is selected by such person or such person's agent." *Id.*

198. 133 U.S. 529 (1890). "The Eleventh Amendment limits the jurisdiction only as to suits against a state [and] 'is of necessity limited to those suits in which the State is a party on the record.'" *Id.* at 530 (quoting *Osborn v. Bank of the United States*, 22 U.S. (9 Wheat) 738 (1824)).

199. Malin, *supra* note 44, at 169.

200. This greatly benefits IP owners since "many potential government infringers [are] school districts, cities, counties, and local colleges." *Id.*

201. 520 U.S. 781 (1997). *McMillan* involved an allegation that a county sheriff in Alabama had violated § 1983 by "intimidat[ing the plaintiff] into making false statements and suppress[ing] exculpatory evidence." *Id.* at 783.

202. In *McMillan*, the Court was "guided by two principles." *Id.* at 785. The first is "whether governmental officials are final policymakers for the local [state] government in a particular area, or on a particular issue;" the second is that "the actual function of a governmental official, in a particular area, will necessarily be dependent on the definition of the official's functions under relevant state law." *Id.* at 785-86. The Court went on to conclude that "Alabama sheriffs, when executing their law enforcement duties, represent the State of Alabama, not their counties." *Id.* at 793. Six years later, this finding was echoed by the Eleventh Circuit in another case dealing with the actions of a sheriff. See also *Manders v. Lee*, 338 F.3d 1304, 1309 (11th Cir. 2003) (examining "four factors to determine whether an entity is an 'arm of the State' in carrying out a particular function"). "To receive

official would be shielded by the state's sovereign immunity.

F. Suing State Officers

A sixth option available to the IP owner is to sue a State officer directly. If the suit is against the officer in his or her personal capacity, then the State's sovereign immunity defense is not available.²⁰³ However, the official may still be able to use qualified immunity to block the suit.²⁰⁴ The availability of qualified immunity depends upon "the 'objective reasonableness' of the action" at issue.²⁰⁵ The underlying rationale for this defense is, at a basic level, a policy decision to reduce the social costs of damages suits against officials and reduce "the risk that the fear of personal monetary liability and harassing litigation will unduly inhibit officials in the discharge of their duties."²⁰⁶ If, on the other hand, the officer is acting in an official capacity, then the suit will be barred by the State's sovereign immunity.²⁰⁷

G. The United States as Plaintiff

A seventh option for an aggrieved IP owner is to get the United States to sue the infringing State on his or her behalf. The States have no sovereign immunity from suits brought by the federal government.²⁰⁸ Unfortunately, any such suit brought by the federal government will likely only seek injunctive relief since the federal government suffered no direct monetary loss due to the

Eleventh Amendment immunity, a defendant need not be labeled a 'state officer' or 'state official,' but instead need only be acting as an 'arm of the State,' which includes agents and instrumentalities of the State." *Id.* at 1308 (emphasis added).

203. Malin, *supra* note 44, at 169. Note that "a state's voluntary decision to indemnify its public servants does not transform a personal-capacity action against a state official into an official-capacity action against the state." *Id.* "[T]he *Eleventh Amendment* does not erect a barrier against suits to impose 'individual and personal liability' on state officers under § 1983." *Hafer v. Melo*, 502 U.S. 21, 30-31 (1991).

204. Malin, *supra* note 44, at 171.

205. *Id.* at 172.

206. *Id.* at 172-73.

207. *Id.* at 169. "State officers sued for damages in their official capacity are not 'persons' for purposes of the suit because they assume the identity of the government that employs them." *Hafer*, 502 U.S. at 27.

208. Malin, *supra* note 44, at 175; Rich, *supra* note 174, at 619. "[T]he immunity of the State is subject to the constitutional qualification that she may be sued in [the Supreme] Court by the United States, a sister State, or a foreign State." *United States v. Minnesota*, 270 U.S. 181, 195 (1926).

infringement.²⁰⁹ If, on the other hand, the federal government did seek and obtain monetary damages from the infringing State, the IP owner would “have to rely on additional legislation allowing recovery of any damages awarded to the United States following a successful lawsuit.”²¹⁰

Conclusion

In light of the Supreme Court’s opinions in *Seminole Tribe* and the *Florida Prepaid* cases, the doctrine of State sovereign immunity seems to have solidified into a substantial, yet not completely unavoidable, barrier to enforcing intellectual property rights against infringements by a State. The latest abrogation offerings contained in Congress’s several IPPRA drafts appear to address the issues underlying the Court’s invalidation of prior statutes that subjected the States to suit in federal court. Yet until Congress enacts such legislation, and such legislation survives the inevitable Constitutional challenges, aggrieved IP owners will have to rely on a patchwork of remedies that, while not grounded in the provisions of 17 U.S.C. and 35 U.S.C., can serve as an interim mechanism to prevent infringement, or at least suspend ongoing infringement, of their intellectual property rights.

209. Malin, *supra* note 44, at 175.

210. Rich, *supra* note 174, at 619.