awards attached to each infringing "transaction." On the other hand, each continuing "act" of infringement would not give rise to additional statutory minimum awards.

VI. Conclusion

This Note illustrates the potential inadequacy of a statutory damage remedy under the 1976 Copyright Act when both plaintiff's actual damages and defendant's profits attributable to the infringement are unascertainable and the infringer's actions constitute multiple infringing "transactions." In such cases, where a prevailing plaintiff is relegated to a statutory damage remedy, it is not unlikely that either the plaintiff's damages or the defendant's profits considerably exceed the maximum statutory award permissible. This scenario invites infringement. Prospective infringers may take the risk, recognizing that the maximum liability to which they will be exposed is one statutory maximum award.

To further the goals of the 1976 Copyright Act, courts should be statutorily permitted to recognize the multiplicity doctrine. The 1976 Act, as did the 1909 Act, gives courts broad discretionary power in determining statutory damage awards. Courts have not abused this power in the past. And, exorbitant statutory damage awards stemming from multiple infringements such as were feared when revision of the copyright law was proposed, have never materialized. There is no reason to believe that by permitting the courts to employ the "time and heterogeneity" tests to multiple infringing "transactions," they will abuse this enhanced discretionary power. Indeed, application of the time and heterogeneity tests will further the goals of the Copyright Act—compensation for harm done and deterrence of future infringement.

Peter Thea

COPYRIGHT INFRINGEMENT SUITS AGAINST STATES: IS THE ELEVENTH AMENDMENT A VALID DEFENSE?

I. Introduction

The eleventh amendment[1] and the issue of state sovereign immunity[2] has been aggressively debated by the Justices of the Supreme Court since 1985.[3] Four justices have seriously questioned the foundation, scope and jurisprudence of the eleventh amendment, which was enacted in 1793—almost 200 years ago.[4] The same four justices also doubt the existence of the doctrine of state sovereign immunity in American law.[5] The other justices continue to support these doctrines and have repeatedly denied plaintiffs remedies against states in various circumstances.[6]

The issue of whether states can be sued for copyright infringement in federal court is important in light of the wide variety of authors, artists and inventors who could have their copyrighted works infringed by the states, state officials and

[1] The eleventh amendment states that "[t]he 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. XI.

[2] For an historical analysis of sovereign immunity, *see infra* notes 34-51 and accompanying text. *See also* Jaffe, *Suits Against Governments and Officers: Sovereign Immunity*, 77 Harv. L. Rev. 1 (1963); Pugh, *Historical Approach to the Doctrine of Sovereign Immunity*, 13 La. L. Rev. 476 (1953); Tribe, *Intergovernmental Immunities in Litigation, Taxation, and Regulation: Separation of Powers Issues in Controversies about Federalism*, 89 Harv. L. Rev. 682 (1976).

[3] *See* Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941 (1987); Papasan v. Allain, 478 U.S. 265 (1986); Green v. Mansour, 474 U.S. 64 (1985); Atascadero State Hosp. v. Scanlon, 473 U.S. 234 (1985). In all of these cases, Justice Brennan led the dissenting opinions which question the validity of sovereign immunity and the eleventh amendment jurisprudence.

[4] Justices Brennan, Marshall, Blackmun, and Stevens have consistently supported this position. For a discussion of their arguments, see *infra* notes 72-117 and accompanying text.

[5] Justice Brennan strongly advocates that "[i]f the [sovereign immunity] doctrine were required by the structure of the federal system created by the Framers, [he] could accept it. Yet the current doctrine intrudes on the ideal of liberty under law by protecting the States from the consequences of their illegal conduct." *Welch*, 107 S. Ct. at 2970.

[6] Justices Rehnquist, White, O'Connor and Scalia currently support this position. *Welch*, 107 S. Ct. at 2942. Justice Powell, who sided with these justices, retired and has been replaced by Justice Kennedy. Justice Kennedy could be a pivotal vote since some conservatives do not view him as conservative as President Reagan's previous appointments—Justices O'Connor and Scalia. Other scholars have stated that Justice Kennedy's opinions are similar to Justice Powell's. N.Y. Times, Nov. 12, 1987, at B10, col. 3. Thus, the Court's present composition portends an uncertain future for copyright suits against states. For a discussion of how the composition of the Court affected previous suits against states, see *infra* notes 71-117 and accompanying text.

agencies that contract for use of their works.[7] The question of whether the eleventh amendment bars such suits against states is still an open one since the Court has denied *certiorari* for the only case brought before it on this issue.[8] Future cases involving this issue are expected to be brought before the Court since the issue has split the decisions of the district courts and the circuit courts[9] and the close positions of the Supreme Court justices regarding state sovereignity.[10]

[7] It is essential that this Court resolve the conflict in the circuits. The issue of state compliance with the copyright laws is of substantial practical importance, because "[t]he states' use of copyrighted materials is systematic and significant. It encompasses a large market including textbooks, training manuals, films, videos, computer software, and advertising materials. If federal remedies are unavailable, the potential harm to individuals is significant."

Brief for Petitioner at 9, Cardinal Indus., Inc. v. King, 811 F.2d 609 (11th Cir.) (No. 86-3354), *cert. denied*, 56 U.S.L.W. 3205 (U.S. Oct. 5, 1987) (No. 86-1941) [hereinafter Brief for Petitioner] (quoting Note, *infra* note 9, at 165) (footnotes omitted).

[8] Cardinal Indus., Inc. v. King, 811 F.2d 609 (11th Cir. 1987), *cert. denied*, 56 U.S.L.W. 3205 (U.S. Oct. 5, 1987) (No. 86-1941). The Eleventh Circuit affirmed without opinion the Middle District Court of Florida which extended eleventh amendment immunity to state university employees and thereby dismissed the copyright infringement action. Cardinal Industries, the petitioner, a manufacturer of factory-assembled modular housing, sued two employees of a state university for copying its copyrighted floor plans for a student housing project. Brief for Petitioners, *supra* note 7, at 2-4.

It is well established that the Court's denial of a writ for *certiorari* is of no authoritative or precedential value. *See, e.g.*, United States v. Shubert, 348 U.S. 222, 228-29 n.10 (1955); Brown v. Allen, 344 U.S. 443, 451-57, 488-97 (1953); Agoston v. Pennsylvania, 340 U.S. 844 (1950); Maryland v. Baltimore Radio Show, 338 U.S. 912, 917-19 (1950); Pyzynski v. Pennsylvania Cent. Transp. Co., 438 F. Supp. 1044 (W.D.N.Y. 1977).

[9] The following cases held that the states were not immune from copyright infringement suits: Mills Music, Inc. v. Arizona, 591 F.2d 1278 (9th Cir. 1979); Johnson v. University of Virginia, 606 F. Supp. 321 (W.D. Va. 1985); Lemelson v. Ampex Corp., 372 F. Supp. 708 (N.D. Ill. 1974). *See infra* notes 169-204 and accompanying text.

The following cases held that states were immune from copyright infringement suits: Mihalek Corp. v. Michigan, 814 F.2d 290 (6th Cir. 1987); Wihtol v. Crow, 309 F.2d 777 (8th Cir. 1962); Richard Anderson Photography v. Radford Univ., 633 F. Supp. 1154 (W.D. Va. 1986); Woelffer v. Happy States of Am., Inc., 626 F. Supp. 499 (N.D. Ill. 1985). *See infra* notes 204-46 and accompanying text. The Western District of Virginia in *Anderson* and the Northern District of Illinois in *Woelffer* changed their views after the Supreme Court decided Atascadero State Hosp. v. Scanlon, 473 U.S. 234 (1985).

Since "states do not normally undertake commercial activities of the type which would subject them to liability for patent or copyright infringement, there are very few reported cases relating to the effect of sovereign immunity on this class of federal litigation." Brief for Appellee at 39, Mills Music, Inc. v. Arizona, 591 F.2d 1278 (9th Cir. 1979) (No. 75-3630) [hereinafter Brief for Mills Music]; *see also* Note, *The Applicability of Eleventh Amendment Immunity Under the Copyright Acts of 1909 and 1976*, 36 AM. U.L. REV. 163 (1986) (states should be subject to copyright infringement suits brought against them when acting in a proprietary rather than governmental role). *Cf.* Boyd v. Gulfport Mun. Separate School Dist., 821 F.2d 308, 310 (5th Cir. 1987) (governmental and proprietary distinction only relevant for municipalities not states).

[10] Sovereign immunity and the eleventh amendment, in the context of copyright or patent infringement suits against a state, has become a popular topic among commentators, each suggesting different solutions. *See* Note, *supra* note 9 (states should be subject to copyright infringement suits when acting in a proprietary rather than a governmental role); Note, *Congressional Abrogation of State Sovereign Immunity*, 86 COLUM. L. REV. 1436 (1986) (balancing state and federal interests should be imposed when determining whether Congress has the power to abrogate state sovereign immunity); Note, *Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?*, 40 VAND. L. REV. 225 (1987) (Congress should amend the exclusive jurisdictional statute—where copyright suits can only be brought in federal court under 28 U.S.C. § 1338(a)—to provide an exception that copyright claims against a state could be brought in state court).

This "issue, which requires accommodation of an important constitutional amendment and an important federal statute, demands a nationwide solution." Brief for Petitioner, *supra* note 7, at 9.

The copyright issue is unique from other issues that have come before the United States Supreme Court concerning a state's violation of federal statutes and its suability in federal court.[11] The Copyright Clause of the United States Constitution grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[12] Pursuant to this power, Congress enacted copyright laws which created a right of action against those who infringed on protected copyrights.[13] In conjunction with its goal for a nationally unified copyright system,[14] Congress enacted section 301 of the Copyright Act of 1976 which dictates that after January 1, 1978, "no person is entitled to any [copyright] or equivalent right in any such work under the common law or statutes of any State."[15] The exceptions to this rule are so narrow

[11] *See* Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941 (1987); *Atascadero*, 473 U.S. at 234; Pennhurst State School & Hosp. v. Halderman, 465 U.S. 89 (1984); Edelman v. Jordan, 415 U.S. 651 (1974); Employees of the Dep't of Pub. Health & Welfare v. Department of Pub. Health & Welfare, 411 U.S. 279 (1973); Parden v. Terminal Ry., 377 U.S. 184 (1964) (to the extent that *Parden* is "inconsistent with the requirement that an abrogation of Eleventh Amendment immunity by Congress must be expressed in unmistakably clear language," *Parden* is overruled by *Welch*, 107 S. Ct. at 2948). *See infra* notes 72-117 and accompanying text.

[12] U.S. CONST. art. I, § 8, cl. 8.

[13] *See* Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended 17 U.S.C. §§ 101-914 (1982 & Supp. IV 1986). Section 501(a) of the 1986 Copyright Act states that:

> [a]nyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118, . . . is an infringer of the copyright.

The Copyright Act was first enacted in 1790 and revised in 1831, 1870, 1909 and 1976. H.R. REP. No. 1476, 94th Cong., 2d Sess. 47, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5660. [hereinafter HOUSE REPORT].

[14] HOUSE REPORT, *supra* note 13, at 129. When discussing section 301 of the Copyright Act, the House Report states that:

> [b]y substituting a single Federal system for the present anachronistic, uncertain, impractical, and highly complicated dual system, the bill would greatly improve the operation of the copyright law and would be much more effective in carrying out the basic constitutional aims of uniformity and the promotion of writing and scholarship.

[15] 17 U.S.C. § 301 (1982). Prior to January 1, 1978, the states maintained juridiction over all common law copyright interests which included all unpublished works except those registered with the U.S. Copyright Office. On January 1, 1978, with the enactment of section 301, the common law definition of a copyrightable work was narrowed to include only works that had not been fixed in a tangible form. Therefore, if one developed a song in one's head and played it, but never reduced it to tangible form, i.e. wrote

that most copyrightable works will be protected exclusively under the federal Copyright Act.[16]

Additionally, Congress has provided exclusive jurisdiction in federal courts for a copyright owner to enforce his rights under the federal Copyright Act.[17] Therefore, the only forum where a copyright holder can seek relief from infringers is in the federal courts.[18]

Congress has created a right without a remedy when a state is the infringer.[19] If the Supreme Court maintains its current policy of upholding eleventh amendment immunity, a state could plead the eleventh amendment and not be sued for copyright infringement.[20] The only exceptions to the sovereign immunity

it down, then this song may be eligible for common law copyright protection. W. STRONG, THE COPYRIGHT BOOK: A PRACTICAL GUIDE 2-3 (1981).

16 *See* 17 U.S.C. § 301(b). The text of this section states that:

> (b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to-
>
> (1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or
>
> (2) any cause of action arising from undertakings commenced before January 1, 1978; or
>
> (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.

Some examples of works which are not "fixed in any tangible medium of expression" are "choreography that has never been filmed or notated, an extemporaneous speech, 'original works of authorship' communicated solely through conversations or live broadcasts, and a dramatic sketch or musical composition improvised or developed from memory and without being recorded or written down." HOUSE REPORT, *supra* note 13, at 131.

17 28 U.S.C. § 1338(a) (1982), which states that "[t]he district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, . . . copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent, . . . and copyright cases." *See* Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 231 n.7 (1964) (uniformity in copyright laws is exemplified in statutes that vest "exclusive jurisdiction to hear patent and copyright cases in federal courts, 28 U.S.C. § 1338(a)").

18 "Section 1338 of title 28, United States Code, also makes clear that any action involving rights under the Federal copyright law would come within the exclusive jurisdiction of the Federal courts." HOUSE REPORT, *supra* note 13, at 131.

19 *See* Jaffe, *supra* note 2, at 1 ("But at least in England [sovereign immunity] has not meant that the subject was without remedy. Perhaps the question has not been whether the doctrine of sovereign immunity was "right" but whether as a practical matter it ever has existed.").

The right without a remedy doctrine originated in a 1702 English case:

> Chief Justice John Holt [stated]: "If the plaintiff has a right, he must of necessity have means of vindication if he is injured in the exercise or enjoyment of it. Right and remedy, want of right and want of remedy, are reciprocal."

C. JACOBS, *infra* note 35, at 8 (footnote omitted).

20 The copyright owner would not have an alternative remedy.

> If the plaintiff cannot pursue its copyright infringement action against the defendants in the [state] courts because of exclusive federal jurisdiction . . . and if the plaintiff cannot sue the defendants in federal court because of sovereign immunity, Congress would have created, and the plaintiff would have suffered, a "wrong without a remedy [even though] plaintiff chose the proper forum and followed the statutory prescribed procedure by which to assert that remedy."

Brief for Mills Music, *supra* note 9, at 22-23 (quoting Leo Feist, Inc. v. Young, 138 F.2d 972, 974 (7th Cir. 1943) (citations omitted).

Although copyright owners who have obtained their rights under the federal Copyright Act of 1976 have no remedy in federal court against a state who infringes their copyright, owners may pursue other avenues. However, these remedies may not be as compensatory and are just a way for the courts to avoid the issue.

In Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941 (1987), the Court noted that "Welch is not without remedy. She may file a worker's compensation claim against the State under the Texas Tort Claims Act." 107 S. Ct. at 2953 n.19.

Another avenue a plaintiff might explore is the takings clauses of the fifth and fourteenth amendments. These amendments insure that property owners will be justly compensated if their property is taken by the federal or state government for public use. Copyrights and patents have been held to constitute property within the meaning of the fifth and fourteenth amendment takings clauses. Loretto v. Teleprompter Manhattan CATV Corp., 500 U.S. 450 (1982); Hercules, Inc. v. Minnesota State Highway Dep't, 337 F. Supp. 795 (D. Minn. 1972) (State may be enjoined from infringing a patent under takings clause even though protected by eleventh amendment from liability for damages).

Although a copyright owner could bring a suit under the takings clause in state court, he would still face the eleventh amendment block to federal court. Only two federal courts have discussed the takings clause in connection with state copyright infringement. *See* Mihalek Corp. v. Michigan, 821 F.2d 327, 328 (6th Cir.), *cert. denied*, 108 S. Ct. 503 (1987) (court found no taking of plaintiff's materials since the state "had not used, appropriated, or benefitted from plaintiff's property"); Lemelson v. Ampex Corp., 372 F. Supp. 708, 711 (N.D. Ill. 1974) (having decided the eleventh amendment issue in favor of the patent owner, the court found that a state could not take a patent without just compensation). A discussion of the interaction of the fifth, eleventh, and fourteenth amendments is beyond the scope of this Note.

21 *See infra* notes 118-42 and accompanying text. *See generally* Horrox, *Florida's Waiver of Sovereign Immunity: Fact or Fiction*, 16 STETSON L. REV. 805 (1987); Pagan, *Eleventh Amendment Analysis*, 39 ARK. L. REV. 447, 488-95 (1986); Comment, *Implied Waiver of a State's Eleventh Amendment Immunity*, 1974 DUKE L.J. 925; Note, *Express Waiver of Eleventh Amendment Immunity*, 17 GA. L. REV. 513, 526 (1983).

22 *See infra* notes 143-68 and accompanying text for a discussion of abrogation. *See generally* Pagan, *supra* note 21, at 496-98; Note, *Congressional Abrogation of State Sovereign Immunity*, 86 COLUM. L. REV. 1436 (1986).

23 If states expressly waived immunity, by passing waiver statutes, to be sued in federal court for copyright infringement cases, then this note would be moot. Some states have waived their sovereign immunity to tort suits in their own courts, but none have waived it for copyright suits. *See* Terrell v. United States, 783 F.2d 1562 (11th Cir. 1986); Borchard, *Government Liability in Tort*, 34 YALE L.J. 1 (1924); *Governmental Responsibility in Tort, VI*, 36 YALE L.J. 1 (1926).

24 The Supreme Court stated its standard for abrogation in Atascadero State Hosp. v. Scanlon that, "Congress must express its intention to abrogate the Eleventh Amendment in unmistakable language in the statute itself." 473 U.S. 234, 243 (1985).

defense are waiver[21] and abrogation.[22] Since the states have not specifically waived their immunity by consenting to copyright suits in federal courts,[23] this exception is not likely. The Supreme Court has required that Congress "unmistakenly" state that it subjects states to suit in federal court before the Court will invoke the abrogation exception.[24] Since there is no clear language currently in the Copyright Act, Congress and the Supreme Court have created a right without a remedy.

Part II of this Note will discuss the eleventh amendment and the doctrine of state sovereign immunity. Part III will discuss waiver and abrogation of a state's eleventh amendment immunity. Parts IV and V will analyze the lower federal court cases on this subject and the validity of their arguments. And, part VI will discuss whether Congress should force states to be subject to copyright infringement suits in federal courts.[25]

II. Is State Sovereign Immunity Enshrined in the Eleventh Amendment?

A. *Introduction*

An important element in analyzing copyright suits against states is the proposed defenses of eleventh amendment and sovereign immunity. The eleventh amendment states that the:

> [j]udicial 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.[26]

Since 1890, the United States Supreme Court has broadly interpreted the eleventh amendment and has even gone beyond the wording of the amendment to prevent suits brought by the citizens of the defendant state in federal court.[27] While the Court supports its broad interpretation with the doctrine of sovereign immunity,[28] it is not supported by explicit language in the Constitution nor is it specifically mandated by Congress.[29]

[25] This is not an unlikely result in view of the fact that the United States government is no longer immune from statutory copyright infringement suits. 28 U.S.C. § 1498 (1982):

> Hereafter, whenever the copyright in any work protected under the copyright laws of the United States shall be infringed by the United States . . . the exclusive remedy of the owner of such copyright shall be by action against the United States in the Claims Court for the recovery of his reasonable and entire compensation as damages for such infringement, including the minimum statutory damages as set forth in section 504(c) of title 17, United States Code.

See Williams & Wilkins Co. v. United States, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd*, 420 U.S. 376 (1975); 3 M. Nimmer, Nimmer On Copyright, § 12.01[E][1], at 12-18, 12-19 (1986) [hereinafter Nimmer].

[26] U.S. Const. amend. XI.

[27] *See infra* notes 65-72 and accompanying text. *See* Hans v. Louisiana, 134 U.S. 1 (1890). To date, *Hans* has never been retracted even though Justices Brennan, Marshall, Blackmun, Stevens and Scalia believe it was incorrectly decided. Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941, 2970 n.19 (1987).

[28] *See Atascadero*, 473 U.S. at 238 ("As we have recognized, the significance of this Amendment 'lies in its affirmation that the fundamental principle of sovereign immunity limits the grant of judicial authority in Art. III . . . .' ").

[29] "The original Constitution did not embody a principle of sovereign immunity as a limit on the federal judicial power. There is simply no reason to believe that the Eleventh Amendment established such a broad principle for the first time." *Atascadero*, 473 U.S. at 289 (Brennan, J., dissenting).

In 1973[30] four members of the Supreme Court began to take a second look at the eleventh amendment.[31] Justice Brennan, the chief spokesman for this position, has argued that the eleventh amendment should be interpreted narrowly to allow suits against states in federal courts when the claim is based on federal law.[32] Consequently, Justice Brennan's view proposes that the eleventh amendment should only prevent suits against states in federal courts brought under state law.[33] This proposal would preserve the eleventh amendment and the doctrine of sovereign immunity while providing a forum for suits based on federal law.

B. *How Important is the Doctrine of State Sovereignty to Our Legal System?*

Although there is no single clear definition for sovereign immunity,[34] the basic concept is that the sovereign who creates the

[30] *See* Employees of the Dep't of Pub. Health & Welfare v. Department of Pub. Health & Welfare, 411 U.S. 279, 309 (1973) (Brennan, J., dissenting) ("Indeed, despite some assumptions in opinions of this Court, I know of no concrete evidence that the framers of the Amendment thought, let alone intended, that even the Amendment would ensconce the doctrine of sovereign immunity.").

[31] *See Atascadero*, 473 U.S. at 259 (Brennan, J., dissenting):

> New evidence concerning the drafting and ratification of the original Constitution indicates that the Framers never intended to constitutionalize the doctrine of state sovereign immunity. . . . There simply is no constitutional principle of state sovereign immunity, and no constitutionally mandated policy of excluding suits against States from federal court.

The "new evidence" included debates from the State ratification conventions in which some legislators asserted that states should not enjoy sovereign immunity. *Id.*

[32] As Justice Brennan stated:

> The Eleventh Amendment can and should be interpreted in accordance with its original purpose to reestablish the ancient doctrine of sovereign immunity in state-law causes of action based on the state-citizen and state-alien diversity clauses; in such a state-law action, the identity of the parties is not alone sufficient to permit federal jurisdiction. If federal jurisdiction is based on the existence of a federal question or some other clause of Article III, however, the Eleventh Amendment has no relevance.

Atascadero, 473 U.S. at 301 (Brennan, J., dissenting). Justices Brennan, Stevens, Marshall, and Blackmun constituted the minority in *Atascadero*.

[33] *Id.*

[34] Various scholars have given their own definitions of sovereign immunity:

> "To Bracton the maxim "the king can do no wrong" meant simply that the king was not privileged to do wrong, but to Blackstone the phrase was not so restricted, and in his Commentaries the following is to be found: "Besides the attribute of sovereignty, the law also ascribes to the king in his political capacity absolute perfection. The king can do no wrong: . . . The king, moreover, is not only incapable of *doing wrong*, but even of *thinking* wrong: he can never mean to do an improper thing: in him is no folly or weakness."

Pugh, *supra* note 2, at 479 (quoting 1 W. Blackstone, Commentaries on the Laws of England 246 (Garland Publishing, Inc. reprint ed. 1978) (ed. 1783)).

law is immune from lawsuits brought pursuant to that law.[35] Justice Holmes extended his classic definition in *Kawananokoa v. Polyblank*:[36]

> A sovereign is exempt from suit, not because of any formal conception or obsolete theory, but on the logical and practical ground that there can be no legal right as against the authority that *makes the law* on which the right depends.[37]

If Holmes' definition was applied literally, there would be no basis for state sovereign immunity in the copyright context since the states did not create the federal Copyright Act.[38]

The doctrine of sovereign immunity was borrowed from our English ancestors.[39] However, many commentators assert that it does not fit into our democratic system.[40] Moreover, they assert that our courts have enforced the doctrine more stringently than the

[35] The right of sovereign immunity is a doctrine of the old English common law. As early as the 13th century, the King of England enjoyed immunity from suit in his own courts, but, he was not above the law and could be sued with his consent. C. JACOBS, THE ELEVENTH AMENDMENT AND SOVEREIGN IMMUNITY 5 (1972). Different theories regarding the origin of sovereign immunity in England: "[T]he king's immunity was personal to himself, and arose from the practical needs and peculiarities of the feudal system, rather than from any conception that the king is superior to the law." Pugh, *supra* note 2, at 478. According to Blackstone, the premise behind sovereign immunity was that the King could not do anything wrong but the waiver of immunity by consent was to benefit the people by providing legal redress. 3 W. BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND 254-55 (Garland Publishing, Inc. reprint ed. 1978 (ed. 1783)).

In America, colonial lawyers kept the doctrine of English sovereign immunity alive by reading Blackstone. C. JACOBS, *supra*, at 7. After the Revolutionary War, some states defaulted on their war debts to out-of-state creditors. These creditors could petition for satisfaction but they lacked an enforceable, legal remedy. *Id.* State sovereign immunity was an underlying concern in the ratification of the Constitution. For instance, the states were concerned about the wording of Article III, section 2, which states that "[t]he judicial Power shall extend to all Cases, . . . between a State and Citizens of another State . . . ." U.S. CONST. art. III, section 2. There is no distinction in this section as to whether the federal judiciary has jurisdiction over the states as plaintiffs or defendants. These concerns were addressed by Alexander Hamilton in The Federalist Papers. THE FEDERALIST No. 81 (A. Hamilton) (B. Wright ed. 1961). Hamilton assured the states that the wording referred to states as plaintiff since under the doctrine of sovereign immunity a state could not be sued without its consent:

> It is inherent in the nature of sovereignty, not to be amenable to the suit of an individual *without its consent*. This is the general sense and the general practice of mankind; and the exemption, as one of the attributes of sovereignty, is now enjoyed by the government of every State in the Union.

Id. at 548-49 (emphasis in original). The states were not protected under the Constitution after Chisholm v. Georgia, 2 U.S. (2 Dall.) 419 (1793).

[36] 205 U.S. 349 (1907). Holmes used Hobbes in formulating his definition of sovereign immunity. Pugh, *supra* note 2, at 490-91. Holmes has been greatly criticized. *See, e.g.*, Borchard, *Governmental Responsibility in Tort, V*, 36 YALE L.J. 757 (1927); C. JACOBS, *supra* note 35, at 154-55 (Holmes made "sovereignty" stronger than "kinship").

[37] *Kawananokoa*, 205 U.S. at 353 (emphasis added).

[38] 17 U.S.C. § 501(a) (1982). 3 NIMMER, *supra* note 25, § 12.01[E], at 12-19.

[39] Pugh, *supra* note 2, at 478, 481.

[40] It is just "common sense" that sovereign immunity should not be a part of American law. Pugh, *supra* note 2, at 480-81.

English did by creating situations where a plaintiff does not have a court in which to bring his claim.[41] Although not explicitly stated in the Constitution,[42] the Supreme Court has enforced the doctrine of sovereign immunity despite a lack of explicit reasoning for its existence:

> After almost a full century under the Constitution, Justice Miller, striving to interpret the scope of the immunity in the light of the reasons for it, observed that "while the exemption of the United States and of the several states from being subjected as defendants to ordinary actions in the courts has . . . been repeatedly asserted here, the principle has never been discussed or the reasons for it given, but it has always been treated as established doctrine."[43]

Justice Brennan explained why the doctrine is not expressly stated in the Constitution and why its existence in our law has caused confusion as to its origin:

> "We the People" formed the governments of the several States. Under our constitutional system, therefore, a State is not the sovereign of its people. Rather, its people are sovereign. Our discomfort with sovereign immunity, born of systems of divine right that the Framers abhorred, is thus entirely natural."[44]

The Supreme Court has expressed two basic reasons for protecting and enforcing the doctrine in favor of the states. The first involves the principle of federalism[45] and the second, a financial concern for state treasuries.[46] Our federalist system dictates the co-

[41] Jaffe, *supra* note 2, at 1. The creation of the eleventh amendment "has meant that relief which in England was available only by petition of right could not be had as a rule in this country without legislative consent." *Id.* at 20.

[42] *See* Atascadero State Hosp. v. Scanlon, 473 U.S. 234, 237-40 (1985) (Brennan, J., dissenting). *But see* Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941, 2945 (1987) ("The Court has recognized that the significance of the Amendment 'lies in its affirmation that the fundamental principle of sovereign immunity limits the grant of judicial authority in Art. III' of the Constitution.") (quoting Pennhurst State School & Hosp. v. Halderman, 465 U.S. 89, 98 (1984)).

[43] HART & WESCHLER, THE FEDERAL COURTS & THE FEDERAL SYSTEM 1339 (2d ed. 1973) (quoting United States v. Lee, 106 U.S. 196, 207 (1882)). Even though the doctrine of sovereign immunity was not embodied in the Constitution, some judges enforced it as a common law notion which could only be corrected by statute. C. JACOBS, *supra* note 35, at 151.

[44] Employees of the Dep't of Pub. Health & Welfare v. Dep't of Pub. Health & Welfare, 411 U.S. 279, 322-23 (1973) (Brennan, J., dissenting).

[45] *See Atascadero*, 473 U.S. at 246-47; *Pennhurst*, 465 U.S. at 105; *Employees*, 411 U.S. at 287; Parden v. Terminal Ry., 377 U.S. 184, 196 (1964).

[46] "[W]hen the action is in essence one for the recovery of money from the state, the state is the real, substantial party in interest and is entitled to invoke its sovereign immunity from suit even though individual officials are

existence of federal and state governments.[47] The theory is to reserve certain powers to the states which are not enumerated to the federal government.[48] A narrow interpretation of the eleventh amendment, thereby subjecting states to suits in federal courts under federal law, would not destroy traditional notions of federalism. The states would still have their separate powers and laws but would have to obey federal statutory laws like all citizens.

The Court's concern is that suits against the states have the potential to result in extraordinary damages which would have to be paid from state funds, essentially out of the taxpayers' pockets.[49] Fear that these damage awards against a state would threaten that state's ability to operate for their citizens' benefit was a major impetus in creating the eleventh amendment at a time when many states were practically bankrupt.[50] Today, however, state treasuries are not in danger of financial collapse as they were at the end of the Revolutionary War when the eleventh amendment was ratified.[51]

nominal defendants." Thus the rule has evolved 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) (citations omitted) (quoting Ford Motor Co. v. Department of Treasury, 323 U.S. 459, 464 (1945)).

47 *See* THE FEDERALIST No. 45, at 311 (J. Madison) (THE ENDURING FEDERALIST, C. Beard ed. 1974) ("The State governments may be regarded as constituent and essential parts of the federal government; whilst the latter is nowise essential to the operation or organisation of the former.").

48 *See* U.S. CONST. amend. X; THE FEDERALIST No. 45, at 328 (B. Wright Ed. 1974) ("The powers delegated by the proposed Constitution to the Federal Government, are few and defined. Those which are to remain in the State Governments are numerous and indefinite.").

49 *See* Brown, *State Sovereignty Under the Burger Court*, 74 GEO. L.J. 313 (1985) (state treasuries must be protected from suits against states). *See generally* Frug, *The Judicial Power of the Purse*, 126 U. PA. L. REV. 715 (1978); Nagel, *Separation of Powers and the Scope of Federal Equitable Remedies*, 30 STAN. L. REV. 661 (1978); Note, *Private Suits Against States in the Federal Courts*, 33 U. CHI. L. REV. 331 (1966). However, taxpayers have a right to sue their own state for misappropriation of public funds. Hoohuli v. Ariyoshi, 741 F.2d 1169 (9th Cir. 1984); O'Donnell v. Kusper, 602 F. Supp. 619 (N.D. Ill. 1985); Birdine v. Moreland, 579 F. Supp. 412 (N.D. Ga. 1983).

50 C. JACOBS, *supra* note 35, at 69-70. Although the underlying reason for ratifying the eleventh amendment was to secure state sovereign immunity, there was no clear evidence to suggest why the states should enjoy immunity from suits initiated by citizens of other states or foreign countries. C. JACOBS, *supra* note 35, at 70. A common explanation was the state and national concern over the Confederate debt incurred by the Revolutionary War. *Id.* at 69-70.

51 Since 1975, the states have experienced an excess in total revenue over total expenditures. In 1984, the states retained a $45.7 billion excess of total revenue which was due to increased revenue rates, expenditure controls and reduced unemployment costs. *See* COUNCIL OF STATE GOVERNMENTS, THE BOOK OF STATES 226-27 (1986-87 ed.).

> [W]e are not dealing here with a statute that would substantially interfere with state operations or impose "enormous fiscal burdens on the states." States have no compelling governmental need to infringe copyrights; on those occasions when states must use protected materials, they need only pay royalities—as private persons, corporations, cities and counties, and the United States would be obliged to do in similar circumstances. The burden

Now, even if the states are heavily indebted, there are safeguards such as federal grants, credit and required state financial planning to help stabilize state treasuries. States should not be allowed to abuse the rights of its citizens and then escape liability by hiding behind the slim possibility of bankrupting state treasuries.

The authenticity of the doctrine of state sovereign immunity is important because the Supreme Court has interpreted the eleventh amendment as a representation of state sovereign immunity. If sovereign immunity is but a hollow doctrine without meaning or reasons for its existence in our law, then the eleventh amendment jurisprudence of almost 200 years is fallacious.

C. *Eleventh Amendment Jurisprudence Should Be Overruled*

The eleventh amendment was quickly ratified[52] to reverse the Supreme Court's decision in *Chisholm v. Georgia*.[53] In *Chisholm*, a South Carolina citizen sued the state of Georgia for money that Georgia owed for the price of military goods it bought in 1777. The Court held that a state could be sued in federal court under the state-citizen diversity clause in article III of the Constitution.[54] The states, infuriated that their right of

on the states of complying with copyright laws would be no greater than the burden of paying just compensation when any other private property is taken for public use.

Brief for Petitioner, *supra* note 7, at 15 (quoting *Employees*, 411 U.S. at 284). For example, in its fiscal year 1984-85, New York State reported $51 million excess of receipts over disbursements from its General Fund, which is the state's principle operating fund. ROCKEFELLER INSTITUTE OF GOVERNMENT, 1985-86 NEW YORK STATE STATISTICAL YEARBOOK 350 (12th ed.).

52 This amendment was proposed by the states two days after the Supreme Court's decision in Chisholm v. Georgia, 2 U.S. (2 Dall.) 419 (1793). A resolution similar to the eleventh amendment was introduced into the Senate and debated on February 25, 1793. C. JACOBS, *supra* note 35, at 66-68 (1972). In *Chisholm*, a South Carolina citizen brought suit against the state of Georgia to recover an outstanding war debt. Alexander Chisholm, the executor of the estate of Robert Farquhar, brought the case to enforce a contract for the sale of war supplies in 1777 to Georgia Commissioners. Although delivery of the supplies were made, Farquhar was never paid. Georgia refused to appear, asserting that the Supreme Court did not have jurisdiction and that it was immune from such suits. *Chisolm*, 2 U.S. at 419. The Court entered default judgment against Georgia based on the arguments of Chisholm's counsel, Attorney General Randolph. *Id.* at 480. Edmund Randolph proposed a resolution to the Philadelphia Convention on May 29, 1787 in criticism of the Confederate government. The language of this resolution was later incorporated in article III, § 2 of the U.S. Constitution. C. JACOBS, *supra* note 35, at 15. Randolph argued that the states transferred their right of sovereign immunity to the people and ultimately to the national government when they formed the Union and ratified the Constitution. *Id.* at 49-50. Chief Justice Jay agreed and stated that since the Supreme Court had jurisdiction over suits between the states, it had jurisdiction over suits where individuals sue states. *Chisholm*, 2 U.S. at 476. Chief Justice Jay reasoned that if a state may sue citizens of another state, the reverse should also be permitted. C. JACOBS, *supra* note 35, at 66-68.

53 2 U.S. (2 Dall.) 419 (1793).

54 Article III, section 2, states that "[t]he Judicial Power shall extend to all Cases . . .

sovereign immunity had been eliminated without their consent,[55] also feared that the Supreme Court would be able to dictate how and when their debts would be paid, if at all, to noncitizen creditors.[56] The language of the amendment specifically prohibits suits against states by citizens of other states or foreign states thereby protecting states from those not subject to their own laws. Although there is no express language in the eleventh amendment which restricts its application to federal question or diversity suits, it refers generally to "any suit in law or equity."[57] The suit in *Chisholm* was brought under state law and on the basis of diversity jurisdiction. Brennan's argument[58] that the eleventh amendment should only be applicable to state law claims is consistent with the states' concern of protecting their own laws against foreign individuals.

Initially, the Supreme Court applied the eleventh amendment narrowly. In *Cohens v. Virginia*,[59] the Cohens brothers were convicted in state court of selling lottery tickets in violation of Virginia law. The issue was whether the eleventh amendment barred the Cohens from appealing to the Supreme Court, thereby subjecting a state to suit in federal court. The Supreme Court held that the eleventh amendment was not a bar since the eleventh amendment only applied to citizens of other states or foreign countries, and the Cohens were Virginia citizens. Chief Justice Marshall supported his holding by stating that in article III "the judicial power was extended to all cases arising under the constitution or laws of the United States, without respect to parties."[60]

This case is consistent with Brennan's proposal since it satisfies the first requirement of his test for applying the eleventh amendment.[61] The first requirement is that the individuals suing the state must be citizens of another state or foreign state.[62] If the individuals are suing their own state, the eleventh amendment does not apply and they can sue their state in federal court. One reason that supports this situation is that the money received by citizens from their state, if they win their case will, most likely stay in the state. The second requirement is that the state be in violation of state law.[63] Individuals from other states can only sue the state in federal court if the state has violated federal law.[64] If the state has violated its own law, it can invoke the eleventh amendment and sovereign immunity in federal court. The individuals from other states can bring their claim in state courts unless the states have waived their immunity in their own courts. In this situation the plaintiff does not have a court in which to bring his claim. This is the cost of maintaining the doctrine of sovereign immunity in our legal system.

The Court's narrow interpretation of the eleventh amendment only lasted until 1890 when *Hans v. Louisiana*[65] was decided. Hans, a citizen of Louisiana, sued the State of Louisiana for payment on bonds that the state government had repudiated. Hans' complaint alleged that such conduct violated the contracts clause of the United States Constitution.[66] The case was brought to the federal courts under federal question jurisdiction.[67] The Court held that the eleventh amendment barred the suit against the state.[68] Hans' claim was similar to the claim alleged in *Chisholm*,[69] namely, a creditor suit against the state.[70] However, *Hans* involved a citizen suing his own state on a federal law question, while *Chisholm* involved a citizen of another state suing under state law.[71] Despite these significant differences, the *Hans*

between a State and Citizens of another State; . . . ." U.S. CONST. art. III, § 2. *See infra* note 68.

55 *See supra* note 52.

56 C. JACOBS, *supra* note 35, at 70. Before and after *Chisholm*, the Supreme Court had decided a number of cases dealing with war debts in favor of British subjects and against states under the Treaty of Peace. *Id.* at 45, 72-74.

57 U.S. CONST. amend. XI. For the full text of the amendment, see *supra* note 1.

58 *Employees*, 411 U.S. at 322-23 (Brennan, J. dissenting).

59 19 U.S. (6 Wheat.) 264 (1821). Chief Justice Marshall wrote the majority opinion in both *Cohens* and *Chisholm*.

60 *Id.* at 412.

61 *See supra* note 32 and accompanying text.

62 *See* Pennhurst State School & Hosp. v. Halderman, 465 U.S. 89, 125 (1984) (Brennan, J., dissenting).

63 *See* Atascadero State Hosp. v. Scanlon, 473 U.S. 234, 261 (1985) (Brennan, J., dissenting).

64 "The restatement of the principle of *Cohens* demonstrates Marshall's understanding that neither Article III nor the Eleventh Amendment limits the ability of the federal courts to hear the full range of cases arising under federal law." *Atascadero*, 473 U.S. at 298 (Brennan, J., dissenting).

65 134 U.S. 1 (1890).

66 U.S. CONST. art. I, § 10, cl. 1.

67 In 1875, Congress provided that the federal district courts shall have original jurisdiction of federal questions. 28 U.S.C. § 1331 (1982).

68 *Hans*, 134 U.S. at 1. Brennan contends that *Hans* was decided incorrectly since *Hans* relied on history that was "plainly mistaken". The *Hans* court misinterpreted the comments of Madison, Marshall and Hamilton in the ratification debates. But,

> [r]ead literally and in context, all three were explicitly addressed to the particular problem of the state-citizen diversity clause. . . . All three are fully consistent with a recognition that the Constitution neither abrogated nor instituted state sovereign immunity, but rather left the ancient doctrine as it found it: a state-law defense available in state-law causes of action prosecuted in federal court.

Atascadero, 473 U.S. at 300 (Brennan, J., dissenting).

69 2 U.S. at 420.

70 *Id.*

71 *Id.*

decision broadened the scope of the eleventh amendment.[72] After *Hans*, the states enjoyed absolute immunity from all suits brought against them in federal court whether initiated by their own citizens or outside citizens, and whether under state or federal law. Currently, the only recourse for plaintiffs is to bring the suit in the state courts provided that the state does not claim immunity before its own courts. This is an unjust result since even if the suits can be brought in state courts there is a possibility of bias in favor of the state.

The Supreme Court interpreted the eleventh amendment narrowly in *Parden v. Terminal Railway of the Alabama State Docks Department*, the first eleventh amendment case brought under a federal statute.[73] Justice Brennan, writing for the majority, held that the state had waived its sovereign immunity in federal court.[74] In *Parden*, Alabama citizens sued an Alabama state-owned railway in federal court to recover damages under the Federal Employers Liability Act ("FELA")[75] for personal injuries sustained while employed by the Railway. Justice Brennan stated that although the eleventh amendment was not applicable since the parties were from the same state, the *Hans* decision was still good law.[76] Brennan distinguished *Hans* by stating that:

> [t]his case is distinctly unlike *Hans v. Louisiana* . . . where the action was a contractual one based on state bond coupons . . . . Such a suit on state debt obligations without the State's consent was precisely the "evil" against which both the Eleventh Amendment and the expanded immunity doctrine of the *Hans* case were directed. Here, for the first time in this Court, a State's claim of immunity against suit [brought] by an individual meets a suit brought upon a cause of action expressly created by Congress.[77]

[72] *See supra* notes 68-71 and accompanying text.

[73] 377 U.S. 184 (1964) (overruled by Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941 (1987). This decision was 5-4 with Justices Brennan, Warren, Black, Clark, and Goldberg constituting the majority and Justices White, Douglas, Harlan, and Stewart dissenting. All of the Supreme Court cases that have dealt with the issue of state immunity under the eleventh amendment were close decisions. It is interesting to note that most of the Justices stood by their respective views and that the new members to the bench did not alter the closeness of the votes. Cf. *Ex Parte* Young, 209 U.S. 123 (1908); Principality of Monaco v. Mississippi, 292 U.S. 313 (1934).

[74] For a discussion on the issue of "waiver," see *infra* notes 122-29 and accompanying text.

[75] 45 U.S.C. §§ 51-60 (1982).

[76] *Parden*, 377 U.S. at 192. Justice Brennan had to distinguish *Hans* since *Hans* extended eleventh amendment immunity to states sued by their own citizens. Justice Brennan refused to follow *Hans* in *Parden*.

[77] *Id.* at 186-87.

Due to the close decision, Justice Brennan was careful to note that *Hans* had not been overruled. In order to reach the fair result of compensating the injured railroad workers and to preserve the eleventh amendment and sovereign immunity, the majority created a compromise which they called implied or constructive waiver of the state's immunity.[78] The court did not follow the implied waiver theory in subsequent cases. Indeed, *Parden* was overruled in *Welch v. Texas Department of Highways and Public Transportation*.[79]

The Supreme Court refused to follow the *Parden* holding in *Employees of the Department of Public Health & Welfare v. Missouri Department of Public Health & Welfare*,[80] where the employees sued to recover overtime compensation owed to them under the Fair Labor Standards Act ("FLSA").[81] The majority refused to deprive Missouri of its "constitutional immunity" to suit in federal courts since it could not find clear congressional intent in the applicable provision.[82] The majority distinguished *Parden* on the basis that the state-defendant in *Parden* was a profit making railroad business, whereas the defendants in this case were state mental hospitals, state cancer hospitals and training schools for delinquent girls which are all non-profit.[83] The Court's reasoning may be that by suing a state profit making entity the state treasury will remain secure. However, this is hardly a significant distinction in light of the fact that the state's funds may still be used to finance the losses of the state-owned profit entity. The majority also distinguished *Parden* by reasoning that the "dramatic circumstances of the *Parden* case, which involved a rather isolated state activity can be put to one side. [The problems dealt with here] may well implicate elevator operators, janitors, charwomen, security guards, secretaries, and the like, in every office building in a State's governmental hierarchy."[84] This distinction appears faulty since the scope of FELA in *Parden* could also include numerous employees, and the fact that the state's actions could affect so many people should compel the state to abide by the federal statute enacted to protect those people. Pursuant to Justice Bren-

[78] *Id.* at 192. For a discussion on implied waiver, see *infra* notes 122-29 and accompanying text.

[79] 107 S. Ct. 2941 (1987). For a discussion of *Welch*, see *infra* notes 108-17 and accompanying text.

[80] 411 U.S. 279 (1973). This was a 6-2-1 decision. Justices Douglas, Burger, White, Blackmun, Powell, and Rehnquist constituted the majority. Justices Marshall and Stewart concurred and Justice Brennan was the lone dissenter. Justices Douglas, White, and Stewart had dissented in *Parden*.

[81] 29 U.S.C. § 216(b) (1982).

[82] *Employees*, 411 U.S. at 285.

[83] *Id.* at 284.

[84] *Id.* at 285.

nan's test, the eleventh amendment would not have prevented this suit in federal court since the plaintiffs were citizens of the same state.

The next case to confront the issues raised by application of the eleventh amendment under federal statutes was *Edelman v. Jordan*.[85] In *Edelman*, Jordan filed a class action against the officials of the Illinois Department of Public Aid for administering benefits under the federal-state program of Aid to the Aged, Blind, and Disabled ("AABD").[86] The state's own regulations were less favorable than the federal regulations.[87] The majority held that the federal courts may only award prospective injuctive relief but not retroactive awards which require payment of public funds from the state treasury.[88] The majority also weakened the implied theory of *Parden* by holding that Illinois did not waive its immunity by participating in the AABD program. The opinion did not discuss the differences between *Parden* and *Employees* but merely stated the "rule" as being "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."[89] The doctrine of state sovereign immunity constitutionalized in the eleventh amendment was thought to be a well established principle[90] even though the aged, blind and disabled were cheated out of benefits they should have received from the state.

The Supreme Court further extended its broad interpretation of the eleventh amendment in *Pennhurst State School & Hospital v. Halderman*[91] and *Atascadero State Hospital v. Scanlon*.[92] In *Pennhurst*, a

85 415 U.S. 651 (1974). This was a 5-4 decision. Justices Rehnquist, Burger, Stewart, White, and Powell were the majority while Justices Douglas, Brennan, Marshall, and Blackmun dissented.

86 42 U.S.C. § 1302 (1982).

87 45 C.F.R. § 206.10(a)(3)(ii) (1987) (Agency has no more than 60 days to make a decision on an application for AABD).

88 *See Ex Parte* Young, 209 U.S. 123 (1908); *see also supra* note 46.

89 *Edelman*, 415 U.S. at 663 (citing Great Northern Life Ins. Co. v. Read, 322 U.S. 47 (1944)); Kennecott Copper Corp. v. State Tax Comm'n, 327 U.S. 573 (1946).

90 *Edelman*, 415 U.S. at 662-63.

91 465 U.S. 89 (1984). This was also a 5-4 decision with Justices Powell, Burger, White, Rehnquist, and O'Connor constituting the majority and Justices Brennan, Stevens, Marshall, and Blackmun dissenting. For a diverse analysis of the *Pennhurst* case, see Chemerinsky, *State Sovereignty and Federal Court Power: The Eleventh Amendment After Pennhurst v. Halderman*, 12 HASTINGS CONST. L.Q. 643 (1985); Rudenstine, *Pennhurst and the Scope of Federal Judicial Power to Reform Social Institutions*, 6 CARDOZO L. REV. 71 (1984); Werhan, *Pullman Abstention After Pennhurst: A Comment on Judicial Federalism*, 27 WM. & MARY L. REV. 489 (1986); Note, *Pennhurst State School & Hospital v. Halderman: Federalism & State Law Claim*, 35 CASE W. RES. 481 (1985); Note, *The Limits of Federal Judicial Power Over the States: The Eleventh Amendment & Pennhurst II*, 26 B.C.L. REV. 947 (1985).

92 473 U.S. 234 (1985) (another 5-4 decision with Powell, Burger, White, Rehnquist and O'Connor constituting the majority, and Brennan, Stevens, Marshall and Blackmun dissenting. *See* Brown, *State Sovereignty Under the Burger Court—How the Eleventh Amendment*

Pennslyvania citizen sued a state institution for the mentally retarded, in which she was a resident, alleging that the institutions' poor conditions violated a state statute providing for the right of the mentally handicapped to adequate habilitation.[93] The Court held that the eleventh amendment barred state law claims brought into federal court under pendent jurisdiction.[94] The decision is consistent with a narrow view of the eleventh amendment in that it barred a suit against a state under state law. However, as Justice Brennan argued, the eleventh amendment should not have been invoked since the suit involved parties of the same state.[95]

In *Atascadero*, a California citizen who suffered from diabetes and blindness in one eye sued a state hospital for denying him employment due to his physical handicap claiming a violation of Section 504 of the Rehabilitation Act of 1973.[96] The five to four majority held that the eleventh amendment barred this suit in federal court[97] and stated:

> As we have recognized, the significance of this Amendment "lies in its affirmation that the fundamental principle of sovereign immunity limits the grant of judicial authority in Art. III" of the Constitution. Thus, in *Hans v. Louisiana*, the Court held that the Amendment barred a citizen from bringing a suit against his own State in federal court, even though the express terms of the Amendment do not so provide.[98]

The five to four struggle over the issue of state sovereign immunity and the eleventh amendment continued in *Green v. Mansour*[99] and *Papasan v. Allain*.[100] In *Green*, recipients of federal aid pursuant to the Aid to Families With Dependent Children Act ("AFDC")[101] sued the Director of the Michigan Department of Social Services for prohibiting the deduction of child care costs from income to deter-

Survived the Death of the Tenth: Some Broader Implications of Atascadero State Hosp. v. Scanlon, 74 GEO. L.J. 363 (1985).

93 *Pennhurst*, 465 U.S. at 92. The action was brought under the Pennsylvania Mental Health and Mental Retardation Act of 1966 which provides a right to adequate habilitation. *Id.* at 94.

94 The doctrine of pendant jurisdiction is "invoked when a plaintiff brings a federal question claim against a nondiverse defendant and seeks to have a related, state law claim against the same defendant adjudicated by the federal court as an incident to the federal claim." J. FRIEDENTHAL, KANE & MILLER, CIVIL PROCEDURE, § 2.12, at 66 (West 1985); *see* Owen Equip. & Erection Co. v. Kroger, 437 U.S. 365 (1978).

95 *Pennhurst*, 465 U.S. at 124 (Brennan, J., dissenting).

96 29 U.S.C. § 794 (1982).

97 *Atascadero*, 473 U.S. at 246.

98 *Id.* at 238 (citations omitted).

99 474 U.S. 64 (1985).

100 106 S. Ct. 2932 (1986).

101 42 U.S.C. §§ 601-615 (1982 & Supp. III 1985).

mine eligibility under AFDC. While the action was pending, Congress amended AFDC by expressly requiring the states to deduct child care costs.[102] The five to four majority refused to award a declaratory judgment because it found that the state had violated federal law before the congressional amendment. Declaratory relief in this case would have been in the form of damages or restitution. This would require payment from the state treasury and was therefore barred by the eleventh amendment.[103] Thus, even when Congress admits that the state was violating federal law, the state escapes liability through application of the ancient doctrine of sovereign immunity.

In *Papasan*, school officials and school children in twenty-three counties sued the State of Mississippi for denial of benefits from public school lands originally granted to their community.[104] The plaintiffs' asserted "that the federal grants of school lands to the State of Mississippi created a perpetual trust, with the State as trustee, for the benefit of the public schools."[105] The majority stated that "if [the] petitioners' legal characterization is accepted, their trust claims are barred by the Eleventh Amendment. The distinction between a continuing obligation on the part of the trustee and an ongoing liability for past breach of trust is essentially a formal distinction of the sort we rejected in *Edelman*."[106] However, the state did not totally escape liability in this case. The court invoked the only exception to the eleventh amendment—the *Ex Parte* Young exception. *Ex Parte* Young applies when an ongoing constitutional right is violated such as "the unequal distribution by the State of the benefits of the State's school lands."[107] The *Papasan* court held that the plaintiffs' equal protection claim was not barred by the eleventh amendment.

In *Welch v. Texas Department of Highways and Public Transportation*,[108] Welch, a state employee, was injured while working on a state-owned ferry dock. Welch brought an action under the Jones

102 *Green*, 474 U.S. at 65.
103 *Id.* at 65-66. The exception to the majority rule that states may not be sued in federal court is the *Ex Parte* Young exception, which states "that the Eleventh Amendment does not prevent federal courts from granting prospective injunctive relief to prevent a continuing violation of federal law . . . . [The Court] refused to extend the reasoning of *Young*, however, to claims for retrospective relief." *Id.* at 68.
104 *Papasan*, 106 S. Ct. at 2933.
105 *Id.* at 2941.
106 *Id.*
107 *Id.* at 2942. The *Ex Parte* Young exception usually applies to State officials acting in their official capacity. State officials were sued in an injunctive or declaratory action grounded on federal law, thereby overcoming the eleventh amendment in Kentucky v. Graham, 473 U.S. 159 (1985); *see* C. JACOBS, *supra* note 35, at 156.
108 107 S. Ct. 2941 (1987).

Act,[109] a federal statute enabling seamen to bring suit for personal injuries.[110] The Jones Act is the admiralty equivalent to the FELA in *Parden*.[111] Five members of the Court decided that the eleventh amendment barred Welch from suing Texas under the Jones Act in federal court and expressly overruled *Parden*.[112] Despite Justice Brennan's continuing dissent in sovereign immunity cases for over ten years, the majority clung to its previous decisions, while acknowledging that "[t]he rule of law depends in large part on adherence to the doctrine of *stare decisis*."[113] The majority conceded that the doctrine of *stare decisis* "is not rigidly observed in constitutional cases"[114] but refused to concur with the minority because the argument was allegedly based on "ambiguous historical evidence."[115] Instead, the majority relied on the Court's adherence to the principles of sovereign immunity for over a century, and did not address the merits of Welch's claim. The majority was satisfied that Welch had an alternative remedy in state court under state law.[116] The fact that no alternative forum is available for suits brought under the Copyright Act might persuade the Court to uphold an eleventh amendment exception for copyright infringement claims.

Even if the Court upholds its broad interpretation of the eleventh amendment, thereby protecting states from suit in federal court pursuant to federal law, a state may still be liable for copyright infringement by waiver or abrogation.[117]

III. WAIVER AND ABROGATION

A. *Introduction*

A state's immunity under the eleventh amendment may be waived. The Supreme Court has consistently held that a state may consent to suit against it in federal court.[118] Prior to *Welch*, there were three ways to overcome an eleventh amendment defense: 1) express waiver, where the state expressly gives its consent;[119] 2) implied waiver, where the state did not give its consent

109 46 U.S.C. § 688 (1982).
110 *Welch*, 107 S. Ct. at 2944.
111 *See supra* note 73-79 and accompanying text.
112 *Welch*, 107 S. Ct. at 2948, 2958.
113 *Id.* at 2948.
114 *Id.*
115 *Id.* at 2949.
116 *Id.* at 2953 n.19.
117 L. TRIBE, AMERICAN CONSTITUTIONAL LAW § 3-35 at 133-34 (1978).
118 Clark v. Barnard, 108 U.S. 436, 447 (1883).
119 State sovereign immunity has been eliminated by most state constitutions which permit their legislatures to create laws whereby the state consents to suits against it for outstanding debts and contract obligations. *See* Note, *supra* note 16, at 528. Most states

but the court construed the state's actions as a waiver of its immunity;[120] and 3) abrogation, where Congress subjects a state to suit in federal court by the language of a federal statute.[121] A state expressly waives its immunity to suit either in its own courts or federal courts when its legislature states the waiver either by statute or in the state constitution. The theories of implied waiver and abrogation were created by the Supreme Court as exceptions to the absolute immunity rule of the eleventh amendment.

B. *Implied Waiver: A Theory of the Past*

In *Parden v. Terminal Railway of the Alabama State Docks Department*[122], Justice Brennan created the theory of implied waiver:

> It remains the law that a State may not be sued by an individual without its consent. Our conclusion is simply that Alabama, when it began operation of an interstate railroad approximately 20 years after enactment of the FELA, necessarily consented to such suit as was authorized by that Act.[123]

The theory of implied waiver was based on three premises:[124] 1) the states adopted and ratified the Constitution which grants certain powers to Congress in article I (the *Parden* case concerned the Commerce clause);[125] 2) Congress enacted a federal statute pursuant to its article I powers and created a right of action which is conditioned on suit in federal court;[126] and 3) states which participate in the activity that Congress has regulated by federal statute have accepted the condition of federal jurisdiction and thus have consented to suit.[127]

Justice Brennan also argued that the question of whether a state has waived its immunity is a federal law question "whenever the waiver is asserted to arise from an act done by the State within the realm of congressional regulation."[128] Justice Brennan distinguished cases which held that the question of waiver depended on the state's intention and was a question of state law since these cases dealt with acts of state wholly within its own area of authority and did not concern interstate acts.[129]

The first premise of *Parden*'s implied waiver theory was that the states adopted and ratified the Constitution which grants certain powers to Congress in article I and thereby waived their immunity in these areas.[130] The relevant article I provision is the Copyright and Patent Clause which gives Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[131]

The second premise of implied waiver was congressional creation of a right of action pursuant to its article I power. Chapter five of the Copyright Act[132] addresses infringement of copyright. Section 501(a) states that "[a]nyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118, or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright."[133] Cases that hold that states are not immune from suits for copyright infringement[134] consider a state to be included in the term "any-

refuse to consent to suits of tort liability. *Id.* Since copyright and patent infringement is considered a tort, these states would be immune from common law copyright infringement suits. It is not clear whether states could be subject to suit in a statutory copyright action. 3 NIMMER, *supra* note 25, § 12.01[E][1], at 12-18.1.

120 *See* Parden v. Terminal Ry., 377 U.S. 184 (1964); *see also infra* note 122-29 and accompanying text. The implied waiver theory of *Parden* was overruled by *Welch* since it is "inconsistent with the requirement that an abrogation of Eleventh Amendment immunity by Congress must be expressed in unmistakably clear language." Welch v. Texas Department of Highways and Public Transportation, 107 S. Ct. 2941, 2948 (1987). *Welch* did not completely overrule *Parden* since it left open the question of whether Congress has the power to abrogate a state's eleventh amendment immunity under its article I powers. *Id.* at 2948 n.8. Since the Copyright Clause is an article I power, Congress is able to abrogate a state's immunity under the Copyright Act of 1976.

121 *Compare* Quern v. Jordan, 440 U.S. 332 (1979) (42 U.S.C. § 1983 does not override a state's eleventh amendment immunity) *with* Fitzpatrick v. Bitzer, 427 U.S. 445 (1976) (Title VII of the Civil Rights Act of 1964 overrides a state's eleventh amendment immunity since Congress has the power to provide for suits against states in violation of the fourteenth amendment). *See* Note, *Congressional Abrogation of State Sovereign Immunity*, 86 COLUM. L. REV. 1436 (1986).

122 377 U.S. 184 (1964).

123 *Id.* at 192.

124 *Id.*

125 U.S. CONST. art. I, § 8, cl. 3.

126 *Parden*, 377 U.S. at 185-86.

127 *Id.* at 192.

128 *Id.* at 196 (citing Petty v. Tennesee-Missouri Bridge Comm'n, 359 U.S. 275 (1959)).

129 *Id.* at 194-95; *see* Ford Motor Co. v. Dep't of Treasury 323 U.S. 459 (1945); Palmer v. Ohio, 248 U.S. 32 (1918); Chandler v. Dix, 194 U.S. 590 (1904).

130 *See supra* text accompanying notes 122-25.

131 U.S. CONST. art. I, § 8, cl. 8.

132 In 1790, the First Congress exercised its constitutional power and enacted the first copyright act. Copyright Act of 1790, Ch. 15, 1 Stat. 124-26 (current version at 17 U.S.C. §§ 101-914 (1982 & Supp. IV 1986)). The last revision of the Copyright Act was in 1976 and it protects any creative work that is an expression of an idea but not the idea itself. *See* 17 U.S.C. § 102 (1982); United Artists Corp. v. Ford Motor Co., 483 F. Supp. 89 (S.D.N.Y. 1980). A copyright does not protect ideas, factual information, or works used for education or governmental material. The purpose of the Copyright Act is to "grant valuable, enforceable rights to authors, publishers, etc., without burdensome requirements; [and] 'to afford greater encouragement to the production of literary [or artistic] works of lasting benefit to the world.'" Mazer v. Stein, 347 U.S. 201, 219 (1954) (quoting Washingtonian Pub. Co. v. Pearson, 306 U.S. 30, 36 (1938)).

133 17 U.S.C. § 501(a) (1982).

134 *See infra* notes 170-203 and accompanying text.

one."[135] Congressional regulation instituting an exclusive federal jurisdiction for copyrights[136] and the preemption of state laws[137] demonstrates that a cause of action for copyright infringement should be brought in federal court. The third premise was state participation in the area of the congressional regulation. The states have been aware of the large amount of congressional regulation of copyrights and patents since the first Copyright act in 1790.[138] A state participates in the Copyright Act differently than, for example, the state in *Parden* participated in interstate commerce. Although, the states have their own copyright laws, these laws are inferior to federal copyright laws. Thus, when a state violates the federal copyright act, it should expect to be sued in federal court and has thereby consented to suit.

The majority in *Edelman v. Jordan* did not accept the implied waiver theory and prevented plaintiffs from relying on *Parden* and *Employees* because it thought the factual requirement of "congressional authorization to sue a class of defendants which literally includes States" was missing.[139] The Court further explained that "[c]onstructive consent is not a doctrine commonly associated with the surrender of constitutional rights, and we see no place for it here."[140] The majority created its own standard stating: "we will find waiver only where stated 'by the most express language or by such overwhelming implications from the text as [will] leave no room for any other reasonable construction.' "[141]

The Copyright Act does not meet the explicit language test of *Edelman*[142] since there is no clear language in the Copyright Act waiving a state's immunity to suit. The *Parden* theory of implied waiver has been overruled. If the states expressly waived their immunity, there would be no jurisdictional problem. If the states successfully argue for the eleventh amendment and sovereign

135 *See infra* notes 204-46 and accompanying text.
136 28 U.S.C. § 1338(a) (1982). *See supra* note 17.
137 Supremacy Clause, U.S. CONST. art. VI, cl. 2. *See infra* note 194 and accompanying text.
138 *See supra* note 13.
139 Edelman v. Jordan, 415 U.S. 651, 672 (1974).
140 *Id.* at 673.
141 *Id.* (quoting Murray v. Wilson Distilling Co., 213 U.S. 151 (1909)).
142 In *Edelman*, the Court held that Illinois did not consent to suit by participating in a matching funds program under the Social Security Act. In *Employees*, the Court found that Missouri was immune from suit and did not consent to suit by engaging in the operation of hospitals and schools under the Fair Labor Standards Act of 1938. One possible distinction between *Parden*, *Edelman* and *Employees* is that in *Parden*, Congress was acting pursuant to an explicit power granted in article I, the interstate commerce clause. U.S. CONST. art.I, § 8, cl. 3. Congress was acting on its implied commerce power when it enacted the Social Security Act and the Fair Labor Standards Act. The states did not act directly within the stream of commerce under these acts.

immunity, the best theory to defeat their position would be abrogation.

C. *Abrogation*

The abrogation exception to the eleventh amendment was first applied in situations where states were found to have violated the fourteenth amendment.[143] Congress was permitted to abrogate or abolish state immunity pursuant to its power under section five of the fourteenth amendment.[144] The Supreme Court has recently extended the abrogation exception by recognizing that Congress' power to abrogate a state's immunity is not limited to section five of the fourteenth amendment.[145] Congress can conceivably abrogate a state's immunity in any federal statute that it has the power to create, including the Copyright Act.

In *Employees of the Department of Public Health and Welfare v. Department of Public Health and Welfare*,[146] the majority refused to extend the implied waiver theory on the grounds that the state was fully engaged in the operation of hospitals and schools prior to Congress' 1966 amendment,[147] which subjected states to suit under the FLSA.[148] Congress had amended section 3(d) to include states within the definition of "employer," but did not state this in section 16(b)[149] under which the suit was brought. Since abrogation is an action by Congress, the Court analyzed this case under an abrogation theory rather than a waiver theory. The majority concluded that Congress had not clearly intended to deprive the state's immunity since it would have done so in section 16(b) of the FLSA.[150] This reasoning is far-fetched since Congress commonly and explicitly defines the terms of the statute in one section which are applicable to the entire statute. It would be overly burdensome for Congress to define all the terms within each section.

143 U.S. CONST. amend. XIV. *See infra* notes 151-63 and accompanying text.
144 "The Congress shall have power to enforce, by appropriate legislation, the provisions of this article." U.S. CONST. amend. XIV, § 5. *See* Pagan, *Eleventh Amendment Analysis*, 39 ARK. L. REV. 447, 488 (1986).
145 Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941, 2946 (1987).
146 411 U.S. 279 (1973).
147 In 1966, Congress amended section 3(d) of the FLSA to include states in the term "employer." *Employees*, 411 U.S. at 282.
148 29 U.S.C. § 203(d) (1982).
149 "Any employer who violates the provisions . . . of this Act shall be liable to the employee or employees affected in the amount of their unpaid minimum wages." 29 U.S.C. § 216(b) (1982).
150 *Employees*, 411 U.S. at 285.

Fitzpatrick v. Bitzer[151] is the fundamental abrogation case. In *Fitzpatrick*, retired male state employees sued the state's retirement commission for discriminating against them on the basis of sex in their retirement benefit plans. This suit was brought under the Civil Rights Act of 1964[152] which Congress enacted pursuant to its authority under section five of the fourteenth amendment. Section 701(a) of the Civil Rights Act defines "person" to include "governments, governmental agencies,[and] political subdivisions."[153] The unanimous Court stated that "the Eleventh Amendment, and the principle of state sovereignty which it embodies . . . are necessarily limited by the enforcement provisions of § 5 of the Fourteenth Amendment."[154] The Court did not require that Congress clearly express its intent to abrogate the state's immunity in the specific section of the statute as it had in *Employees*. The Court distinguished *Employees* by stating that it applied a waiver analysis.[155]

Fitzpatrick followed the reasoning in *Ex Parte* Young with regard to damages awarded to private individuals from the state treasury: in some situations it is "necessary to permit the federal courts to vindicate federal rights and hold state officials responsible to 'the supreme authority of the United States.' "[156] The court in *Edelman* reasoned that "[s]uch an ancillary effect on the state treasury is a permissible and often an inevitable consequence of the principle announced in *Ex Parte Young*."[157]

In *Atascadero State Hosp. v. Scanlon*,[158] the majority placed a requirement on the abrogation rule stated in *Fitzpatrick*: "Congress may abrogate the States' constitutionally secured immunity from suit in federal court only by making its intention unmistakably clear in the language of the statute."[159] The majority prohibited the employment discrimination suit against the state claiming that Congress had not expressed its intent in unmistakenly clear language. Plaintiff sued under the Rehabilitation Act which prohibited employment discrimination of handicapped individuals. This act was created pursuant to Congress' section five power under the fourteenth amendment.[160] Section 504 of the Rehabilitation Act provides remedies against "any recipient of Federal assistance."[161] In *Atascadero*, all parties, including the court, agreed that California was a recipient under the Act.[162] However, this language, "any recipient," was not clear enough for the court to find that the Rehabilitation Act applied to states. The general definition provision in *Fitzpatrick*, which included states within the meaning of the term "person," was clear enough. However, the fact that a state was included in the term "any recipient" was insufficient evidence of congressional intent for the *Atascadero* court. The court gave a feeble explanation:

> [b]ut given their constitutional role, the States are not like any other class of recipients of federal aid. A general authorization for suit in federal court is not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment. When Congress chooses to subject the States to federal jurisdiction, it must do so specifically.[163]

In *Green v. Mansour*,[164] the Court began to stray from its requirement that Congress' authority for abrogation emanated from section five of the fourteenth amendment. In *Green*, the Court stated that "[s]tates may not be sued in federal court unless they consent to it in unequivocal terms or unless Congress, *pursuant to a valid exercise of power*, unequivocally expresses its intent to abrogate the immunity."[165] In *Welch v. Texas Department of Highways and Public Transportation*, the Court definitively stated "that the authority of Congress to subject unconsenting States to suit in federal court is not confined to § 5 of the Fourteenth Amendment."[166] The Jones Act[167] enables "any seaman" to bring a suit against his employer.

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151 427 U.S. 445 (1976) (a 9-0 decision).

152 Civil Rights Act of 1964, 42 U.S.C. § 1983 (1982).

153 42 U.S.C. § 2000e(a); *Fitzpatrick*, 427 U.S. at 449 n.2.

154 *Fitzpatrick*, 427 U.S. at 456.

155 *Id.* at 451-52.

156 Pennhurst State School & Hosp. v. Halderman, 465 U.S. 89, 105 (1984) (quoting *Ex Parte* Young, 209 U.S. 123, 160 (1908)).

157 *Edelman*, 415 U.S. at 668. The Court seems to be applying the eleventh amendment solely to protect state treasuries. However, in a more recent case, the Court indicated other reasons for state sovereignty under the eleventh amendment. "We acknowledge that 'the authority to make . . . fundamental . . . decisions' is perhaps the quintessential attribute of sovereignty. . . . Indeed, having the power to make decisions and to set policy is what gives the State its sovereign nature." Federal Energy Regulatory Comm'n v. Mississippi, 456 U.S. 742, 761 (1982) (citations omitted). *But see* C. Jacobs, *supra* note 35, at 150-53 (the courts' defenses of sovereign immunity, such as necessity for adminstrative discretion and the concept of kinship, are not persuasive).

158 473 U.S. 234 (1985). For a discussion of *Atascadero*, see *supra* notes 96-98 and accompanying text.

159 *Atascadero*, 473 U.S. at 242.

160 *Id.* at 238.

161 Rehabilitation Act of 1973, § 504, 29 U.S.C. § 794(a)(2) (1982).

162 *Atascadero*, 473 U.S. at 245-46.

163 *Id.* at 246.

164 474 U.S. 64 (1985).

165 *Id.* at 68 (emphasis added).

166 Welch v. Texas Dep't of Highways and Pub. Transp., 107 S. Ct. 2941, 2946 (1987).

167 46 U.S.C. § 688 (1982).

Since the Jones Act does not specifically include states in the definition of the word "employer," the Court believed there was a difference between states and other "employers" of seamen. The majority did not think the Act's language was the type of unequivocal statutory language sufficient to abrogate the eleventh amendment.[168] Thus, due to Congress' choice of words, Welch could not sue his employer for injuries that he incurred on the job. However, seamen who are employed by someone other than a state can recover under the Act. This is highly discriminatory.

The abrogation theory can be applied to other statutes created by Congress, specifically the Copyright Act. However, since "anyone" in section 501(a) is not defined to include the states, copyright owners may have a problem applying this theory under the current Supreme Court standard. The lower federal courts have suggested other standards specifically tailored to copyright suits.

IV. "The Better View"[169]—Arguments Against State Immunity

Several lower federal court cases support the argument that states should not be immune to actions brought against them for copyright or patent infringement.[170] The courts in these cases recognize that a copyright claim is unique from other federal statutory claims. However, these courts were guided by the implied waiver theory of *Parden*[171] since abrogation was not an alternative at the time.[172]

In *Lemelson v. Ampex Corporation*,[173] Jerome Lemelson brought suit against both Ampex, a California corporation, and the Illnois Bureau of Investigations ("IBI") for patent infringement.[174] Lemelson had a patent on a magnetic recording system which Ampex used in its video system.[175] IBI bought and used the Ampex video system.[176] The Northern District of Illinois held that Illinois had implicitly waived its eleventh amendment immunity[177] stating that by "granting to Congress the right to create exclusive patents, the states largely surrendered their sovereignty over patents."[178] The court compared its treatment of a claim under the patent clause to the treatment of the claims alleged under the interstate commerce clause in *Parden*.[179] Congress authorized suits against a state in the Patent Act.[180] IBI entered into an indemnity agreement with Ampex, which the court reasoned was "an indication of IBI's belief as to the applicability of the patent laws."[181] The arguments in *Lemelson* suggest that since Congress has established a national legal system[182] for regulating patents for the purpose of protecting the rights of the inventors and promoting the development of technology, the states should not violate the purpose of the patent system through sovereign immunity. In the case of patents, the right of protecting inventors and promoting the development of technology should greatly outweigh the right of the states to immunity under the eleventh amendment. This argument would equally apply to copyright infringement.

Ampex and IBI petitioned the *Lemelson* court to reconsider its decision in light of the Supreme Court's decision *Employees*.[183] The court denied the petitions to reconsider. Although the Supreme Court's holding in *Employees* barred a suit against a state in violation of a federal law pursuant to the doctrine of sovereign immunity, the *Lemelson* court maintained its position that the patent situation was unique:

> It remains this Court's view that the exclusive nature of the grant of a patent and its exclusive control by the federal government requires that a licensee state's immunity be, in effect, waived. . . .
>
> . . . Patents, both constitutionally and by statute, are exclusively in the federal domain. . . . There are no other reme-

168 *Welch*, 107 S. Ct. at 2947.

169 Professor Nimmer expressed his opinion that the Court's approach in Mills Music, Inc. v. Arizona, 591 F.2d 1278 (9th Cir. 1979) was a better view than the approach used in Wihtol v. Crow, 309 F.2d 777 (8th Cir. 1962). 3 Nimmer, *supra* note 25, § 12.01[E][2][b], at 12-21.

170 *Mills Music*, 591 F.2d 1278; Johnson v. University of Virginia, 606 F. Supp. 321 (D. Va. 1985); Lemelson v. Ampex Corp., 372 F. Supp. 708 (N.D. Ill. 1974). Since patent interests are protected under the same clause as copyright, the same arguments can be applied. U.S. Const. art. I, § 8, cl. 8.

171 377 U.S. 184, 196 (1964).

172 *Mills Music*, 591 F.2d at 1283; *Johnson*, 606 F. Supp. at 323; *Lemelson*, 372 F. Supp. at 711.

173 372 F. Supp. 708 (N.D. Ill. 1974).

174 *Id.* at 710.

175 *Id.*

176 *Id.*

177 State officials or agencies acting in their official capacity enjoy state sovereign immunity under the eleventh amendment. *Ex Parte* Young, 209 U.S. 123 (1908). *See* 3 Nimmer, *supra* note 25, § 12.01[E][2][b], at 12-20, 12-21.

178 *Lemelson*, 372 F. Supp. at 711. This position was taken by Attorney General Randolph in *Chisholm*. *See supra* note 52.

179 377 U.S. 184 (1964).

180 Patent Act, 35 U.S.C. § 271(a) (1982).

181 *Lemelson*, 372 F. Supp. at 712.

182 Besides 35 U.S.C. § 1 (1982), Congress has given the federal courts exclusive jurisdiction over copyright and patent cases pursuant to 28 U.S.C. § 1338(a) (1982).

183 *Lemelson*, 372 F. Supp. at 714.

dies available for patent infringement.[184]

In *Mills Music, Inc. v. Arizona*[185], Mills brought a suit against the State of Arizona and the Coliseum Board, a state agency, alleging violations of his copyrighted musical composition, "Happiness Is".[186] The Coliseum Board used the song as the theme for the 1971 Arizona State Fair.[187] *Mills Music*, relying on the *Edelman* test of whether states fit into the class of defendants, found that both Arizona and the Coliseum Board had waived their eleventh amendment immunity.[188] The Ninth Circuit upheld this claim stating that, "the *Parden-Employees-Edelman* trilogy establishes that the Eleventh Amendment immunity is waived when Congress has authorized suit against a class of defendants that includes states, and the state enters into the activity regulated by federal law."[189] To decide whether Congress had authorized suit against states, the court focused on the Copyright Act of 1909,[190] which stated that "[i]f *any person* shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable".[191] The court reasoned "that the reasonable construction of ["any person"] includes states within the defined class."[192] The court concluded that "[t]he language of the statute is sweeping and without apparent limitation, suggesting that Congress intended to include states within the class of defendants."[193]

The *Mills Music* court also reasoned that Congress could, pursuant to its power under article I of the Constitution, subject states to the Copyright Act.[194] "[T]he Copyright and Patent Clause is a specific grant of constitutional power that contains inherent limitations

184 *Id.* at 715.
185 591 F.2d 1278 (9th Cir. 1979).
186 *Id.* at 1280.
187 *Id.*
188 *Id.* at 1285 (the *Mills Music* Court partially used the implied waiver theory of *Parden* in applying the *Edelman* test of class of defendants).
189 *Id.* at 1283.
190 Copyright Act of 1909, ch. 320, 35 Stat. 1075 (codified as amended at 17 U.S.C. §§ 101-914 (1982 & Supp. IV 1986)).
191 *Mills Music*, 591 F.2d at 1284.
192 "The term 'any person' is common in other federal statutes and has occasionally been analyzed to determine whether states are to be included within it." *Id.* at 1284 n.7.
193 *Id.* at 1285 (construing Edelman v. Jordan, 415 U.S. 651, 672 (1974)).
194 U.S. CONST. art. I, section 8, cl. 8.

The Supremacy Clause of the Constitution states that the federal constitution and laws are supreme over state laws and state action. U.S. CONST. art. VI, cl. 2. Pursuant to its power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries," U.S. CONST. art. I, § 8, cl. 8, Congress "has fixed the conditions upon which patents and copyrights shall be granted. These laws, like other laws of the United States enacted pursuant to constitutional authority, are the supreme law of the land." Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 229 (1964) (citations omitted). The states cannot impair the Copyright Act under the supremacy clause either through its laws or actions. *See* Workman v. New York City, 179 U.S. 552, 558 (1900).

The Copyright Act grants an exclusive right of ownership which cannot be taken away by the states simply by virtue of their sovereign immunity. The Supreme Court has stated that "the States cannot exercise a sovereign power which, under the Constitution, they have relinquished to the Federal Government for its exclusive exercise." Goldstein v. California, 412 U.S. 546, 552 (1973). In Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974), the Supreme Court stressed the preemptive effect of the supremacy clause in copyright cases: "[t]he only limitation on the States is that in . . . the area of patents and copyrights they do not conflict with the operation of the laws in this area passed by Congress . . . ." *Id.* at 479. The Supreme Court in Goldstein v. California noted that "[w]hen Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach." *Goldstein*, 412 U.S. at 560.

States that violate the Copyright Act by infringing on an author's copyrighted work are not above the Act, since the federal act and not state actions is supreme.

195 *Mills Music*, 591 F.2d at 1285 (construing Goldstein v. California, 412 U.S. 546 (1973)).
196 *Id.* at 1285.
197 *Id.* at 1286.
198 606 F. Supp. 321 (D. Va. 1985).
199 *See supra* note 13 and accompanying text; *see also* 3 NIMMER, *supra* note 25, § 12.01[E][2][b], at 12-22 to 22.1 and n.104.
200 606 F. Supp. at 322.
201 *Id.* at 322-24.
202 *Id.* at 323 n.2.

on state sovereignty."[195] The *Mills Music* court noted that the Copyright Act is a detailed and complex system of protecting copyrights to which even the United States government is not immune. In response to the state treasury argument, the court stated that "the fiscal burden on state finances will be minimal, if only because states will infrequently engage in the ownership or infringement of a copyright."[196] Since the state voluntarily engaged in a commercial activity knowing of the exclusive federal regulation, the court did not believe that the damage award of $75,000 would "interfere with the state's budgeting process."[197]

In *Johnson v. University of Virginia*,[198] the reasoning of *Mills Music* was applied in conjunction with the revised Copyright Act of 1976.[199] Johnson alleged that the University of Virginia had infringed on his copyrighted photographs taken at a sporting event.[200] The Virginia district court acknowledged the split of authority on this issue but applied the arguments in *Mills Music*.[201] The *Johnson* court agreed that the words "anyone" in the infringement section of the Copyright Act of 1976 was just as sweeping and broad as "any person" in the 1909 Act. The court also agreed with the *Mills Music* court regarding the state treasury concern: "Given the paucity of case law concerning the issue of the states' liability for copyright infringement, the *Mills Music* court's prediction seems to have been quite accurate to date."[202] The *Johnson* court found that the *Mills Music* decision was well reasoned and applied a thorough analysis of

the eleventh amendment.[203]

Although the cases discussed above relied on the implied waiver theory of *Parden*, their arguments could similarly be applied to an abrogation theory. The difference in the cases above that held that the states could not use the eleventh amendment to avoid liability for copyright or patent infringement from the cases below is the recognition that the copyright system is different from the federal statutes in *Employees* and *Edelman.*

V. Arguments for State Immunity

While several cases have held that the eleventh amendment should not bar copyright infringement suits against a state, other cases have upheld the proposition that the states are immune from copyright and patent suits.[204] The courts in these cases simply applied the standards set by the Supreme Court for other federal statutes.[205]

In *Wihtol v. Crow*,[206] Crow, a school choir director, allegedly infringed on Wihtol's copyrighted musical composition entitled "My God and I."[207] Crow copied the song and changed it to fit the composition of the choir.[208] The Eighth Circuit held that since the teacher was acting in his official capacity[209] and the school district was an instrumentality of the State of Iowa,[210] Crow was immune from suit in federal court protected by the state's immunity under the eleventh amendment.[211] The court supported its decision with language from *Ex Parte New York* that stated, "a state could not be sued without its consent."[212] The

[203] *Id.* at 323. Professor Nimmer also agreed with the holding in Johnson v. University of Virginia. Nimmer, *supra* note 25, § 12.01[E][2][b], at 12-22.1 and n.104. *But see* Wihtol v. Crow, 309 F.2d 777 (8th Cir. 1962) (predicated on conclusory logic). For a full discussion of *Wihtol* see *infra* notes 206-14 and accompanying text.

[204] *Wihtol*, 309 F.2d 777; Richard Anderson Photography v. Radford Univ., 633 F. Supp. 1154 (W.D. Va. 1986); Woelffer v. Happy States of Am., Inc., 626 F. Supp. 499 (N.D. Ill. 1985); Mihalek Corp. v. Michigan, 595 F. Supp. 903 (E.D. Mich. 1984), *aff'd* 814 F.2d 290 (6th Cir. 1987).

[205] *Wihtol*, 309 F.2d at 781; *Richard Anderson*, 633 F. Supp. at 1159; *Woelffer*, 626 F. Supp. at 501; *Mihalek*, 595 F. Supp. at 905-06.

[206] 309 F.2d 777 (8th Cir. 1962).

[207] *Id.* at 778.

[208] *Id.* at 778-79.

[209] *Ex Parte* Young, 209 U.S. 123, 159-60 (1908) (discussing that the eleventh amendment is a bar to suit against a state official acting in his official capacity but not if he is acting as an individual).

[210] *Wihtol*, 309 F.2d at 782.

[211] Crow also used the songs in his capacity as choir director of his church. The court held that the church could be sued for Crow's copyright infringement. Therefore, the court found a way in which to compensate Wihtol. *Id.* at 782-83.

[212] *Wihtol*, 309 F.2d at 781 (construing *Ex Parte* State of New York, 256 U.S. 490, 497-500 (1921)).

Wihtol court also reasoned that the state could not be sued since the damages would be payable out of public funds.[213] Since this case was decided prior to *Parden* the only exception to the absolute immunity rule was *Ex Parte Young* which was limited to a narrow interpretation. The court did not discuss the nature of the copyright clause or the Copyright Act in connection with the state's immunity.[214]

In *Mihalek v. Michigan*,[215] Mihalek held a copyright to a collection of materials called the "Michigan is Good News" campaign.[216] He created these materials under agreement with the agents of the State of Michigan.[217] Mihalek alleged that Michigan used his designs in its "Say Yes to Michigan" and "Yes M!ch!gan" campaigns to promote investment and travel in the state.[218] The Michigan district court stated that *Mills* was decided incorrectly.[219] Relying upon the decision in *Edelman*,[220] the court reasoned that the copyright infringement claim was similar to *Edelman* and that therefore the result should be the same.[221]

> Although the federal interest in patent and copyright law is expressly declared in the body of the constitution itself, it is the Copyright Act which establishes the substantive legal right to be free from infringement which is the basis for the relief sought in this case by plaintiff. As such, the right to be free from infringement . . . is deserving of no more protection than is the right to benefits for the aged, blind, and disabled, which rights were also expressly established by act of Congress.[222]

[213] *Id.* at 782.

[214] The court did discuss the copyright issue in deciding whether Wihtol had a valid infringement claim. *Id.* at 779-81.

Professor Nimmer also criticized the *Wihtol* decision but on the grounds that state eleventh amendment immunity should not be extended to state agents and agencies. "It would appear, then, that the court in the *Wihtol* case in denying at the very least injunctive relief, if not damages, against the defendant school district, enlarged the scope of the Eleventh Amendment immunity." 3 Nimmer *supra* note 25, § 12.01[E][2][b], at 12-22.

[215] 595 F. Supp. 903 (E.D. Mich. 1984).

[216] *Id.* at 904.

[217] *Id.*

[218] *Id.* For a discussion of state's use of copyrighted material for commercial purposes, see *supra* note 9 and accompanying text.

[219] *Id.* at 905.

[220] 415 U.S. 651 (1974) (Court denied retroactive relief to beneficiaries of AABD since state was immune under eleventh amendment).

[221] 595 F. Supp. at 906.

[222] *Id.* at 906. The *Mihalek* court is correct in saying that the right to be free from copyright infringement is not more important than the right to benefits for the aged, blind, and disabled. However, the court fails to recognize that copyright claims are unique since there is no other remedy but to bring an action under the Copyright Act in federal court.

On appeal, the Sixth Circuit affirmed the district court's decision to dismiss the action, but on the grounds that there was insufficient evidence to support the existence of copyright infringement.[223] The Sixth Circuit did not believe it was necessary to address the issue of whether state immunity applied to copyright infringement claims.[224]

In *Woelffer v. Happy States of America*,[225] the Illinois Department of Commerce and Community Affairs ("DCCA") and its director, Woelffer, sought a declaratory judgment against Happy States to obtain a ruling on whether the state of Illinois could use its slogan, "Illinois, you put me in a happy state," in its tourism campaign.[226] The Illinois district court ruled that DCCA and Woelffer had partly waived their immunity by bringing the action into that court.[227] However, the state plaintiffs had not waived their immunity as to Happy States' counterclaim for copyright infringement.[228]

The *Woelffer* court then discussed abrogation of eleventh amendment immunity under *Atascadero*. In *Atascadero*, the Rehabilitation Act's reference to "*any* recipient of federal assistance" was not construed to include states.[229] The *Woelffer* court rejected Happy States' argument that the copyright clause was supreme to the eleventh amendment. The court relied on the Supreme Court's statement in *Atascadero* that stated, "were we to view this statute as an enactment pursuant to the Spending Clause, Art. I, § 8 . . . we would hold that there was no indication that the State of California consented to federal jurisdiction."[230] However, the *Woelffer* court misinterpreted this statement. The Supreme Court stated that even though the Rehabilitation Act was enacted pursuant to Congress' power under section five of the fourteenth amendment, they would have come to the same result by relying on the abrogation theory if the Act was enacted pursuant to Congress' article I powers. This interpretation is consistent with later decisions of the Supreme Court where the abrogation theory was extended to any valid power of Congress and not restricted to its power under the fourteenth amendment. The *Woelffer* court dismissed *Mills Music* in view of the

223 814 F.2d 290 (6th Cir. 1987).
224 *Id.* at 297 (relying on Alma Motor Co. v. Timken-Detroit Axle Co. 329 U.S. 129 (1946)).
225 626 F. Supp. 499 (N.D. Ill. 1985).
226 *Id.* at 501.
227 *Id.* at 502.
228 *Id.* at 503. This result contradicts itself and is inconsistent. If the state has waived its immunity by bringing the case in federal court then it should not escape jurisdiction for the counterclaim.
229 *Atascadero*, 473 U.S. at 245-46 (emphasis in original).
230 *Id.* at 247.

express language rule in *Atascadero*. The *Woelffer* court did not expressly overrule its earlier decision in *Lemelson* which found that a state could be sued for patent infringement, but merely mentioned it in a footnote indicating that *Lemelson* was questionable in light of *Atascadero*.[231]

In *Richard Anderson Photography v. Radford University*,[232] the Western District of Virginia, after reviewing several eleventh amendment cases,[233] relied on *Edelman* and *Atascadero* rather than on *Parden*.[234] Anderson brought a copyright infringement suit against Radford University for using his copyrighted photographs for a publication to which Anderson had not agreed.[235] The court thought that the doctrines of express waiver and congressional abrogation did not apply to the facts of this case and decided the case on the issue of whether Virginia, through the operation of a state university, implicitly waived its eleventh amendment immunity.[236] Thus far, this court is the only one to have analyzed the differences in the copyright situation. The court agreed with the argument in *Mills Music*[237] and *Johnson*[238] that the term "anyone" in the infringement chapter of the Copyright Act of 1976 is sufficiently broad to include the states.[239] However, the court incorrectly applied the express language standard of *Atascadero* and held that Virginia had not waived its immunity.[240] The court, in rejecting the implied waiver argument, distinguished *Parden* from *Edelman* and *Atascadero* by stating that:

> [T]he operation of a railroad is somewhat less of a traditional function of a State than is the administering of Social Security funds in *Edelman* and the participation in a program for the handicapped in *Atascadero*. Thus, in *Parden*, the Court more readily implied waiver because there was less compulsion for Alabama to choose to operate a railroad than there would

231 *Woelffer*, 626 F. Supp. at 503 n.5.
232 633 F. Supp. 1154 (W.D. Va. 1986).
233 *Id.* at 1156.
234 *Id.* at 1156-60.
235 *Id.* at 1155-56. While the school in *Anderson* was a state university, not all schools are protected under the eleventh amendment. *See* Mt. Healthy City School Dist. Bd. of Educ. v. Doyle, 429 U.S. 274, 279-81 (1977) (school board more like a county or city than an arm of the state and not entitled to eleventh amendment immunity).
236 *Id.* at 1158.
237 *Id.* at 1159. *See supra* text accompanying notes 185-97.
238 *Id. See supra* text accompanying notes 198-203.
239 *See supra* notes 192, 201-02 and accompanying texts.
240 *Anderson*, 633 F. Supp. at 1159. The *Atascadero* standard was not on the books when Congress drafted Section 501 of the Copyright Act. It is possible that Congress purposely used the broad language to include everyone and everything. The plain meaning of the term "anyone" includes states.

> have been had it been dealing with a more basic and fundamental function of the State.[241]

In deciding whether a state has impliedly waived its sovereign immunity, courts need only to decide if the state acted within an area regulated by Congress. If so, the state should abide by the federal laws and expect to be enjoined or fined if it violates that law.[242] A distinction should not be made as to whether the state was acting in a traditional function.[243] The *Anderson* court stated that it would have decided *Johnson* differently if *Atascadero* had been decided prior to *Johnson*.[244] The *Anderson* court seems confused. On the one hand, it recognizes the Copyright Act "is sufficiently broad to include the states,"[245] but, on the other hand, feels confined by *Atascadero*. In footnote fourteen the court notes that "it is understandable when Nimmer states that *Mills Music* is the 'better view.' "[246]

VI. Proposal for Congressional Amendment of the Copyright Act

The eleventh amendment and the Copyright Act create a unique situation when copyright owners seek to enforce their rights against infringing states. Since infringement suits under the Copyright Act preempt state copyright laws, and the federal courts have exclusive jurisdiction over federal copyright cases,[247] copyright owners whose works are infringed by a state have no court in which to bring their claims. Congress has thus created a right without a remedy.[248]

To alleviate this "jurisdictional paradox,"[249] three solutions could be enforced. First, the Supreme Court could adopt a narrow interpretation of the eleventh amendment and apply Justice Brennan's test. Second, the Court could revive the *Parden* theory of implied waiver for copyright cases. And third, Congress could amend the Copyright Act to abrogate a state's immunity for suit in federal court in unmistakably clear language.

It can be argued, in support of the first solution, that the ancient doctrine of sovereign immunity does not lie comfortably

241 *Id.* at 1160.
242 *See supra* note 194 and accompanying text.
243 *Anderson*, 633 F. Supp. at 1154.
244 *Anderson*, 633 F. Supp. at 1160.
245 *Id.* at 1159.
246 *Id.* at 1160 n.14.
247 28 U.S.C. § 1338(a) (1982).
248 *See supra* notes 19-20 and acccompanying text; Brief for Petitioner, *supra* note 7, at 14.
249 Brief for Mills Music, *supra* note 9, at 22.

within our constitutional framework. Sovereign immunity is not essential to state power since the Constitution grants powers and rights to the states under the doctrine. The federal courts, including the Supreme Court, have not presented sufficient reasons to support the existence of sovereign immunity, yet blindly and broadly enforce it. Therefore, if the Supreme Court's broad interpretation of the eleventh amendment is supported by the underlying doctrine of state sovereign immunity, there is some reason to doubt it. The insufficient support for sovereign immunity also undermines the broad application of the eleventh amendment. The Court should therefore take a narrow view of the eleventh amendment as did the first Supreme Court in *Cohens v. Virginia*.[250] The Court should only enforce the eleventh amendment when a state is sued by citizens of other states or foreign states under state law and not federal law. As Justice Brennan stated:

> If this doctrine [of sovereign immunity] were required to enhance the liberty of our people in accordance with the Constitution's protections, I could accept it. If the doctrine were required by the structure of the federal system created by the Framers, I could accept it. Yet the current doctrine intrudes on the ideal of liberty under law by protecting the States from the consequences of their illegal conduct.[251]

Justice Brennan's test for applying the eleventh amendment would lead to equitable results in copyright cases since citizens of the infringing state, as well as citizens of other states, would be entitled to bring suit in federal court under the Copyright Act. If a citizen from another state sued a state for copyright infringement under the Copyright Act, the eleventh amendment would not bar the suit since the eleventh amendment would only apply to suits involving state law. Therefore, all copyright suits brought against a state could be brought in federal court.

The second solution applies the implied waiver theory of *Parden* to copyright cases. Whether implied waiver is applicable should not turn on a court's determination of whether a state is involved in a traditional state function. It would be too complicated and burdensome for the courts to determine if a particular state action is a traditional function of the state. The focus of determining implied waiver should rest on the examination of whether Congress has regulated that area. If Congress has regulated the area and a state par-

250 119 U.S. (6 Wheat.) 264 (1821).
251 *Atascadero*, 473 U.S. at 302 (Brennan, J., dissenting).

ticipates or violates that action, a court should find that the state has consented to suit. The copyright field is heavily regulated by Congress since Congress is better equipped to protect an author's copyright nationally and uniformly. Should the Supreme Court continue to apply the eleventh amendment broadly, supported by the hollow doctrine of sovereign immunity, then only the application of implied waiver, in its most liberal form, would allow just results.

Given the Supreme Court's refusal to adopt the first two solutions, the third solution of express congressional abrogation of state immunity could be employed. Congress could either add the term "anyone" to the general definitions section of the Copyright Act and define "anyone" to include states. Congress could, in the alternative, add a section to the Act which expressly subjects states to suit in federal court. The suggestion for the addition of a separate section abrogating state's immunity is preferable in light of the Supreme Court's strict standard for clear and unambiguous language. The added section could be similar to the section which subjects the United States government to suit under the Copyright Act.[252] The amendment might read as follows:

> Anyone may bring a copyright infringement action pursuant to section 501(a) of this Act against any State of the United States in the appropriate federal district court for the recovery of reasonable and entire compensation as damages for such infringement.

There are several reasons why at least one of the three solutions above should be adopted to allow states to be sued for copyright infringement in federal courts. The copyright clause is included as one of Congress' powers to nationally preserve the exclusive rights of authors and artists over their works. If states are permitted to infringe on copyrights of authors or artists, protected from suit by the eleventh amendment, then authors and artists do not have exclusive rights to their own work. This would both weaken Congress' power under the copyright clause and undermine the existence of the clause which was enacted to encourage and preserve the arts.

Another reason for adopting one of the solutions is that the benefits of providing an author or inventor with legal recourse in the federal judiciary greatly outweigh the costs of depriving a state of its eleventh amendment immunity for copyright or patent infringement even if the damages would be paid out of public funds. In support, Professor Nimmer stated "[o]n principle it would seem

252 28 U.S.C. § 1498 (1982). For a full text of this statute, see *supra* note 25.

that neither a state nor a state entity should be able to assert the defense of governmental immunity from tort liability in a statutory copyright or any other federal action."[253] Such suits would help preserve the exclusive rights of authors and artists and the freedom to create without fear of infringement by states. The costs of allowing these suits are threats upon state treasuries, the doctrine of sovereign immunity and notions of federalism. However, none of these costs are severe or damaging. The threat of emptying state treasuries is important but not realistic. Many states have already expressly waived their eleventh amendment rights by placing themselves in the position of being sued for copyright infringement. Sovereign immunity should not be considered a doctrine that supports the foundation of our government. It is a borrowed doctrine that when applied, is the exception rather than the rule. Federalism is so engrained in our Constitution that its existence would not be threatened by the allowance of copyright suits against states under federal law in federal court.

Therefore, if the issue of state sovereignty in copyright infringement cases should come before the Supreme Court,[254] the exclusive right of authors and inventors to their writings and inventions specifically granted in the Constitution, should prevail.

VII. Conclusion

This Note has explored the major issues of state sovereignty in copyright infringement suits. The doctrine of state sovereign immunity has been questioned and no satisfactory reason for its existence has been presented. Federalism and the preservation of state treasuries are insufficient to support state sovereign immunity.[255]

If the Supreme Court refuses to narrow the scope of the eleventh amendment,[256] then it may reasonably find an implied waiver or abrogation of a state's immunity to uphold individual rights under the Copyright Act.[257] Since the Supreme Court has not directly addressed this issue, the *Mills Music*[258] decision presents the next best argument supporting the policy that indi-

253 3 Nimmer *supra* note 25, § 12.01[E][2][a], at 12-20.
254 *See supra* note 8.
255 *See* Garcia v. San Antonio Metropolitan Transit Authority, 469 U.S. 528 (1985) (federal act should apply to employees of city-owned mass-transit system) (majority approach effectively reduced the tenth amendment to meaningless rhetoric when Congress acts pursuant to the Commerce Clause) (Powell, J., dissenting).
256 *See supra* note 1 and accompanying text.
257 *See supra* note 122-68 and accompanying text.
258 *See supra* note 185 and accompanying text.

vidual rights guaranteed by the Constitution under the Copyright Clause should outweigh the privilege of state sovereign immunity in the area of copyright and patent infringement by states.[259]

In this, the 200th anniversary of our Constitution, we realize the value of preserving the individual rights represented in the Constitution. Unqualified freedom should be given to artists and authors to create and maintain the exclusive rights to their creative works. States should not be permitted to infringe on an individual's copyright and avoid liability by hiding behind the doctrine of sovereign immunity. Sovereign immunity does not belong in our legal system if used to bar copyright actions. Not only does it compromise the effectiveness of a copyright and thereby lessen its worth, it also conflicts with enumerated federal powers.

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[259] *See supra* note 253 and accompanying text.

A NEW STRATEGY FOR CENSORSHIP: PROSECUTING PORNOGRAPHERS AS PANDERERS

I. Introduction

In 1987, the California Court of Appeals, in *People v. Freeman*,[1] affirmed the conviction of a producer of "adult" movies for encouraging prostitution. Freeman was convicted under the appellate court's 1976[2] interpretation of the state's "anti-pandering" law, which prohibits the procurement of another person for prostitution.[3] Under that interpretation, actors and actresses who receive compensation for engaging in sex during the making of a movie are deemed to be prostitutes, and the producers who hire them are therefore considered panderers.

California's anti-pandering law was enacted in 1911 to control the prostitution industry.[4] Applying the law to the creators of "adult" materials represents an attempt to extend the law to control the pornography industry by inhibiting the production of sexually oriented materials. This raises the issue of whether the law's new application involves nothing more than a valid exercise of the state's police power, which only incidentally infringes on constitutional rights, or whether this application is simply an attempt to circumvent the first amendment.

[1] 188 Cal. App. 3d 618, 233 Cal. Rptr. 510 (Ct. App. 1987).
[2] People v. Fixler, 56 Cal. App. 3d 321, 128 Cal. Rptr. 363 (Ct. App. 1976).
[3] Cal. Penal Code § 266i (West Supp. 1988) provides:
Any person who: (a) procures another person for the purpose of prostitution; or (b) by promises, threats, violence, or by any device or scheme, causes, induces, persuades or encourages another person to become a prostitute; or (c) procures for another person a place as inmate in a house of prostitution or as an inmate of any place in which prostitution is encouraged or allowed within this state; or (d) by promises, threats, violence or by any device or scheme, causes, induces, persuades or encourages an inmate of a house of prostitution, or any other place in which prostitution is encouraged or allowed, to remain therein as an inmate; or (e) by fraud or artifice, or by duress of person or goods, or by abuse of any position of confidence or authority, procures another person for the purpose of prostitution, or to enter any place in which prostitution is encouraged or allowed within this state, or to come into this state or leave this state for the purpose of prostitution; or (f) receives or gives, or agrees to receive or give, any money or thing of value for procuring, or attempting to procure, another person for the purpose of prostitution, or to come into this state or leave this state for the purpose of prostitution, is guilty of pandering, a felony, and is punishable by imprisonment in the state prison for three, four or six years, or, where the other person is under 16 years of age, is punishable by imprisonment in the state prison for three, six, or eight years.
[4] *See infra* notes 69-75 and accompanying text.