

ARTICLE

EX PARTE YOUNG: A MECHANISM FOR ENFORCING FEDERAL INTELLECTUAL PROPERTY RIGHTS AGAINST STATES

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ABSTRACT

Today, as state agencies, such as state universities, actively pursue intellectual property rights, the extent of state liability in suits for infringement is an important issue. Congress attempted to abrogate state Eleventh Amendment immunity in this context, but the Supreme Court has refused to condone such abrogation when Congress is not acting pursuant to § 5 of the Fourteenth Amendment, that is, to ensure that no State shall deprive any person of life, liberty, or property without due process of law. Because congressional abrogation of Eleventh Amendment immunity in the intellectual property context has failed, States currently cannot be sued for damages resulting from intellectual property infringement. However, officials still can be sued for injunctive relief under the limited doctrine of *Ex parte Young*, an exception to Eleventh Amendment immunity. A successful application of injunctive relief for intellectual property infringement could be just as devastating as a suit for infringement to the involved state agency.

I. INTRODUCTION

Congressional concern developed in the late 1980s that state Eleventh Amendment immunity from suit in federal court left a huge loophole in federal intellectual property laws. As a consequence, Congress passed the Copyright Remedy Clarification Act of 1990 (“CRCA”),¹ the Patent and Plant Remedy Clarification Act of 1992 (“PRCA”),² and Trademark Remedy Clarification Act of 1992 (“TRCA”).³ The purpose of the Clarification Acts was to make clear the intent of Congress to abrogate Eleventh Amendment immunity in the context of intellectual property rights. Courts have deemed these Acts invalid, despite Congress’s attempts to abrogate immunity in the context of patent, copyright and trademark law.

The 1999 Supreme Court decision in *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank* held that the PRCA was an invalid abrogation of Eleventh Amendment immunity because the PRCA could not be sustained as appropriate legislation to enforce the Due Process Clause of the Fourteenth Amendment.⁴ Furthermore, the 1999 Supreme Court decision in *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board* (the companion case to *Florida Prepaid*) held the TRCA invalid as to

¹ Copyright Remedy Clarification Act of 1990, Pub. L. No. 101-553, 104 Stat. 2749 (1990) (codified at 17 U.S.C. §§ 501(a), 511).

² Patent and Plant Remedy Clarification Act of 1992, Pub. L. No. 102-560, 106 Stat. 4230 (1992) (codified at 35 U.S.C. §§ 271(h), 296(a)).

³ Trademark Remedy Clarification Act of 1992, Pub. L. No. 102-542, 106 Stat. 3567 (1992) (codified at 15 U.S.C. §§ 1122, 1125(a)).

⁴ See *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Savings Bank*, 527 U.S. 627, 647-48 (1999).

claims for false or misleading advertising because these interests were not protectable property interests under the Fourteenth Amendment.⁵ The Court in *College Savings Bank* did not address the validity of the TRCA as it pertains to claims of trademark infringement against States. Finally, the Fifth Circuit decision in *Chavez v. Arte Publico Press* held that the CRCA, like the PRCA, was also an improper exercise of congressional legislative power.⁶

In response to the *College Savings Bank* and *Florida Prepaid* decisions, Senator Leahy has introduced a bill, for the fourth time, in both the Senate and the House entitled the Intellectual Property Protection Restoration Act of 2003 (“IPPRO”).⁷ The bill’s basic premise is that any State wishing to own federal intellectual property must expressly waive its Eleventh Amendment immunity and consent to suit as a condition of being eligible to receive additional federal intellectual property. The IPPRO’s future is unknown at this time.

This Article addresses the scope of state sovereign immunity from suit in federal court and the *Ex parte Young* exception to such immunity. States should be warned that compliance with the federal intellectual property laws is imperative because Eleventh Amendment immunity is not absolute. Regardless of whether Senator Leahy’s waiver-bill passes, injunctive relief is still available under the doctrine of *Ex parte Young*.⁸ Thus, under this doctrine, a private party can still bring a declaratory judgment suit against a state officer to ensure that the officer complies with federal law.

II. BACKGROUND ON THE ELEVENTH AMENDMENT AND STATE SOVEREIGN IMMUNITY JURISPRUDENCE

The States retain substantial sovereign powers under the U.S. Constitution. Among these sovereign powers is Eleventh Amendment immunity from suit by private parties. The Eleventh Amendment was adopted in response to the Supreme Court’s 1793 decision in *Chisholm v. Georgia*.⁹ In *Chisholm*, a citizen of South Carolina brought suit in federal court against the State of Georgia to collect money that the State owed him on a contract.¹⁰ While the State of Georgia contested jurisdiction, arguing that sovereign immunity barred an action by a private citizen against an uncontesting State, the Court determined that federal courts did have jurisdiction over the State based upon the “letter of the Constitution” as set forth in § 2 of Article III of the

⁵ See *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999).

⁶ See *Chavez v. Arte Publico Press*, 204 F.3d 601, 607-608 (5th Cir. 2000).

⁷ Intellectual Property Protection Restoration Act of 2003 Bill Tracking Report, S.1191, 108th Cong. (2003); H.R. 2344, 108th Cong. (2003).

⁸ See *Ex parte Young*, 209 U.S. 123 (1908).

⁹ *Chisholm v. Georgia*, 2 U.S. 419 (1793).

¹⁰ See *id.* at 430.

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Constitution.¹¹

The States responded to *Chisholm* by ratifying the Eleventh Amendment in 1798, which provides 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.”¹² By its express terms, the Eleventh Amendment only bars federal court jurisdiction when suits are brought against States by non-resident citizens and citizens of foreign lands. However, judicial interpretation has broadened the scope of the Eleventh Amendment to bar suits by individuals against their own State of citizenship, notwithstanding the plain text of the Amendment notwithstanding.¹³

The Supreme Court recognizes only two circumstances in which an individual can sue a State in federal court.¹⁴ First, a State can waive its Eleventh Amendment immunity by consenting to suit in federal court.¹⁵ Second, Congress can abrogate a State’s Eleventh Amendment immunity, without a State’s consent, in the exercise of its power to enforce due process under § 5 of the Fourteenth Amendment - an amendment specifically designed to maintain a balance between federal and state governments.¹⁶ Congress, however, must make its intention to abrogate a State’s constitutionally-secured Eleventh Amendment immunity from suit in federal court unmistakably clear in the language of the statute.¹⁷ In addition to waiver and abrogation, the Supreme Court has provided an exception to Eleventh Amendment immunity: suits for injunctive relief against state officials who directly affect state policy and resources under the doctrine of *Ex parte Young*.¹⁸

¹¹ See *id.* at 467.

¹² U.S. CONST. amend. XI.

¹³ Compare *Cohens v. Virginia*, 19 U.S. 264, 305-309 (1821) (initially narrowly construing the Eleventh Amendment as only prohibiting unconsenting States from being sued in federal court where the plaintiff was a resident of another State or a foreign country) with *Hans v. Louisiana*, 134 U.S. 1, 15-21 (1890) (broadening the scope of the Eleventh Amendment to bar suit by an individual against his State of citizenship in federal court under the Contracts Clause, Article I § 10 of the U.S. Constitution).

¹⁴ See *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 670 (1999).

¹⁵ See *id.*, citing *Clark v. Barnard*, 108 U.S. 436 (1883).

¹⁶ See *id.*, citing *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976). Congress’s power to abrogate was recently limited to the provisions of § 5 of the Fourteenth Amendment (that is, to remedy a due process violation) by the Supreme Court in *Seminole Tribe of Florida v. Fla.*, 517 U.S. 44, 72-73 (1996), (holding that, despite a clear intent in a federal statute to abrogate Eleventh Amendment immunity, the Commerce Clause does not grant Congress such power.).

¹⁷ See *Atascadero State Hospital v. Scanlon*, 473 U.S. 234, 242 (1985).

¹⁸ See *Ex parte Young*, 209 U.S. 123, 159-160 (1908). For a further discussion of *Ex parte Young*, see *infra* Part V.

III. WAIVER OF STATES' ELEVENTH AMENDMENT IMMUNITY FROM SUIT IN FEDERAL COURT

States can expressly waive Eleventh Amendment immunity from suit in federal court by making a general appearance in court, by statute, or by state constitution. Senator Leahy attempted to pass an express statutory waiver to Eleventh Amendment immunity as a condition of receiving intellectual property rights in his Intellectual Property Protection Restoration Act. To date, Senator Leahy's Act has failed to pass in Congress.

A. *Waiver: States Can Waive Eleventh Amendment Immunity Expressly, i.e., by Making a General Appearance in Court, by Statute, or by State Constitution*

States can waive their Eleventh Amendment immunity by consenting to suit in federal court, that is, by making a general appearance in litigation before a federal court, by a state statute or constitutional provision, or by otherwise waiving its immunity to suit in the context of a particular federal program.¹⁹ A waiver of immunity before a State's own court is insufficient to constitute a waiver of immunity before federal courts.²⁰ Furthermore, a general waiver of Eleventh Amendment immunity in a state constitution, which provides language such as "[s]uits may be brought against the State in such manner and in such courts as shall be directed by law," is sufficient to subject the State to suit in state court, but insufficient to waive the immunity granted by the Eleventh Amendment.²¹

Until recently, a "constructive waiver" exception to Eleventh Amendment immunity, as set forth by the Supreme Court in *Parden v. Terminal Railway of Alabama State Docks Department*,²² was also a mechanism for enforcing federal rights against unconsenting States in the federal courts. In *Parden*, the Court held that the State of Alabama, by operating a state-owned railway, had constructively waived its Eleventh Amendment immunity in federal court by virtue of a general provision in the Federal Employee's Liability Act.²³ The FELA subjected to suit "every common carrier by railroad . . . engaging in commerce . . . between any of the several States."²⁴ The constructive waiver doctrine, however, is no longer applicable in the context of sovereign

¹⁹ See *Atascadero*, 473 U.S. at 238 n.1.

²⁰ See *id.* at 241.

²¹ See *id.* For a discussion of the general waiver in the state constitution in *Atascadero*, see *infra* Part IV.A.1.

²² See *Parden v. Terminal Ry. Of Ala. State Docks Dep't*, 377 U.S. 184 (1964), *overruled by* *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 680 (1999).

²³ 45 U.S.C. § 51 (1940).

²⁴ *Parden*, 377 U.S. at 185-86.

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immunity.²⁵

B. *The Intellectual Property Restoration Act of 2003*

Although constructive waivers are no longer enforceable, attempts have been made in Congress to institute an express waiver of Eleventh Amendment immunity concerning the federal intellectual property law. These attempts asked States to consent to suit in federal court as a premise for receiving additional intellectual property rights. Senator Leahy has unsuccessfully introduced a bill known as the Intellectual Property Protection Restoration Act²⁶ (“IPPRA”) three times in Congress. Most recently, in June 2003, he introduced the IPPRA a fourth time as Senate Bill S. 1191 and companion House of Representatives Bill H.R. 2344. No information is available on the status of the bill at this time.

The basis of the IPPRA is that any State wishing to own federal intellectual property must expressly waive its Eleventh Amendment immunity and consent to suit as a condition of being eligible to receive and to enforce additional federal intellectual property rights. Senator Leahy bases the constitutionality of this bill on Article I intellectual property power and Article I spending power.²⁷

Senator Leahy urges Congress to respond to the recent *Florida Prepaid* and *College Savings Bank* decisions by passing the IPPRA for two reasons: (1) the 1999 decisions left a huge loophole in federal intellectual property laws, and (2) the five-to-four decisions further exemplify the current Supreme Court’s “judicial activism.” For example, the Court has a tendency to overturn federal legislation with a frequency unprecedented by U.S. constitutional history.²⁸

Because Senator Leahy’s IPPRA has failed to pass thus far in Congress, and because congressional abrogation of Eleventh Amendment immunity is limited to instances in which Congress is acting pursuant to § 5 of the Fourteenth

²⁵ *Coll. Savings Bank*, 527 U.S. at 680 (“We think that the constructive-waiver experiment of *Parden* [*v. Terminal Railway of Alabama State Docks Department*] was ill conceived, and see no merit in attempting to salvage any remnant of it.”).

²⁶ On November 1, 1999, Senator Leahy introduced IPPRA of 1999, Senate Bill S. 1835, 106th Cong. (1999). On November 1, 2001, Senator Leahy reintroduced a new, less confrontational version of the condition-and-waiver approach in the 1999 bill, Senate Bill S. 1611, 107th Cong. (2001) and companion House of Representatives Bill H.R. 3204, 107th Cong. (2001). On March 19, 2002, Senator Leahy introduced a third version of the bill, Senate Bill S. 2031, 107th Cong. (2002) and companion House of Representatives Bill H.R. 3204, 107th Cong. (2001).

²⁷ *Coll. Savings Bank*, 527 U.S. at 704 (Breyer, J., dissenting) (“[P]erhaps Congress will be able to achieve the results it seeks . . . by embodying the necessary state ‘waivers’ in federal funding programs . . .”).

²⁸ See 149 Cong. Rec. S7478, 7479-7482 (daily ed. June 5, 2003) (statement of Sen. Leahy), LEXSEE 149 Cong. Rec. S7478.

Amendment,²⁹ the only means currently available for intellectual property owners to assert federal intellectual property rights against States is to sue state officers for injunctive relief under the doctrine of *Ex parte Young*.³⁰

IV. CONGRESSIONAL ABROGATION OF STATES' ELEVENTH AMENDMENT IMMUNITY FROM SUIT IN FEDERAL COURT

Congress has the power to abrogate state Eleventh Amendment immunity to suit in federal court only when acting pursuant to § 5 of the Fourteenth Amendment, that is, to ensure that no State shall deprive any person of life, liberty, or property without due process of law, and only if Congress makes its intent to abrogate unmistakably clear in the language of its abrogation statute. In 1988, the Supreme Court expanded congressional power to abrogate Eleventh Amendment immunity pursuant to its powers under the Commerce Clause in Article I of the Constitution in *Pennsylvania v. Union Gas Co.* Relying upon its broadened abrogation power after *Union Gas*, Congress passed three Clarification Acts to abrogate Eleventh Amendment immunity in the intellectual property infringement context (the Copyright Remedy Clarification Act of 1990, the Patent and Plant Remedy Clarification Act of 1992, and the Trademark Remedy Clarification Act of 1992). In 1996, the Supreme Court overruled its *Union Gas* decision in *Seminole Tribe of Florida v. Florida*, holding that congressional abrogation is only valid if pursuant to § 5 of the Fourteenth Amendment. This holding rendered congressional abrogation acts that relied on congressional authority under Article I, such as the intellectual property Clarification Acts, invalid.

A. *Abrogation Under §5 of the Fourteenth Amendment*

Section 1 of the Fourteenth Amendment provides that no State shall “deprive any person of life, liberty, or property without due process of law.” Section 5 provides that “the Congress shall have power to enforce, by appropriate legislation, the provisions of this article.” Thus, the Eleventh Amendment is “necessarily limited to the enforcement provisions of § 5 of the Fourteenth Amendment.” Meaning, the Eleventh Amendment is limited by Congress’s power to enforce, by appropriate legislation, the substantive

²⁹ For a detailed discussion of the jurisprudence concerning the constitutionality of congressional abrogation of Eleventh Amendment immunity from suit in federal court, see *infra* Part IV.

³⁰ *Ex parte Young*, 209 U.S. 123 (1908). See U.S. General Accounting Office, *GAO Rep. 01-811: State Immunity in Infringement Actions* 16-17 (2001), available at <http://www.goa.gov> [hereinafter GAO Report]. In fact, a recent decision from the District Court for the Southern District of New York relied on the *Young* doctrine to allow a copyright action seeking injunctive relief to proceed against two university officials. See *Salerno v. City Univ. of N.Y.*, 191 F. Supp. 2d 352, 357 (S.D.N.Y. 2001). For a detailed discussion of the doctrine of *Ex parte Young*, see *infra* Part V.

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provisions of the Fourteenth Amendment.³¹ As a result, Congress can abrogate the Eleventh Amendment without the States' consent only when acting pursuant to § 5 of the Fourteenth Amendment.³² After the Supreme Court's decision in *Atascadero State Hospital v. Scanlon*, however, Congress must be sure to make its intention to abrogate unmistakably clear in the language of the statute.³³

1. *Atascadero* Standard: Congress can abrogate Eleventh Amendment immunity from suit in federal court only by making its intention unmistakably clear in the language of the statute.

In *Atascadero*, the Supreme Court held that Congress can only abrogate the States' constitutionally-secured immunity from suit in federal court "by making its intention unmistakably clear in the language of the statute."³⁴ In its decision, the Court addressed three issues regarding Eleventh Amendment immunity: (1) whether the State of California waived its immunity to suit in federal court expressly by a provision in its state constitution; (2) whether by enacting the Rehabilitation Act, Congress abrogated the State's constitutional immunity; and (3) whether the State consented to suit in federal court by accepting funds under the Rehabilitation Act.³⁵

First, the Court held that, although a State can effectuate a waiver of its constitutional immunity by a constitutional provision, the general waiver of Eleventh Amendment immunity in Article III, § 5 of the California Constitution is insufficient to waive the immunity granted by the Eleventh Amendment.³⁶ The Court thus held that Article III, § 5 of the California Constitution, which provides "[s]uits may be brought against the State in such manner and in such courts as shall be directed by law," is only sufficient to subject the State to suit in state court.³⁷

The second holding of the *Atascadero* decision was the most notable. The Court held that Congress can only abrogate the States' constitutionally-secured immunity from suit in federal court "by making its intention unmistakably clear in the language of the statute."³⁸ The Court found that the pre- and post-enactment legislative history and the mere inferences from general statutory language in the Rehabilitation Act did not effect an unmistakably clear expression of Congress's intention to abrogate the Eleventh Amendment bar to

³¹ *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456 (1976).

³² *Id.*

³³ *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 242 (1985).

³⁴ *Id.*

³⁵ *Id.* at 240.

³⁶ *Id.* at 241; *see supra* Part III.A.

³⁷ *Atascadero*, 473 U.S. at 241.

³⁸ *Id.* at 242.

suits against States in federal court.³⁹

Finally, the Court found that the State of California did not consent to suit in federal court by accepting funds under the Rehabilitation Act.⁴⁰ Because the Rehabilitation Act did not evince an unmistakable congressional purpose to abrogate Eleventh Amendment immunity, the Court stated that the Act, likewise, did not manifest a clear intent by Congress to condition participation in the program on a State's consent to waive its constitutional immunity.⁴¹

After *Atascadero*, Congress could only abrogate a State's Eleventh Amendment immunity upon showing an unmistakable intent to abrogate in the federal statute.⁴²

B. *After Union Gas, Abrogation Under the Article I Commerce Clause*

In *Pennsylvania v. Union Gas Co.* the Supreme Court held that Congress could also abrogate a State's Eleventh Amendment immunity pursuant to its powers under the Commerce Clause in Article I, § 8, clause 3 of the Constitution, stating that the power to regulate interstate commerce would be "incomplete without the authority to render States liable in damages."⁴³

In 1996 – only eight years later – the Court overruled the *Union Gas* decision in *Seminole Tribe of Florida v. Florida*,⁴⁴ stating that "[t]he Eleventh Amendment restricts the judicial power under Article III, and Article I cannot be used to circumvent the constitutional limitations placed upon federal jurisdiction."⁴⁵ As a result, Congress does not have abrogation power under the Commerce Clause or any other Article I power, even when the Constitution grants Congress complete lawmaking authority over that area of law.⁴⁶ Thus, after *Seminole Tribe*, congressional abrogation of state Eleventh Amendment immunity is limited to the powers granted to Congress in § 5 of the Fourteenth Amendment.

³⁹ *Id.*

⁴⁰ *Id.* at 246.

⁴¹ *Id.* at 247.

⁴² *See, e.g., Dellmuth v. Muth*, 491 U.S. 223 (1989) (holding that "parties aggrieved by the Administrative process" was not sufficient language to abrogate state Eleventh Amendment immunity under Education of the Handicapped Act, 20 U.S.C. § 1400 *et seq.*); *Welch v. Texas Dep't of Highways & Pub. Transp.*, 483 U.S. 468 (1987) (holding that "any seaman" was not sufficient language to abrogate state Eleventh Amendment immunity under the Jones Act, 46 U.S.C. § 688); *Will v. Michigan Dep't of State Police*, 491 U.S. 58 (1989) (holding that "persons" was not sufficient language to abrogate state Eleventh Amendment immunity under 42 U.S.C. § 1983).

⁴³ *Pennsylvania v. Union Gas Co.*, 491 U.S. 1 (1988), *overruled by Seminole Tribe of Florida v. Florida*, 517 U.S. 44 (1996).

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

⁴⁵ *Id.* at 72-73.

⁴⁶ *Id.* at 72.

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Before the Supreme Court overruled its decision in *Union Gas*, Congress relied upon its abrogation powers under Article I to pass the intellectual property Clarification Acts⁴⁷ in response to two 1990 Federal Circuit decisions which exposed Congress's failure to make its intention to abrogate Eleventh Amendment immunity unmistakably clear in the language of the intellectual property statutes.⁴⁸

C. No Requisite Unmistakable Intent, Per Atascadero, to Abrogate Eleventh Amendment Immunity from Suit in Federal Court in the Patent Act

In both *Chew v. California*⁴⁹ and *Jacobs Wind Electric Company v. Florida Department of Transportation*,⁵⁰ the Federal Circuit found that a patentee was precluded from suing a State for patent infringement because Congress failed to make unmistakably clear its intention to abrogate state Eleventh Amendment immunity in the text of the Patent Act⁵¹ as required by the Supreme Court's holding in *Atascadero*.⁵² In *Chew*, the Court examined the pertinent language in 35 U.S.C. § 271(a), "whoever without authority makes, uses, or sells any patented invention. . . infringes the patent," and found that "whoever," even when given its broadest interpretation, could not conceivably include "States."⁵³ In *Jacobs Wind*, the Federal Circuit relied on its decision in *Chew*, finding the two cases indistinguishable, to hold that Eleventh Amendment immunity still obtained to bar suit for patent infringement against a State brought by a resident of that State.⁵⁴

The *Atascadero* standard had a similar effect in the context of copyright infringement and unfair competition law per § 43(a) of the Lanham Act.⁵⁵

⁴⁷ Copyright Remedy Clarification Act of 1990, Pub. L. No. 101-553, 104 Stat. 2749 (codified at 17 U.S.C. §§ 501(a), 511); Patent and Plant Remedy Clarification Act of 1992, Pub. L. No. 102-560, 106 Stat. 4230 (codified at 35 U.S.C. §§ 271(h), 296(a)); and Trademark Remedy Clarification Act of 1992, Pub. L. No. 102-542, 106 Stat. 3567 (codified at 15 U.S.C. §§ 1122, 1125(a)). See *infra* Part IV.D.

⁴⁸ *Chew v. California*, 893 F.2d 331 (Fed. Cir. 1990); *Jacobs Wind Elec. Co. v. Florida Dep't of Transp.*, 919 F.2d 726 (Fed. Cir. 1990).

⁴⁹ 893 F.2d 331 (Fed. Cir. 1990).

⁵⁰ 919 F.2d 726 (Fed. Cir. 1990).

⁵¹ 35 U.S.C. §§ 1-376.

⁵² *Atascadero State Hosp. V. Scanlon*, 473 U.S. 234, 242 (1985).

⁵³ *Id.* at 335 (emphasis added).

⁵⁴ *Jacob's Wind*, 919 F.2d at 728-29.

⁵⁵ See *BV Eng'g v. UCLA*, 858 F.2d 1394, 1398 (9th Cir. 1988) (holding that "anyone who violates the exclusive rights of the copyright owner" as used in Section 501(a) of the Copyright Act of 1976, does not meet the *Atascadero* standard as sufficient language to abrogate state Eleventh Amendment immunity); *Woelffer v. Happy States of Am., Inc.*, 626 F. Supp. 499, 504 (N.D. Ill. 1985) ("The general authorization for suit in federal court against 'anyone' who infringes an copyright or 'any person' who falsely designates the

These cases prompted Congress to amend the intellectual property statutes to make its intention to abrogate state Eleventh Amendment immunity unmistakably clear.

D. Clarification Acts: Congress's Attempts to Show an Unmistakable Intent in Intellectual Property Laws

In direct response to the Supreme Court's decision in *Atascadero*, Congress passed the Copyright Remedy Clarification Act of 1990 ("CRCA"),⁵⁶ the Patent and Plant Remedy Clarification Act of 1992 ("PRCA"),⁵⁷ and the Trademark Remedy Clarification Act of 1992 ("TRCA").⁵⁸ The purpose of the Clarification Acts was to make Congress's intent to abrogate state Eleventh Amendment immunity in the context of intellectual property rights unmistakably clear.⁵⁹

Congress provided several justifications for its passage of the PRCA and TRCA in 1992: (1) granting sovereign immunity to infringing States cuts against Article I, § 8, clause 8 of the U.S. Constitution, which grants Congress the power to issue patents for a limited period to promote the progress of science and the useful arts; (2) allowing States to freely infringe discourages future innovation; (3) States and their agencies, such as state universities, have an unjustified advantage in the commercial arena over private parties, such as private universities, because they are immune from patent infringement actions; (4) the federal government has already consented to patent infringement suits by statute, 28 U.S.C. §1498, leaving only States immune from liability for patent infringement; and (5) the original patent and trademark acts contain no expression of congressional intent to exclude States from the reach of the statutes.⁶⁰

In 1990, Congress relied on the Copyright Clause of Article I⁶¹ as its authority to pass the CRAC.⁶² In 1992, Congress cited the Commerce Clause,

origin of goods is not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment.").

⁵⁶ Pub. L. No. 101-553, 104 Stat. 2749 (codified at 17 U.S.C. §§ 501(a), 511).

⁵⁷ Pub. L. No. 102-560, 106 Stat. 4230 (codified at 35 U.S.C. §§ 271(h), 296(a)).

⁵⁸ Pub. L. No. 102-542, 106 Stat. 3567 (codified at 15 U.S.C. §§ 1122, 1125(a)).

⁵⁹ H. REP. NO. 101-282(I), *reprinted in* 1990 U.S.C.C.A.N. (104 Stat. 2749) 3949, 3950.

⁶⁰ S. REP. NO. 102-280 (1992), *reprinted in* 1992 U.S.C.C.A.N. (196 Stat. 4230) 3087, 3094-95.

⁶¹ Note that the Clarification Acts were passed after the Supreme Court decision in *Pennsylvania v. Union Gas Co.*, 491 U.S. 1 (1988), which expanded congressional abrogation authority to include its powers under the Article I Commerce Clause, and before the Supreme Court decision in *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996), which limited congressional abrogation authority to its powers under § 5 of the Fourteenth Amendment.

⁶² H. REP. NO. 101-282(I), *reprinted in* 1990 U.S.C.C.A.N. (104 Stat. 2749) 3949, 3955.

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the Patent Clause, and § 5 of the Fourteenth Amendment as its authority to pass the PRCA, and Congress cited the Commerce Clause and § 5 of the Fourteenth Amendment as its authority to pass the TRCA.⁶³

1. Copyright Remedy Clarification Act (“CRCA”)

The CRCA amended § 501(a) of the 1976 Copyright Act⁶⁴ by defining “anyone” to include “any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity.” The same definition was set forth for the term “any person,” as it was used in § 901(a). The CRCA further set forth the following language in new § 511(a) and 911(g)(1) to specifically address the Eleventh Amendment immunity issue:

Any State, and instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the Eleventh Amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity, for a violation of any of the exclusive rights of a copyright owner

The 1990 amendments to the 1976 Copyright Act were based on the Rehabilitation Act Amendments of 1986,⁶⁵ which the Supreme Court had cited twice as an example of Congress’s ability to abrogate the Eleventh Amendment.⁶⁶

2. Patent and Plant Variety Protection Remedy Clarification Act (“PRCA”)

In response to the Federal Circuit’s decisions in *Chew* and *Jacobs Wind*,⁶⁷ Congress passed the Patent and Plant Variety Protection Remedy Clarification Act (“PRCA”) in 1992. The PRCA amended the Patent Act⁶⁸ by adding § 271(h) to define the term “whoever,” as used in § 271(a), to include “any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity.” The PRCA further added § 296(a) to the Patent Act to specifically address the issue of sovereign immunity:

Any State, any instrumentality of a State, and any officer or employee of a

⁶³ H. REP. NO. 102-280 (1992), *reprinted in* 1992 U.S.C.C.A.N. (196 Stat. 4230) 3087, 3093-94.

⁶⁴ 17 U.S.C. §§ 101-1332.

⁶⁵ Pub. L. No. 99-506, 100 Stat. 1807 (1986).

⁶⁶ *See* *Dellmuth v. Muth*, 491 U.S. 223, 229 (1989); *Pennsylvania v. Union Gas. Co.*, 491 U.S. 1, 13 (1988), *overruled by* *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996).

⁶⁷ *See supra* Part IV.C.

⁶⁸ 35 U.S.C. §§ 1-376.

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

3. Trademark Remedy Clarification Act (“TRCA”)

Section 32(1)⁶⁹ of the Trademark Act of 1946 (Lanham Act)⁷⁰ creates a private right of action against “any person” who infringes a registered trademark; section 43(a)⁷¹ of the Lanham Act creates a private right of action against “any person” who uses false descriptions or makes false representations in commerce. The TRCA amended § 32(1)⁷² and § 45⁷³ by defining “any person” and “person” to include “any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity.” The TRCA further added § 40(b)⁷⁴ to the Lanham Act to specifically address the sovereign immunity issue:

Waiver of Sovereign Immunity by States— Any State, instrumentality of a State or any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or nongovernmental entity for any violation under this Act.

E. Union Gas Overruled: After Seminole Tribe, Congress Lacks the Authority Under Article I of the Constitution to Abrogate the States’ Eleventh Amendment Immunity.

In *Seminole Tribe of Florida v. Florida*,⁷⁵ the Supreme Court overruled its decision in *Pennsylvania v. Union Gas*,⁷⁶ holding that Congress lacked the authority under Article I of the Constitution to abrogate the States’ Eleventh Amendment immunity from suit in federal court.⁷⁷ This decision rendered congressional abrogation acts invalid, at least to the extent that these acts relied on congressional authority under Article I, such as the Commerce and Patent

⁶⁹ 15 U.S.C. § 1114(1).

⁷⁰ 15 U.S.C. §§ 1051-1129.

⁷¹ 15 U.S.C. § 1125(a).

⁷² 15 U.S.C. § 1114(1).

⁷³ 15 U.S.C. § 1127.

⁷⁴ 15 U.S.C. § 1122.

⁷⁵ *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996).

⁷⁶ *Pennsylvania v. Union Gas*, 491 U.S. 1 (1988), *overruled by Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996).

⁷⁷ *See Seminole Tribe*, 517 U.S. at 72.

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Clauses.⁷⁸

The Supreme Court's abrogation analysis in *Seminole Tribe* of Eleventh Amendment immunity asked two questions: (1) following *Atascadero*, whether Congress made its intention to abrogate the immunity unmistakably clear in the language of the statute, and (2) whether Congress acted pursuant to a valid exercise of power, that is, § 5 of the Fourteenth Amendment.⁷⁹

First, in addressing the *Atascadero* question, the Court recognized that Congress, in Indian Gaming Regulatory Act⁸⁰ § 2710(d)(7), provided an "unmistakably clear" statement of its intent to abrogate by making "numerous references to the 'State.'"⁸¹

Second, the majority noted that precedent had established the authority to abrogate under only two provisions of the Constitution: § 5 of the Fourteenth Amendment, which extends authority to Congress to enact "appropriate legislation" to enforce the prohibitions directed at the States in § 1, and the Article I Commerce Clause.⁸² By a five-to-four vote, the Court overturned its earlier decision in *Pennsylvania*, terminating Congress's power under the Article I Commerce Clause to abrogate state Eleventh Amendment immunity from suit in federal court.⁸³ The Court reasoned that expansion of the scope of the federal courts' jurisdiction under Article III by using the Article I Commerce Clause contradicted the purpose of the Eleventh Amendment, which was to limit the grant of judicial authority under Article III.⁸⁴ The Court further stated that the bounds of Article III could only be expanded by Congress operating pursuant to the Fourteenth Amendment.⁸⁵

Subsequent to this decision, the validity of the CRCA, PRCA, and TRCA was questionable, at least to the extent that these Congress relied on Article I as its authority to enact these statutes. Although the decision in *Seminole Tribe* challenged the validity of these acts, it did not alter an individual's ability to "bring suit against a state officer in order to ensure that the officer's conduct is in compliance with federal law" under the doctrine of *Ex parte Young*.⁸⁶

⁷⁸ See, e.g., Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Savings Bank, 527 U.S. 627 (1999).

⁷⁹ *Seminole Tribe*, 517 U.S. at 55. This was the Supreme Court's first holding in *Seminole Tribe*. The second holding pertains to the statutory remedy limitation on the doctrine of *Ex parte Young*. See *infra* Part V.B.3.

⁸⁰ 25 U.S.C. §§ 2701-2721.

⁸¹ *Seminole Tribe*, 517 U.S. at 56-57.

⁸² *Id.* at 59 (citing Fitzpatrick v. Bitzer, 427 U.S. 445 (1976) and *Pennsylvania v. Union Gas Co.*, 491 U.S. 1 (1989)).

⁸³ *Id.* at 66.

⁸⁴ *Id.* at 64-65.

⁸⁵ *Id.* at 65.

⁸⁶ *Id.* at 71 n.14. For a further discussion of the *Young* exception to Eleventh Amendment immunity, see *infra* Part V.

F. *The PRCA and the TRCA, with Respect to False or Misleading Advertising Claims, Held Invalid by the Supreme Court, and the CRCA Held Invalid by the Fifth Circuit.*

By a mere five-to-four majority in 1999, the Supreme Court expressly invalidated the PRCA in *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank* because, according to the Court, this Act could not be sustained under § 5 of the Fourteenth Amendment as remedial legislation.⁸⁷ Similarly, in the sister case, *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*, the Supreme Court invalidated the TRCA with respect to false or misleading advertising claims.⁸⁸ Although the Supreme Court did not reach the issue of whether the TRCA was a valid abrogation of Eleventh Amendment immunity in the trademark infringement context under the Lanham Act, the Court held that, with respect to § 43(a), false or misleading advertising by a competitor does not implicate a property interest protected by the Fourteenth Amendment.⁸⁹ Moreover, while the validity of the CRCA has not come before the Supreme Court, the Fifth Circuit, in *Chavez v. Arte Publico Press*, found that the CRCA, like the PRCA, also fails as remedial legislation under the Fourteenth Amendment.⁹⁰

1. *Florida Prepaid*: PRCA is an invalid abrogation because the Act cannot be sustained by § 5 of the Fourteenth Amendment.

In *Florida Prepaid*, the Court held that the PRCA cannot be sustained by § 5 of the Fourteenth Amendment because, following the analysis in *City of Boerne v. Flores*,⁹¹ the statute does not enforce the guarantees of the Due Process Clause.⁹²

The Court set forth the criteria to determine whether Congress's enactment

⁸⁷ *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Savings Bank*, 527 U.S. 627, 647 (1999).

⁸⁸ *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 675 (1999).

⁸⁹ *Id.*

⁹⁰ *Chavez v. Arte Publico Press*, 204 F.3d 601, 607-08 (5th Cir. 2000).

⁹¹ *City of Boerne v. Flores*, 521 U.S. 507 (1997). For a discussion of the *City of Boerne* "congruence and proportionality" test, see *infra* note 95.

⁹² *Florida Prepaid*, 527 U.S. at 630. In addition to arguing congressional abrogation of state Eleventh Amendment immunity under the PRCA, the respondent argued that the constructive waiver doctrine applied. *See id.* at 635. The Court, however, automatically foreclosed the argument that Florida Prepaid (an arm of the State of Florida) had constructively waived its sovereign immunity under *Parden v. Terminal Ry. of Alabama State Docks Department*, 377 U.S. 184 (1964), because the Court overruled the constructive waiver theory in the companion case to this case, *College Savings Bank v. Florida Prepaid*, 527 U.S. at 635. (for further discussion of the constructive waiver theory, see *infra* Part IV.F.2).

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of the PRCA validly abrogated state Eleventh Amendment immunity: (1) following *Atascadero*, whether Congress made its intention to abrogate the immunity unmistakably clear in the language of the statute; and (2) following *Seminole Tribe*, whether Congress acted pursuant to a valid exercise of power (that is, § 5 of the Fourteenth Amendment) to remedy a specific due process violation.⁹³

First, under the *Atascadero* standard, the Court found that Congress made its intention to abrogate state Eleventh Amendment immunity unmistakably clear in the language of the PRCA.⁹⁴ Second, the Court set forth three criteria to determine whether the PRCA was “appropriate legislation” pursuant to § 5 of the Fourteenth Amendment under the *City of Boerne* “congruence and proportionality” test:⁹⁵ (a) whether Congress had established a strong record of patent infringement by the States; (b) whether the abrogation was drafted in such a way as to apply only to those States that do not provide a state remedy; and (c) whether the abrogation extended only to non-negligent deprivation by the States.⁹⁶

In its analysis, the Court stated that patents have long been considered a species of property, protectable under the Due Process Clause, § 1 of the Fourteenth Amendment; thus, patent infringement could constitute an unconstitutional deprivation of property.⁹⁷ Although patents are a protectable property interest, Congress failed to establish sufficient factual findings of infringement by the States to justify abrogation.⁹⁸ First, Congress, in enacting the PRCA, identified no pattern of patent infringement by the States, thus no pattern of unconstitutional property deprivation.⁹⁹ The Court stated that even the House Report to the bill acknowledged the contrary, that “many [S]tates comply with patent law.”¹⁰⁰ Further, the Court, citing the circuit court opinion, noted that only eight patent infringement suits were prosecuted against the

⁹³ See *Florida Prepaid*, 527 U.S. at 635.

⁹⁴ See *id.*

⁹⁵ The “congruence and proportionality” test, established by the Supreme Court in *City of Boerne v. Flores*, determines whether there is “congruence and proportionality between the injury to be prevented or remedied and the means adopted to that end.” *City of Boerne*, 521 U.S. at 520 (1997). The Court in *Florida Prepaid* set forth an analytical framework that requires examination of three aspects of the abrogation legislation to determine whether congruence and proportionality exists: (1) the nature of the injury to be remedied; (2) Congress’s consideration of the adequacy of state remedies to redress the injury; and (3) the legislation’s coverage. See *Chavez v. Arte Publico Press*, 204 F.3d 601, 605 (5th Cir. 2000).

⁹⁶ *Florida Prepaid*, 527 U.S. at 640-45.

⁹⁷ *Id.* at 642.

⁹⁸ *Id.* at 645.

⁹⁹ *Id.* at 640.

¹⁰⁰ *Id.* (quoting PRCA House Report).

States in the 110-year period between 1880 and 1990.¹⁰¹

Second, the Court stated that Congress “barely considered the availability of state remedies for patent infringement and hence whether the States’ conduct might have amounted to a constitutional violation under the Fourteenth Amendment.”¹⁰² Statements made by witnesses during the PRCA House Hearings acknowledged that some uncertain state remedies (such as a deceit suit, a general unfair competition suit, or a restitution suit) might be available for patent infringement.¹⁰³ The Court noted, however, that the primary point made by most of the witnesses was not that the state remedies were constitutionally inadequate, but that they were less convenient than federal remedies and undermining of the uniformity of patent law.¹⁰⁴

Finally, the Court found that the legislative record indicated that most state infringement was not intentional, but innocent or at worst negligent.¹⁰⁵

Thus, instead of addressing a deprivation of property in violation of § 1 of the Fourteenth Amendment, “the [PRCA’s] apparent and more basic aims were to provide a uniform remedy for patent infringement and to place States on the same footing as private parties under that regime.”¹⁰⁶ While the Supreme Court acknowledged that such aims might be proper congressional concerns under Article I, the concerns were insufficient to support constitutional abrogation under § 5 of the Fourteenth Amendment.¹⁰⁷

2. *College Savings Bank*: TRCA is an invalid abrogation with respect to false or misleading advertising claims because false or misleading advertising by a competitor is not a protectable “property” interest, but TRCA could conceivably be a valid abrogation of Eleventh Amendment immunity with respect to trademark infringement claims.

In *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*,¹⁰⁸ the Court did not reach the issue of whether the TRCA was an appropriate exercise of congressional power under § 5 of the Fourteenth Amendment; the Court instead found that certain unfair competition interests, which Congress sought to protect by enacting the TRCA, were not protectable “property” interests.¹⁰⁹ The Court identified two issues in the case: (1) whether

¹⁰¹ *Id.* (citing *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 148 F.3d 1343, 1353-54 (Fed. Cir. 1998)).

¹⁰² *Florida Prepaid*, 527 U.S. at 643.

¹⁰³ *Id.* at 643 n.8.

¹⁰⁴ *Id.* at 644.

¹⁰⁵ *Id.* at 645.

¹⁰⁶ *Id.* at 647-48.

¹⁰⁷ *Id.* at 648.

¹⁰⁸ *Florida Prepaid*, 527 U.S. 666 (1999).

¹⁰⁹ *Id.* at 673.

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Florida's Eleventh Amendment immunity was validly abrogated by the TRCA, with respect to false or misleading advertising claims under § 43(a) of the Lanham Act; and (2) whether the State constructively waived its immunity from Lanham Act suits by engaging in the interstate marketing and administration of its program after the TRCA made clear that such activity would subject Florida Prepaid (an arm of the State of Florida) to suit.¹¹⁰

In addressing the first issue, the Court determined that it did not need to reach the question of whether state Eleventh Amendment immunity was validly abrogated by the TRCA (with respect to § 43(a) of the Lanham Act) under the purported authority of § 5 of the Fourteenth Amendment because, unlike the patent infringement at issue in *Florida Prepaid*, the Court found that false or misleading advertising by a competitor does not implicate a property interest protected by § 1 of the Fourteenth Amendment.¹¹¹ The petitioner claimed that Congress enacted the TRCA, specifically § 43(a) of the Lanham Act, to remedy and prevent state deprivations without due process of two species of "property" rights: (1) a right to be free from a business competitor's false or misleading advertising of its own product; and (2) a more generalized right to be secure in one's business interests.¹¹² The Court rejected both of these interests as property rights.

First, the Court stated that "the hallmark of a protected property right is the right to exclude others."¹¹³ The Court recognized that "[t]he Lanham Act may well contain provisions that protect constitutionally cognizable property interests – notably, its provisions dealing with infringement of trademarks, which are 'property' of the owner because he can exclude others from using them."¹¹⁴ However, the Court stated that the Lanham Act's false-advertising provisions "bear no relationship to any right to exclude."¹¹⁵

Second, the Court rejected the petitioner's assertion that the right to conduct a business is a property right within the intent of the Fourteenth Amendment.¹¹⁶ The Court stated that "business in the sense of *the activity of doing business*, or *the activity of making a profit* is not property in the ordinary sense – and it is only *that*, and not any business asset, which is impinged upon by a competitor's false advertising."¹¹⁷ Thus, finding no deprivation of property at issue, the Court stated that it need not pursue the follow-on *City of Boerne* question addressed in the *Florida Prepaid* decision, "whether the prophylactic measure taken under purported authority of § 5 . . . was genuinely

¹¹⁰ *Id.* at 672, 675-76.

¹¹¹ *Id.* at 675.

¹¹² *Id.* at 672.

¹¹³ *Id.* at 673.

¹¹⁴ *See Florida Prepaid*, 527 U.S. at 673.

¹¹⁵ *See id.*

¹¹⁶ *See id.* at 675.

¹¹⁷ *Id.* (emphasis in original).

necessary to prevent violation of the Fourteenth Amendment.”¹¹⁸

In addressing the second issue, whether the State constructively waived its immunity from Lanham Act suits by engaging in the interstate marketing and administration of its program after the TRCA made clear that such activity would subject the State to suit, the Court went on to overrule its earlier decision in *Parden v. Terminal Railway of Alabama State Docks Department*,¹¹⁹ which established the constructive waiver doctrine, stating that “*Parden* stands as an anomaly in the jurisprudence of sovereign immunity . . .”¹²⁰ Consequently, States can no longer constructively waive Eleventh Amendment immunity.

Thus, in addition to invalidating the constructive waiver doctrine, the Court held that the TRCA is an invalid abrogation of Eleventh Amendment immunity to the extent that the asserted claims pertain to false or misleading advertising by a competitor because these interests are not protectable property interests under the Fourteenth Amendment.¹²¹ The Court, however, did not address the validity of the TRCA with respect to trademark infringement claims.

3. *Chavez v. Arte Publico Press*: Fifth Circuit held that CRCA, like the PRCA, is an improper exercise of congressional legislative power, although this issue has not been addressed by other circuits or by the Supreme Court.

In *Chavez v. Arte Publico Press*,¹²² the Fifth Circuit followed the Supreme Court’s decision in *Florida Prepaid* and applied the same three-part congruence and proportionality test (as established in *City of Boerne*),¹²³ to hold that the CRCA, like the PRCA, was “an improper exercise of congressional legislative power” in violation of the Eleventh Amendment.¹²⁴

To start its analysis, the Fifth Circuit stated that because “patent and copyright are of similar nature, and [because] patent is a form of property protectable against the [S]tates, copyright would seem to be so too.”¹²⁵ Then,

¹¹⁸ *Id.*

¹¹⁹ *Parden v. Terminal Ry. of Ala. State Docks Dep’t*, 377 U.S. 184 (1964); *see supra* Part III.A..

¹²⁰ *See Coll. Savings Bank*, 527 U.S. at 680.

¹²¹ *See id.* at 673.

¹²² *Chavez v. Arte Publico Press*, 204 F.3d 601 (5th Cir. 2000).

¹²³ *City of Boerne v. Flores*, 521 U.S. 507, 520 (1997).

¹²⁴ *Chavez*, 204 F.3d at 607-08. *See also* *Rodriguez v. Texas Comm’n on the Arts*, 199 F.3d 279, 281 (5th Cir. 2000) (holding that it is appropriate to adopt the Supreme Court’s holding in *Florida Prepaid* in the copyright context because the “the interests Congress sought to protect in each statute are substantially the same and the language of the respective abrogation provisions are virtually identical.”).

¹²⁵ *Chavez*, 204 F.3d at 605 n.6.

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applying the congruence and proportionality analysis (as applied in *Florida Prepaid*), the Fifth Circuit found that the legislative histories of the PRCA and CRCA paralleled one another. First, the court, relying on data compiled by the Copyright Office in 1988, stated that only seven incidents of copyright infringement by States had been documented so far, establishing that copyrights, like patents, were seldom infringed by States.¹²⁶ Further, the court acknowledged that “the testimony before Congress worried principally about the ‘potential’ for future abuse,” not current abuse.¹²⁷

Second, the court found that Congress barely considered the availability of state remedies for infringement.¹²⁸

Third, the court found that the “indiscriminate scope” of the legislation would be disproportionate to the injury to be prevented because the scope of the CRCA would necessarily include negligent acts by States.¹²⁹ The court quoted the legislative record which stated that “[the States] would want [immunity] only as a shield for the State treasury from the occasional error or misunderstanding or innocent infringement.”¹³⁰ Thus, the Fifth Circuit held that States cannot be sued for copyright infringement in federal court because the CRCA, like the PRCA, is an invalid abrogation of state Eleventh Amendment immunity.¹³¹

G. District and Circuit Courts Cases Since Supreme Court Decision in Florida Prepaid and College Savings Bank

In *State Contracting & Engineering Corp. v. Florida*, the Federal Circuit – relying on *Florida Prepaid* and *College Savings Bank* – affirmed the District Court’s grant of summary judgment in favor of the State of Florida on patent infringement claims and Lanham Act claims for false representations in commerce based on state Eleventh Amendment immunity, but reversed the grant of summary judgment as to the private contractors.¹³²

¹²⁶ *Id.* at 606 (citing Register of Copyrights, *Copyright Liability of States and the Eleventh Amendment* 509 (1988)). *But see Florida Prepaid*, 527 U.S. at 658 n.9 (Stevens, J. dissenting) (“To the extent that a majority of this Court finds [the record of infringement] dispositive, there is hope that the [CRCA] may be considered ‘appropriate’ § 5 legislation. The legislative history of that Act includes many examples of copyright infringement by States, especially state universities.”).

¹²⁷ *Chavez*, 204 F.3d at 606 (citing Copyright Remedy Clarification Act and Copyright Office Report on Copyright Liability of States: Hearings Before the Subcomm. on Courts, Intellectual Property, and the Administration of Justice, 101st Cong. 53 (1989) [hereinafter CRCA House Hearings]).

¹²⁸ *Chavez*, 204 F.3d at 606.

¹²⁹ *Id.* at 607.

¹³⁰ *Id.* (quoting CRCA House Hearings, testimony of Mr. Oman, Register of Copyrights).

¹³¹ *See Chavez*, 204 F.3d at 607-08.

¹³² *State Contracting & Eng’g Corp. v. Florida*, 258 F.3d 1329, 1340 (Fed. Cir. 2001).

Moreover, in *Progressive Games, Inc. v. Shuffle Master, Inc.*, the District Court for the District of Nevada – relying on the Supreme Court’s recent decision in *Florida Prepaid* – granted the defendants’ motion to dismiss, holding that defendants, Nevada Gaming Commission and Nevada State Gaming Control Board, could not be sued in federal court for patent infringement without the State’s consent.¹³³

However, in *Syrrx, Inc. v. Oculus Pharmaceuticals, Inc.*, the District Court for the District of Delaware denied the defendant’s motion to dismiss, holding that sovereign immunity under the Eleventh Amendment does not extend immunity to private parties that infringe a valid patent by inducing a state entity to commit infringing acts.¹³⁴

Finally, in *Regents of the University of New Mexico v. Knight*, the Federal Circuit held that when a State files suit in federal court to enforce its claims to certain patents, the State shall be considered to have consented to have litigated in the same forum all compulsory counterclaims, that is, those counterclaims arising out of the same transaction or occurrence that gave rise to the State’s asserted claims.¹³⁵

H. Declaratory Judgments: No Eleventh Amendment Immunity when the Validity of a Patent Owned by the State Itself is Being Challenged

When the validity of a patent owned by a State itself is being challenged, Congress can compel a waiver of Eleventh Amendment immunity. Although the constructive waiver doctrine is no longer applicable,¹³⁶ Justice Scalia, writing for the majority in *College Savings Bank*, distinguished two instances in which Congress can compel a waiver of Eleventh Amendment immunity. In both instances, the State seeks not merely to engage in otherwise lawful activity, but rather receives a “gratuity” or “gift” that Congress could rightfully withhold.¹³⁷ First, under the Compact Clause, Article I, § 10, clause 3, States

¹³³ *Progressive Games, Inc. v. Shuffle Master, Inc.*, 69 F. Supp. 2d 1274, 1275 (D. Nev. 1999).

¹³⁴ *Syrrx, Inc. v. Oculus Pharmaceuticals, Inc.*, 2002 U.S. Dist. LEXIS 14893, *8 (D. Del. 2002).

¹³⁵ *See Regents of the Univ. of N.M. v. Knight*, 2003 U.S. App. LEXIS 3647, *37-38 (Fed. Cir. 2003).

¹³⁶ For a discussion of the constructive waiver doctrine, see *supra* Parts III.A & IV.F.2.

¹³⁷ *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. at 686-87, *citing Petty v. Tennessee-Missouri Bridge Comm’n*, 359 U.S. 275, 277 (1959) and *South Dakota v. Dole*, 483 U.S. 203, 208 (1987). In *Petty v. Tennessee-Missouri Bridge Commission*, the Supreme Court held that a state agency had waived its right to claim state immunity from lawsuits pursuant to a congressionally approved compact between Tennessee and Missouri which provided that each compacting State would have the power “to contract, to sue, and be sued in its own name.” In *South Dakota v. Dole*, the Supreme Court held that a statute, which permitted the reduction of federal highway funds otherwise

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must first obtain the express consent of Congress before entering an interstate compact; the granting of such consent is a “gratuity.”¹³⁸ Second, Congress has no obligation to use its Spending Clause power to disperse funds to the States; such funds are “gifts.”¹³⁹

Relying on these two instances of compulsion as detailed by Justice Scalia, the District Court for the Eastern District of California, in *New Star Lazars v. Regents of the University of California*, denied a motion by the defendants, the Regents (an arm of the State), to dismiss the plaintiff’s claim for declaratory relief based on patent invalidity, concluding that the defendants waived their immunity to a declaratory suit when they acquired their patent from the federal government.¹⁴⁰ The court reasoned that acquiring a patent was more than ordinary commercial activity; it constituted a gift or gratuity bestowed by the federal government.¹⁴¹ Therefore, Congress may condition its receipt on a waiver of Eleventh Amendment immunity to a declaratory suit.¹⁴²

Moreover, in *McGuire v. Regents of the University of Michigan*, the District Court for the Southern District of Ohio denied the motion by the defendants, the Regents, to dismiss the plaintiff’s claim for declaratory relief, holding that in obtaining the trademarks at issue, the State waived its Eleventh Amendment immunity.¹⁴³ Like the State in *New Star Lazars*, the State here acted as more than an ordinary participant in the marketplace, because it was conferred a gift or gratuity – in the form of a registered trademark – by the federal government.¹⁴⁴ The court reasoned that while in *College Savings Bank* a property right did not exist in the right to be free from false or misleading advertising by a competitor, here the State had been conferred a right of exclusion on its registered trademark, the word “Michigan.”¹⁴⁵ Thus, the court concluded that the State could not then avoid a suit challenging the parameters of the property right conferred.¹⁴⁶

allocable to a State if the State had a minimum drinking age below twenty-one, was a valid exercise of Congress’s spending power.

¹³⁸ *Coll. Savings Bank*, 527 U.S. at 686.

¹³⁹ *Id.* at 686-87.

¹⁴⁰ *New Star Lazars v. Regents of the Univ. of Calif.*, 63 F. Supp. 2d 1240, 1244-1245 (E.D. Cal. 1999).

¹⁴¹ *Id.* at 1244.

¹⁴² *Id.*

¹⁴³ *McGuire v. Regents of the Univ. of Mich.*, 2000 U.S. Dist. LEXIS 21615 *14 (S.D. Ohio 2000).

¹⁴⁴ *Id.* at *12-13.

¹⁴⁵ *Id.* at *13.

¹⁴⁶ *Id.* at *13-14.

V. INJUNCTIVE RELIEF: THE *EX PARTE YOUNG* EXCEPTION TO ELEVENTH AMENDMENT IMMUNITY

Even though States cannot be directly sued for monetary damages in cases of intellectual property infringement,¹⁴⁷ injunctive relief appears to remain available under the doctrine of *Ex parte Young*.¹⁴⁸ State entities (including state universities) that infringe intellectual property rights thus run the risk of being forced by court order to cease infringing activities, resulting in the potential loss of valuable research and intellectual property developments.¹⁴⁹

The *Ex parte Young* doctrine is an exception to Eleventh Amendment immunity: “a State can be sued in federal court for prospective relief by the simple expedient of naming the appropriate state officer as the defendant.”¹⁵⁰ In *Ex parte Young*, a state official challenged a federal court’s authority to enjoin him from enforcing a state law that allegedly violated the Fourteenth Amendment.¹⁵¹ The Supreme Court held that the Eleventh Amendment did not serve to bar an action in federal court seeking to enjoin an officer of the State from enforcing a law which was in violation of the Fourteenth Amendment of the U.S. Constitution.¹⁵² Such action did not constitute an action against the State.¹⁵³ Rather, because the state officer had a duty to

¹⁴⁷ See *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Savings Bank*, 527 U.S. 627, 647-48 (1999); *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999); *Chavez v. Arte Publico Press*, 204 F.3d 601, 607 (5th Cir. 2000).

¹⁴⁸ *Ex parte Young*, 209 U.S. 123, 159 (1908). Because recent cases have reaffirmed the *Ex parte Young* exception, the doctrine appears to be valid. See, e.g., *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44, 75 n.17 (1996); *Idaho v. Coeur d’Alene Tribe*, 521 U.S. 261, 269 (1997) (affirming the viability of the *Young* doctrine, but, in the plurality opinion, failing to affirm any clear rule for the application of the doctrine).

¹⁴⁹ Since the Bayh-Dole Act passed in 1980, 35 U.S.C. §§ 200-212, universities are permitted to obtain title to intellectual property developed with federal funds. As a result, state universities are more actively pursuing and enforcing intellectual property rights. This Article advises state entities, such as state universities to continue, in the spirit of the intellectual property laws, to continue to comply with these laws. Remember in *Florida Prepaid*, 527 U.S. at 640, the Court acknowledged the PRCA House Report, which stated that “many [S]tates comply with patent law.”

¹⁵⁰ PETER W. LOW & JOHN C. JEFFRIES, JR., *FED. COURTS & THE LAW OF FED.-STATE RELATIONS* 819 (4th ed. 1998 & Supp. 2001). See also *Pennhurst State Sch. & Hosp. v. Halderman*, 465 U.S. 89, 114 n.25 (1984) (noting that *Young* rests on a fictional distinction between the official and the State); *Florida Dep’t of State v. Treasure Salvors, Inc.*, 458 U.S. 670, 685 (1982) (recognizing the ironic premise that a state official’s conduct may be considered “state action” for Fourteenth Amendment purposes, yet not state action for Eleventh Amendment purposes).

¹⁵¹ *Ex Parte Young*, 209 U.S. at 143-44.

¹⁵² *Id.* at 159-61.

¹⁵³ *Id.* at 161. In *Ex parte Young*, the Minnesota Attorney General’s “power by virtue of

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enforce the laws of the State, the injunction was sought against him, as an individual.¹⁵⁴ Thus, in an *Ex parte Young* action, the plaintiff sues a state officer (or state officers),¹⁵⁵ in his or her individual capacity, to enjoin him or her from violating either federal law or the Constitution.¹⁵⁶

Although the *Young* doctrine is still a viable exception to Eleventh Amendment immunity, the Supreme Court has established important limitations to effectively narrow its application: the plaintiff must seek prospective relief to address an ongoing violation, not recompense or other retrospective relief for past violations;¹⁵⁷ the plaintiff must allege that the state officers are acting in violation of federal law;¹⁵⁸ and, finally, the plaintiff must establish that Congress has not prescribed a detailed remedial scheme that was intended to limit the availability of *Ex parte Young* suits over causes of action brought under the statute at issue.¹⁵⁹

In the intellectual property context, these three limitations will likely not bar a plaintiff from applying the *Young* exception to sue a state officer in federal court for injunctive relief. First, although a plaintiff will not be able to seek

his office sufficiently connected him with the duty of enforcement to make him a proper party” to the suit. *Id.*

¹⁵⁴ *Id.* at 159-60.

¹⁵⁵ For a discussion on who is a state officer, see *infra* Part V.A.1.

¹⁵⁶ See Steve Malin, *The Protection of Intellectual-Property Rights in a Federalist Era*, 6 COMP. L. REV. & TECH. J. 137, 164 (2002). The language in the *Ex parte Young* decision states that injunctive relief is available if,

the act which the state Attorney General seeks to enforce be a violation of the Federal Constitution, the officer in proceeding under such enactment comes into conflict with the superior authority of that Constitution, and he is in that case stripped of his official or representative character and is subjected in his person to the consequences of his individual conduct.

Ex parte Young, 209 U.S. at 159-60 (emphasis added). Subsequent courts, however, have held that *Ex parte Young* applies to violations of federal statutory law as well violations of the Constitution. See, e.g., *Sofamor Danek Group, Inc., v. Brown*, 124 F.3d 1179, 1184 (9th Cir. 1997) (“We have held that *Ex parte Young* applies to violations of federal statutory law as well as federal constitutional violations.”); *Natural Res. Def. Council v. Calif. Dep’t of Transp.*, 96 F.3d 420, 422 (9th Cir. 1996) (holding that *Ex parte Young* applies to violations of federal statutory law); *Almond Hill Sch. v. U.S. Dep’t of Agric.*, 768 F.2d 1030, 1034 (9th Cir. 1985) (“The underlying purpose of *Ex parte Young* seems to require its application to claims against state officials for violations of federal statutes.”); *Pennhurst State Sch. & Hosp. v. Halderman*, 465 U.S. 89, 105 (1984) (“[T]he *Young* doctrine has been accepted as necessary to permit the federal courts to vindicate federal rights . . .”); see also *Idaho v. Coeur d’Alene Tribe*, 521 U.S. 261, 294 (1997) (O’Connor, J., concurring) (“[A] *Young* suit is available where a plaintiff alleges an ongoing violation of federal law, and where the relief sought is prospective rather than retrospective.”) (emphasis in original).

¹⁵⁷ *Edelman v. Jordan*, 415 U.S. 651, 664 (1974); see *infra* Part V.B.1.

¹⁵⁸ *Pennhurst*, 465 U.S. at 89 (1984); see *infra* Part V.B.2.

¹⁵⁹ *Seminole Tribe of Florida v. Florida*, 517 U.S. 44, 74 (1996); see *infra* Part V.B.3.

retrospective monetary damages for past infringement, the real danger still exists in that the plaintiff is seeking prospective relief from infringement through an injunction. Second, the intellectual property laws (the copyright, patent, and trademark laws) are federal laws, not state laws. These statutes are thus within the expanse of the *Young* doctrine. Third, all of the federal intellectual property statutes – the Copyright, Patent, and Trademark Acts – contemplate suits against state officials, and even contemplate injunctive relief as a remedy within their detailed remedial schemes.¹⁶⁰

A. *The Exception as Established in Ex parte Young*

Ex parte Young began as a suit filed by railroad company stockholders in response to several acts passed by the Minnesota legislature to regulate the maximum rates that railroads could charge for the transportation of passengers and commodities.¹⁶¹ These acts set the maximum rates below the rates that the railroads had previously been charging.¹⁶² The stockholders of certain Minnesota railroad companies brought an action to enjoin the companies from adopting new rate schedules and to enjoin both the Railroad and Warehouse Commission and the Minnesota Attorney General, Edward T. Young, from enforcing the acts.¹⁶³ The stockholders claimed that the reduction in rates prescribed by the acts deprived them of property without due process of law, in violation of § 1 of the Fourteenth Amendment.¹⁶⁴ The Circuit Court issued a temporary injunction to prevent the Minnesota Attorney General from levying penalties on the railroad companies for violations of the acts.¹⁶⁵ The Minnesota Attorney General, in turn, disobeyed this injunction, claiming that the Court's issuance of the injunction violated the Eleventh Amendment.¹⁶⁶

Ex parte Young unveiled a paradox. To bring a valid suit under the Fourteenth Amendment there must be a state action; however, if the State itself is performing the state action, then the Eleventh Amendment bars suit against the defendant-State. The issue the Supreme Court faced was whether the action against the Minnesota Attorney General was actually an action against the State of Minnesota for a violation of the Fourteenth Amendment – and thus barred by the Eleventh Amendment – or whether it was an action against the State official, the Minnesota Attorney General, as an individual.¹⁶⁷

¹⁶⁰ See 1976 Copyright Act, 17 U.S.C. § 502; Patent Act, 35 U.S.C. §§ 281, 283; Trademark Act of 1946 (Lanham Act), 15 U.S.C. § 1116. For a detailed discussion of these statutes, see *infra* note 226.

¹⁶¹ See *Ex parte Young*, 209 U.S. 123 (1908).

¹⁶² See *id.*

¹⁶³ See *id.* at 129.

¹⁶⁴ See *id.* at 130.

¹⁶⁵ See *id.* at 132.

¹⁶⁶ See *id.* at 134.

¹⁶⁷ See *Ex parte Young*, 209 U.S. at 149.

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The Court in *Ex parte Young* overcame this paradox by adopting a legal “fiction” that allowed the Court to recognize an official’s unconstitutional conduct as state action for purposes of the Fourteenth Amendment,¹⁶⁸ while it simultaneously “stripped” the official’s state affiliation for purposes of the Eleventh Amendment.¹⁶⁹ Applying this legal fiction, the *Young* Court held that the suit against the Minnesota Attorney General was not a suit against the State, and, therefore, was not barred by the Eleventh Amendment.¹⁷⁰ Although the *Young* doctrine continues as a viable exception to Eleventh Amendment immunity,¹⁷¹ three limitations have effectively narrowed its application.¹⁷²

1. What is a State? Who is a State Officer?

Before addressing the three limitations to the *Young* doctrine, it is important to clarify the definitions of “State” and “state officer” within the Eleventh Amendment jurisprudence. The *Ex parte Young* doctrine only applies as an exception to the Eleventh Amendment, that is, if the entity is considered a state entity. Case law holds that the Eleventh Amendment applies to States and “arms of the State,”¹⁷³ but not to lesser entities,¹⁷⁴ such as counties, corporate

¹⁶⁸ The *Young* doctrine is often referred to as a “fiction” because the authority for a *Young* cause of action seems to exist independent of explicit congressional authorization. LOW & JEFFRIES, *supra* note 150, at 819. Under 42 U.S.C. § 1983, a cause of action is established to enforce the Constitution against an official who is acting under color of state law. *See id.* The state officer acting in alleged violation of federal law, however, is then stripped of his official character and sued as a person. *Id.*

¹⁶⁹ *See Ex Parte Young*, 209 U.S. at 160.

¹⁷⁰ *See id.*

¹⁷¹ *See supra* note 148.

¹⁷² *Edelman v. Jordan*, 415 U.S. 651, 664 (1974) (suits for prospective, not retroactive relief); *Pennhurst State Sch. & Hosp. v. Halderman*, 465 U.S. 89 (1984) (suits seeking compliance with federal rather than state law); *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996) (no injunctive relief when a congressionally prescribed detailed remedial scheme exists for enforcement against a State); *see also Idaho v. Coeur d’Alene Tribe*, 521 U.S. 261, 294 (1997) (O’Connor, J., concurring) (“[A] *Young* suit is available where a plaintiff alleges an *ongoing* violation of *federal* law, and where the relief sought is *prospective* rather than *retrospective*.”) (emphasis in original).

¹⁷³ *Edelman v. Jordan*, 415 U.S. 651 (Illinois Department of Public Aid is an arm of the State); *Ford Motor Co. v. Dep’t of Treasury of Ind.*, 323 U.S. 459 (1945) (holding that a suit against the Department of Treasury of the State of Indiana and individuals constituting the Board of the Department of Treasury for a refund of taxes alleged to have been illegally collected is a suit against the State).

¹⁷⁴ *See Alden v. Maine*, 527 U.S. 706, 756-57 (1999) (“The immunity does not extend to suits prosecuted against a municipal corporation or other governmental entity which is not an arm of the State.”); *Auer v. Robins*, 519 U.S. 452, 456 n.1 (1997) (“The [St. Louis] Board of Police Commissioners . . . does not share the immunity of the State of Missouri. While the Governor appoints four of the board’s five members, Mo. Rev. Stat. § 84.030

municipalities, or similar State political subdivisions,¹⁷⁵ unless the relief to be obtained runs against the State.¹⁷⁶ Whether an entity is classified as an arm of the State or not depends, at least in part, upon the nature of the entity created by state law.¹⁷⁷

The *Young* doctrine permits suits for injunctive and declaratory relief against state officers acting in their official capacity.¹⁷⁸ To maintain such a suit it is sufficient for the plaintiff to allege some connection between the official and the enforcement of the illegal act.¹⁷⁹ “State officers” includes employees or

(1994), the city of St. Louis is responsible for the board’s financial liabilities, § 84.210, and the board is not subject to the State’s direction or control in any other respect. It is therefore not an ‘arm of the State’ for Eleventh Amendment purposes.”).

¹⁷⁵ See *Lincoln County v. Luning*, 133 U.S. 529 (1890) (holding that the Eleventh Amendment does not operate to prevent counties in a State from being sued in federal court); *Mt. Healthy City Sch. Dist. Bd. of Educ. v. Doyle*, 429 U.S. 274, 280-81 (1977) (holding that a local school board, even though it receives some guidance from the State Board of Education and money from the State, is more like a county or a city than it is like an arm of the State because it has extensive powers to issue bonds and levy taxes; it, therefore, is not entitled to assert any Eleventh Amendment immunity from suit in federal courts).

¹⁷⁶ See *Pennhurst*, 465 U.S. at 123 n.34 (citations omitted):

We have held that the Eleventh Amendment does not apply to ‘counties and similar municipal corporations.’ At the same time we have applied the Amendment to bar relief against county officials ‘in order to protect the state treasury from liability that would have had essentially the same practical consequences as a judgment against the State itself.’ The Courts of Appeals are in general agreement that a suit against officials of a county or other governmental entity is barred if the relief obtained runs against the State We need not decide this issue

¹⁷⁷ In *Mt. Healthy*, under Ohio Rev. Code § 2743.01 (1975), the “state” did not include “political subdivisions,” and “political subdivisions” did include local school districts. *Mt. Healthy*, 429 U.S. at 280-81. In *Lincoln County*, the Court held that the Eleventh Amendment limits the jurisdiction of federal courts only as to suits against States, not counties. *Lincoln County*, 133 U.S. at 530. In further support, the Court found that the constitution of the State of Nevada explicitly provided for the liability of counties (as corporations) to suit against a State. *Id.* at 530-31.

¹⁷⁸ *Ex parte Young*, 209 U.S. 123, 159-160 (1908).

¹⁷⁹ *Id.* at 157. For examples of state officers who were enjoined from enforcing an act, see *Young*, 209 U.S. at 132 (defendant was the Minnesota Attorney General); *Sofamor Danek Group, Inc., v. Brown*, 124 F.3d 1179, 1184 (9th Cir. 1997) (defendant was the Director of the Department of Labor and Industries of the State of Washington); *Milliken v. Bradley*, 433 U.S. 267 (1977) (state defendants included the State Board of Education, the Governor of Michigan, the Attorney General, the State Superintendent of Public Instruction, and the State Treasurer); *Salerno v. City Univ. of N.Y.*, 191 F. Supp. 2d 352 (S.D.N.Y. 2001) (holding that defendants, Chancellor of City University of N.Y. and Director of the Calandra Institute, have sufficient, albeit limited, involvement in the alleged copyright infringement to subject them to suit under the *Young* doctrine).

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instrumentalities of the State acting in their official capacity.¹⁸⁰ Private contractors, however, are not state officers.¹⁸¹

Significantly, the Eleventh Amendment and the foregoing case law do not prohibit actions for damages against state employees in their personal capacity.¹⁸² The Fourth Circuit has stated that, in determining whether the Eleventh Amendment bars an action for damages, a court must consider whether the relief sought implicates the employee's personal liability or her official duties.¹⁸³ However, collecting monetary damages against an individual employee of the State is difficult in practice.¹⁸⁴ First, the individual might be protected by substantive immunity.¹⁸⁵ Second, an individual state employee seldom has the means to pay a significant award in an infringement action.¹⁸⁶

B. Subsequent Limitations on the Young Exception

Under the *Young* doctrine, a federal court has jurisdiction in an individual's action against state officers so long as it meets two conditions. First, the plaintiff must seek prospective relief to address an ongoing violation, not recompense or other retrospective relief for past violations.¹⁸⁷ Second, the plaintiff must allege that the officers are acting in violation of federal law, not state law.¹⁸⁸ The Supreme Court has further enforced a third limitation to the *Young* exception in those instances in which Congress has created a remedial scheme so detailed as to imply that judicially created equitable remedies, such as injunctive relief, could not be invoked.¹⁸⁹ Most recently, in *Idaho v. Coeur d'Alene Tribe*, the Court affirmed the viability of *Young* doctrine, although it

¹⁸⁰ See *supra* Parts IV.D.1-3 (Clarification Acts defining "any person" as "any State, any instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity.").

¹⁸¹ See *State Contracting & Eng'g Corp. v. Florida*, 258 F.3d 1329 (Fed. Cir. 2001).

¹⁸² See *Richard Anderson Photography v. Brown*, 852 F.2d 114, 122-23 (4th Cir. 1988).

¹⁸³ *Id.*

¹⁸⁴ Robert T. Neufeld, *Closing Federalism's Loophole in the Intellectual Property Rights*, 17 *BERKELEY TECH. L.J.* 1295, 1322 (2002).

¹⁸⁵ *Id.* In *Harlow v. Fitzgerald*, 457 U.S. 800, 818 (1982), the Supreme Court held that "government officials performing discretionary functions, generally are shielded from liability for civil damages insofar as their conduct does not violate clearly established statutory or constitutional rights of which a reasonable person would have known."

¹⁸⁶ Neufeld, *supra* note 184, at 1322.

¹⁸⁷ *Edelman v. Jordan*, 415 U.S. 651, 664 (1974) (suits for prospective, not retroactive relief).

¹⁸⁸ *Pennhurst State Sch. & Hosp. v. Halderman*, 465 U.S. 89 (1984) (suits seeking compliance with federal rather than state law).

¹⁸⁹ *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996) (no injunctive relief when a congressionally prescribed detailed remedial scheme exists for enforcement against a State).

seems to have muddled the examination into when the doctrine applies.¹⁹⁰

1. *Edelman v. Jordan* – Prospective, Not Retrospective, Relief

In *Edelman v. Jordan*, the Court conducted a thorough analysis of the *Young* exception emphasizing that the relief granted by the Court in *Ex parte Young* “was prospective only.”¹⁹¹ In *Edelman*, a class of plaintiffs sought declaratory and injunctive relief against two former state officials in Illinois who were administering Aid to the Aged, Blind, or Disabled (“AABD”) benefits in a manner that was inconsistent with federal regulations and the Fourteenth Amendment.¹⁹² One of the complaints charged that the state officials were improperly authorizing grants to commence the month that the application was approved, a procedure that failed to award grant money for the application months prior to approval (even though, upon approval, it was established that the recipients had been entitled to federal aid during those application months).¹⁹³ The recipients thus sought an order directing the state officials to remit the AABD benefits that the State had wrongfully withheld.¹⁹⁴

The District Court ordered the State to comply with federal law for future applicants by placing a time limit on application processing.¹⁹⁵ The State conceded on appeal that this order amounted to proper prospective relief under *Young*.¹⁹⁶ The State, however, argued that the District Court’s award of those retroactive benefits wrongfully withheld was beyond the reach of *Young*.¹⁹⁷ On review whether the recipients were entitled to past benefits wrongfully withheld, the Supreme Court held that, although prospective relief was appropriate, the *Young* exception did not encompass any award, in law or in equity, for retroactive monetary relief.¹⁹⁸ Such relief, the Court stated, was

¹⁹⁰ In *Idaho v. Coeur d’Alene Tribe*, 521 U.S. 261 (1997), five Justices agreed that a suit against state officials for injunctive relief – which was the functional equivalent of quiet title for submerged lands under Lake Coeur d’Alene – could not proceed in federal court under the *Young* exception to the Eleventh Amendment; however, no rationale for this conclusion commanded a majority. See *infra* Part V.C.

¹⁹¹ *Edelman v. Jordan*, 415 U.S. 651, 664 (1974).

¹⁹² See *id.* at 653.

¹⁹³ See *id.* at 655.

¹⁹⁴ See *id.* at 656.

¹⁹⁵ See *id.* at 664.

¹⁹⁶ See *id.*

¹⁹⁷ See *id.*

¹⁹⁸ See *Edelman*, 415 U.S. at 658-59. In *Milliken v. Bradley*, 433 U.S. 267 (1977), however, the Supreme Court affirmed the District Court’s desegregation decree, which ordered compensatory and remedial educational programs for school children who had been subjected to past acts of *de jure* segregation and ordered the State to bear the costs of those programs. *Id.* at 289. The Court found that the decree to share the future costs of education fits within the *Edelman* prospective-compliance exception to the *Young* doctrine. *Id.* at 290

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outside the prospective purview of the *Young* doctrine.¹⁹⁹

The *Edelman* limitation on the *Young* exception, applied in the context of intellectual property infringement, will effectively limit injunctive relief from infringement prospectively. As a result, if a court orders an injunction to an intellectual property owner, the state official will be ordered to cease all infringing activity. However, the intellectual property owner will not be compensated for past infringement under this doctrine.

2. *Pennhurst State School & Hospital v. Halderman* – Requires a Violation of Federal Law, Not State Law

In *Pennhurst State School & Hospital v. Halderman*, the Court stated that the *Young* doctrine exists to enable the federal judiciary to vindicate federal rights, and to hold state officials responsible to federal law and the Constitution.²⁰⁰ Thus, the Court held that the *Young* doctrine does not extend to pendent state law claims against state officials in federal court, and that it applies only to those claims which are grounded in federal law.²⁰¹ Because intellectual property rights are grounded in federal law,²⁰² the *Pennhurst* limitation to the *Young* doctrine will generally not apply in the intellectual property context.²⁰³

3. *Seminole Tribe of Florida v. Florida* – Statutory Remedy Limitation.

In *Seminole Tribe of Florida v. Florida*,²⁰⁴ the Court created its third limitation to the *Young* doctrine. In the second holding of *Seminole Tribe*, the Court concluded that where Congress has prescribed a detailed remedial scheme for the enforcement of a statutorily created right against a State that is significantly more limited than the liability that would be imposed under the

n.21 (“Unlike the award in *Edelman*, the injunction entered here could not instantaneously restore the victims of unlawful conduct to their rightful condition. Thus, the injunction here looks to the future, not simply to presently compensating victims for conduct and consequences completed in the past.”).

¹⁹⁹ *Edelman*, 415 U.S. at 658-59.

²⁰⁰ See *Pennhurst State Sch. & Hosp. v. Halderman*, 465 U.S. 89, 105 (1984).

²⁰¹ See *id.* at 106.

²⁰² Federal courts have exclusive jurisdiction over cases arising under these federal laws.

²⁰³ Injunctive relief under the *Young* doctrine, however, will likely not be an available remedy for state law claims such as deceit, unfair competition, conversion, restitution, or contract claims. This is a predictable result given that these state law claims are redressable in state court.

²⁰⁴ *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44 (1996). Although the real thrust of the *Seminole Tribe* decision is the limitation it places on the congressional power to abrogate Eleventh Amendment immunity, *supra* Part IV.E, it also bars the application of the *Young* doctrine to support a suit against a state official for prospective injunctive relief to enforce the good-faith bargaining requirement of the Indian Gaming Regulatory Act (“IGRA”).

Young doctrine, the *Young* doctrine does not apply.²⁰⁵

The Seminole Tribe petitioned the Court to enjoin the Governor of Florida, forcing him to fulfill his duty under federal law to negotiate a compact with respect to gaming activities.²⁰⁶ Faced with two issues, the Court first held that the abrogation provision in the Indian Gaming Regulatory Act (“IGRA”)²⁰⁷ was an unconstitutional abrogation of the State’s Eleventh Amendment immunity from suit in federal court because Congress’s power to abrogate does not extend to its powers under the Commerce Clause.²⁰⁸ Thus, the Court found that Congress does not have any authority under the Constitution to make the State liable to suit in federal court under § 2710(d)(7).

Second, the Court held that the doctrine of *Ex parte Young* could not be used to enforce § 2710(d)(3) of IGRA²⁰⁹ against a state official, because, even though the Court found that § 2710(d)(7) of IGRA was an unconstitutional abrogation of Eleventh Amendment immunity, § 2710(d)(7)’s detailed “intricate procedures” were intended to significantly limit the duty imposed by § 2710(d)(3) and not to extend to broad *Young* relief.²¹⁰ The Court reasoned that “[w]here Congress has created a remedial scheme for the enforcement of a particular federal right, we have, in suits against federal officers, refused to supplement that scheme with one created by the judiciary.”²¹¹ The Court concluded that if Congress had intended for § 2710(d)(3) to be enforceable in a *Young* suit, then § 2710(d)(7) would be a superfluous provision.²¹²

The Court borrowed its approach in *Seminole Tribe* from *Schweiker v. Chilicky*²¹³ to establish a new limitation on the *Young* exception.²¹⁴ *Chilicky*

²⁰⁵ *See id.* at 73-76.

²⁰⁶ *See id.* at 51-52.

²⁰⁷ 25 U.S.C. § 2710(d)(7).

²⁰⁸ For a detailed discussion of the Court’s first holding in *Seminole Tribe*, see *supra* Part IV.E. Although the power to abrogate is limited to congressional power pursuant to the Fourteenth Amendment, the application of the *Young* doctrine is not subject to the same restriction. According to the *Young* doctrine, injunctive relief is available for a state violation of the Constitution or the laws of the United States. *See supra* note 156.

²⁰⁹ IGRA § 2710(d)(3) imposes a duty upon the States to negotiate in good faith with an Indian tribe toward the formation of a compact.

²¹⁰ *Seminole Tribe*, 517 U.S. at 74-76. For an example of “intricate procedures,” 25 U.S.C. § 2710(d)(7) provides that, where a court finds that the State has failed to negotiate in good faith, then the court shall order the State and the Indian tribe to conclude a compact within sixty days. *Id.* at 50.

²¹¹ *Id.* at 74 (citing *Schweiker v. Chilicky*, 487 U.S. 412, 423 (1988)).

²¹² *Id.* at 75.

²¹³ *Chilicky*, 487 U.S. at 42.

²¹⁴ *Id.* at 423, quoted in *Seminole Tribe*, 517 U.S. at 74 (“When the design of a Government program suggests that Congress has provided what it considers adequate remedial mechanisms for constitutional violations that may occur in the course of its administration, we have not created additional . . . remedies.”).

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addressed whether an award of money damages for state agencies' wrongful termination of social security disability benefits was legally justified under the *Bivens v. Six Unknown Federal Narcotics Agents*.²¹⁵ In *Chilicky*, the Court held that the existence of a congressionally created remedial scheme, for example, the administrative structure and procedures of the Social Security system,²¹⁶ precluded a court from creating any additional remedies.²¹⁷

Although the majority in *Seminole Tribe* acknowledged that the award questioned in *Chilicky* (monetary damages for the wrongful denial of benefits from an administrative agency) differed from the award questioned in *Seminole Tribe* (injunctive relief), it nevertheless applied the *Chilicky* principle.²¹⁸ In applying this principle, the *Seminole Tribe* majority found that the limited state liability provided under IGRA's remedial scheme signaled Congress's desire not to impose *Ex parte Young* liability on state officials for violations of the duty to negotiate in good faith.²¹⁹ Thus, the Court found that *Young* was not available to the Seminole Tribe, and that the Eleventh Amendment barred suit against the Governor.²²⁰

In a fervid dissent, Justice Souter theorized that the majority's opinion in *Seminole Tribe* had effectively overruled *Ex parte Young*. In expressing his opposition toward altering the doctrine's application or viability, Justice Souter explained the history and lineage of *Young* as well as the important role that it serves today in assuring the supremacy of federal law.²²¹ Justice Souter further argued that *Young* actions and *Bivens* actions, as embodied in the *Chilicky* analysis, are distinguishable in two ways.²²² First, Justice Souter argued that *Young* does not provide retrospective monetary relief, like *Bivens* actions; instead, it "allows prospective enforcement of federal law that is entitled to

²¹⁵ *Bivens v. Six Unknown Fed. Narcotics Agents*, 403 U.S. 388 (1971). In *Bivens* rights of actions, "where legal rights have been invaded, and a federal statute provides for a general right to sue for such invasion, federal courts may use any available remedy to make good the wrong done." *Chilicky*, 487 U.S. at 421, quoting *Bivens*, 403 U.S. at 396-97. However, the Court warns in *Chilicky* that "[w]hen the design of a Government program suggests that Congress has provided what it considers adequate remedial mechanisms for constitutional violations that may occur in the course of its administration, we have not created additional *Bivens* remedies." *Chilicky*, 487 U.S. at 423.

²¹⁶ For a detailed description of the procedures available under the Continuing Disability Review program, see *Chilicky*, 487 U.S. at 424-25.

²¹⁷ *Chilicky*, 487 U.S. at 428-29.

²¹⁸ *Seminole Tribe*, 517 U.S. at 74 ("Here, of course, the question is not whether a remedy should be created, but instead is whether the Eleventh Amendment bar should be lifted, as it was in *Ex parte Young*, in order to allow a suit against a state officer.").

²¹⁹ *Id.* at 74-75.

²²⁰ *Id.* at 76.

²²¹ *Id.* at 169-175.

²²² *Id.* at 176-77.

prevail under the Supremacy Clause.”²²³ And, second, Justice Souter argued that *Young* does not function to provide a “supplementary regime of compensation to deter illegal action.”²²⁴ Instead, he argued, *Young* is the sole jurisdictional basis for a court’s enforcement of a federal statutory obligation against a State.²²⁵

The *Seminole Tribe* limitation to the *Young* doctrine extends Eleventh Amendment immunity to state officials where Congress provides a statutory remedial scheme which is a specific and limited remedy that is more limited than the liability that would be imposed by the application of the *Young* doctrine. Although remedies for infringement are also defined in the federal intellectual property laws, the Copyright Act, the Patent Act, and the Trademark Act (Lanham Act) all contemplate injunctive relief, unlike the scheme in the IGRA.²²⁶ As a result, the *Seminole Tribe* limitation will likely not affect the enforcement of injunctive relief against state actors for intellectual property infringement.²²⁷

Indeed, the Ninth Circuit held in *Sofamor Danek Group, Inc. v. Brown*²²⁸ that Congress did not intend to limit the availability of *Ex parte Young* suits over a cause of action brought against the Director of the Department of Labor and Industries of the State of Washington for making false and misleading

²²³ *Id.* at 177.

²²⁴ *Seminole Tribe*, 517 U.S. at 177.

²²⁵ *Id.*

²²⁶ Compare 1976 Copyright Act, 17 U.S.C. § 502(a) (“Any court having jurisdiction of a civil action arising under this title may, subject to the provisions of section 1498 of title 28, grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.”), Patent Act, 35 U.S.C. §§ 281 (“A patentee shall have remedy by civil action for infringement of his patent.”) and 283 (“The several courts having jurisdiction of cases under this title [35 U.S.C. §§ 1 *et seq.*] may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.”), and Trademark Act of 1946 (Lanham Act), 15 U.S.C. § 1116 (“The several courts vested with jurisdiction of civil actions arising under this Act shall have power to grant injunctions . . .”) with Indian Gaming Regulatory Act, 25 U.S.C. § 2710(d)(7):

(A) The United States district courts shall have jurisdiction over (i) any cause of action initiated by an Indian tribe arising from the failure of a State to enter into negotiations with the Indian tribe for the purpose of entering into a Tribal-State compact under paragraph (3) or to conduct such negotiations in good faith . . . (B)(i) An Indian tribe may initiate a cause of action described in subparagraph (A)(i) only after the close of the 180-day period beginning on the date on which the Indian tribe requested the State to enter into negotiations under paragraph (3)(A).

²²⁷ See *Coll. Savings Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666, 704 (1999) (Breyer, J., dissenting) (“*Ex parte Young* . . . is still available [as a remedy for trademark infringement by States], though effective only where damages remedies are not important.”).

²²⁸ *Sofamor Danek Group, Inc. v. Brown*, 124 F.3d 1179 (9th Cir. 1997).

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statements about its spinal fixation devices in violation of the Lanham Act.²²⁹ The Court found it evident from the plain language of the statute that the Lanham Act not only contemplates suit against state officials, but explicitly authorizes *Ex parte Young* actions.²³⁰

C. Idaho v. Coeur d'Alene Tribe – *Reconsidering Young*

The Court addressed the “proper scope and application” of the *Ex parte Young* doctrine in *Idaho v. Coeur d'Alene Tribe*.²³¹ The Court affirmed the viability of the *Young* doctrine in federal jurisprudence, finding that it does not apply in the context of an Indian tribe’s suit against a state official for the functional equivalent of quiet title to the submerged lands of Lake Coeur d’Alene. The Court failed, however, to affirm any clear rule for applying the doctrine. The Coeur d’Alene Tribe brought suit in district court claiming ownership of the “submerged lands and bed of Lake Coeur d’Alene and of various navigable rivers and streams that form part of its water system.”²³² Although five Justices agreed (with four Justices dissenting) that the suit against the state officials could not proceed in federal court under the *Young* exception to the Eleventh Amendment, no rationale for this conclusion commanded a majority.²³³ Seven Justices affirmed the viability of the *Young*

²²⁹ *Id.* at 1186.

²³⁰ *Id.* at 1185. The court references the following language of § 1125(a) of the Lanham Act to show that the Act contemplates suit against state officials:

Any person who [acts in violation of the statute] . . . shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act The term “any person” includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

Id. at 1185 (emphasis in original). Courts with jurisdiction over civil actions arising under the Lanham Act also have the power to grant injunctions. Lanham Act, 15 U.S.C. § 1116; *see also supra* note 226. Although the Supreme Court subsequently held in *College Savings Bank* that this provision of the Lanham Act was an invalid abrogation with respect to false or misleading advertising claims, this holding has no effect on the finding of Congressional intent within the statute to authorize *Ex parte Young* actions. *See Seminole Tribe of Florida v. Florida*, 517 U.S. 44, 75-76 (1996) (stating that, even after finding that the statute at issue was an invalid abrogation on Eleventh Amendment immunity, Congress did not intend to extend relief in the remedial scheme of IGRA to broad *Young* relief).

²³¹ *Idaho v. Coeur d'Alene Tribe*, 521 U.S. 261, 269-273 (1997).

²³² *Coeur d'Alene Tribe v. Idaho*, 798 F. Supp. 1443, 1445 (D. Idaho 1992), *rev'd in part* (claim against state officials), *and aff'd in part* (claim against State and state agencies), 42 F.3d 1244 (9th Cir. 1994), *rev'd* (state officials), 521 U.S. 261, 264 (1997).

²³³ Justice Kennedy wrote the principal opinion in which Chief Justice Rehnquist joined; Justice O'Connor wrote the concurring opinion in which Justice Scalia and Justice Thomas joined; and Justice Souter wrote the dissenting opinion in which Justice Stevens, Justice

doctrine, concluding that a *Young* suit is available when a plaintiff alleges an ongoing violation of federal law by a state official, and where the relief sought is prospective rather than retrospective.²³⁴

One commentator, William E. Thro, contends that, in *Coeur d'Alene*, the Supreme Court found the *Young* doctrine inapplicable when “special sovereignty interests,” such as a State’s interest in maintaining effective ownership of its land, are involved.²³⁵ He deduces that the Supreme Court could find “special sovereignty interests” also extend to the academic freedom of a state university.²³⁶ As a result, the *Young* doctrine would not apply in a private party’s suit against a state university.

Such an extrapolation is unlikely, however, considering the unique interest the State of Idaho had in the submerged lands in the *Coeur d'Alene* case and the need for the Court to maintain some vehicle under the Supremacy Clause by which federal law could be vindicated.²³⁷ Although the *Young* doctrine’s vitality appears to be withering, it still remains part of well-established Eleventh Amendment jurisprudence.²³⁸

Despite the Court’s inability to reach a consensus on a rule of application for the *Young* doctrine – that is, whether the inquiry applies a straightforward

Ginsberg, and Justice Breyer joined. *Idaho v. Coeur d'Alene Tribe*, 521 U.S. 261 (1997). Justice Kennedy supported the theory of applying *Young* on a case-by-case balancing approach by contrasting *Edelman v. Jordan*, 415 U.S. 651 (1974) with *Milliken v. Bradley*, 433 U.S. 267 (1977). *Coeur d'Alene*, 521 U.S. at 278-80. The principal opinion argues that, in *Edelman*, the Court denied the welfare benefit recipients retroactive relief for federal benefits wrongly withheld by the State; however, in *Milliken*, the Court affirmed an order requiring the State to pay a retrospective award, that is, a comprehensive education program for school children who had been subjected to past acts of *de jure* segregation. *Id.* This argument, however, is rejected by Justice O'Connor in her concurrence, which states that the relief in *Milliken* was not retrospective. *Id.* at 295. *See also Milliken*, 433 U.S. at 290 (“That the programs are also ‘compensatory’ in nature does not change the fact that they are part of a plan that operates *prospectively* to bring about the delayed benefits of a unitary school system.”). Justice O'Connor argued that a vague balancing test should not replace the straightforward approach that already exists: a *Young* suit is available when a plaintiff alleges an ongoing violation of federal law by a state official, and where the relief sought is prospective rather than retrospective. *Id.* at 294. Also noteworthy is that Justice Souter states in his dissenting opinion (to which three other Justices join) that “Justice O'Connor’s view should be the controlling one.” *Id.* at 298.

²³⁴ *Coeur d'Alene*, 521 U.S. at 294 (O'Connor, J., concurring), 298 (Souter, J., dissenting).

²³⁵ *See* William E. Thro, *Why You Cannot Sue State U: A Guide to Sovereign Immunity*, NAT'L ASSOC. OF COLL. & UNIV. ATTORNEYS PUBL'N SERIES 14 (2001).

²³⁶ *Id.*

²³⁷ *See id.*

²³⁸ Patricia L. Barsalou & Scott A. Stengel, *Ex parte Young: Relativity in Practice*, 72 AM. BANKR. L.J. 455, 495-96 (1998).

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approach or a case-by-case balancing approach²³⁹ – in *Coeur d’Alene*, seven of the Justices affirmed that a *Young* suit is available when a plaintiff alleges an ongoing violation of federal law by a state official, and where the relief sought is prospective rather than retrospective.²⁴⁰ Moreover, even though the Court’s treatment of the *Young* doctrine in *Seminole Tribe* to bar injunctive relief against a State where Congress has prescribed a detailed remedial scheme for enforcement against a State of a statutorily created right that does not contemplate injunctive relief seems “willfully perverse,”²⁴¹ its practical effect is limited.²⁴² Finally, the mechanics of our federal system “demand that *Young* persist to balance the Eleventh Amendment.”²⁴³

D. Hypothetical Applications of the Young Exception to State Universities

In the intellectual property context, the limitations to the *Young* doctrine will likely not bar a plaintiff from applying the *Young* exception to Eleventh Amendment immunity and suing a state officer in federal court for injunctive relief. First, although a plaintiff will not be able to seek retrospective monetary damages for past infringement, the plaintiff will still be able to seek prospective relief from infringement. Second, the Copyright, Patent, and Trademark laws are enforced by federal statutes, not state statutes, and thus are within the expanse of the *Young* doctrine. And, finally, all of the intellectual property statutes (i.e., the Copyright, Patent, and Trademark Acts) contemplate injunctive relief as a remedy within their detailed remedial schemes.²⁴⁴ Despite this new limitation added by the Court in *Seminole Tribe*, its practical significance for questions of injunctive relief will be limited.²⁴⁵

The danger to state agencies from intellectual property claims is exemplified by consideration of such claims in the context of state-run universities. Given that a patent grants the patent holder the right to exclude all others from using the patented invention,²⁴⁶ basic and applied research programs are at risk for infringement claims based upon the patented technology of a third party. Such

²³⁹ See *supra* note 233. As acknowledged by Justice O’Connor in her concurring opinion, the factors that the principal opinion considers in its case-by-case approach include whether a state forum is available to hear the dispute, what particular federal right the suit implicates, and whether “special factors counsel hesitation” in the exercise of jurisdiction. *Coeur d’Alene*, 521 U.S. at 291 (O’Connor, J., concurring).

²⁴⁰ See *supra* note 233.

²⁴¹ John C. Jeffries, Jr., *In Praise of the Eleventh Amendment and Section 1983*, 84 VA. L. REV. 47, 52 n.19 (1998).

²⁴² LOW & JEFFRIES, *supra* note 150, at 265.

²⁴³ Barsalou & Stengel, *supra* note 238, at 496.

²⁴⁴ See 1976 Copyright Act, 17 U.S.C. § 502 (2000); Patent Act, 35 U.S.C. §§ 281, 283 (2000); Trademark Act of 1946 (Lanham Act), 15 U.S.C. § 1116 (2000).

²⁴⁵ LOW & JEFFRIES, *supra* note 150, at 265.

²⁴⁶ 35 U.S.C. § 154(a)(1).

infringement claims appear extremely likely in the context of sponsored research wherein a university conducts research with the financial support of an industrial company. Claims by competitors of that company against the university, based upon a competitor's patent covering the use of a process or device employed in the sponsored research, are foreseeable.

In the case of trademarks, increased exposure to suit is also likely, especially since the normal relief sought for trademark infringement is injunctive relief.²⁴⁷ Modern state-run universities have extensive athletic programs that commonly use trademarks to identify their activities and to identify branded merchandise sold by or under the sponsorship of the university. One can readily contemplate litigation against the university by a manufacturer or merchant of branded merchandise for infringement of a federally-registered trademark. Section 43(a) of the Lanham Act also provides for protection of unregistered names and marks.²⁴⁸ A likely scenario for litigation based on such unregistered names and marks is a claim by another university having a similar name, especially given the common practice of promoting universities by two and three-letter acronyms of their names.²⁴⁹

In the case of copyrights, the potential of injunctive relief perhaps raises the gravest danger for a university. The sale of branded merchandise may be subject to copyright infringement claims, especially if such merchandise includes artwork or other images included on works subject to copyright protection.²⁵⁰ Universities also have as a principal mission the publication and distribution of research and other information.²⁵¹ In support of this mission, universities provide numerous vehicles for publication, which extend from the distribution of print media to the narrowcasting of information via specialized communication networks to the broadcasting of information via radio, TV and Internet media. Each of these activities is subject to copyright infringement claims by owners of copyrightable works.²⁵² State-run universities are also the

²⁴⁷ See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS § 30:2 (4th ed. 2003).

²⁴⁸ 15 U.S.C. § 1125(a).

²⁴⁹ An example is provided by the University of Wisconsin, University of Wyoming, and University of Washington, all of which use and promote the mark "UW."

²⁵⁰ 17 U.S.C. § 106(2) (2000) ("[T]he owner of a copyright under this title has the exclusive rights to do and to authorize the following . . . to prepare derivative works based upon the copyrighted work . . .").

²⁵¹ See, e.g., University of Washington, Office of the Executive Vice President, Mission and Vision, available at <http://www.washington.edu/president/evp-mission.htm> (last visited April 15, 2004) ("[P]roviding relevant information where and when it is needed so that users can make and implement well-informed decisions.").

²⁵² 17 U.S.C. § 106 (2000) (including the exclusive rights of an owner of a copyright to do and to authorize the following: reproduction, preparation of derivative works, distribution, performance, display, and performance by means of a digital audio transmission).

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principal operators of many Internet hubs, over which a tremendous and substantial volume of information passes.²⁵³ Although some protection may be available, in the event that the university complies with the registration provisions of the Digital Millennium Copyright Act,²⁵⁴ the exposure for copyright infringement claims, directed to activities over which the university has absolutely no control, is substantial.

Universities traditionally have sought to deflect any liability for infringement of intellectual property claims by seeking indemnification from those with whom they deal. It is well recognized, however, that such indemnification is only as good as the ability of the indemnifier to defend and support the university in any such claim. Regarding injunctive relief, the substantial disruption of university activities resulting from an infringement claim most likely can never be wholly or even partly indemnified through the use of such arrangements.

VI. CONCLUSION

Under the doctrine of *Ex parte Young*, states rely on their Eleventh Amendment rights at their peril insofar as intellectual property claims are concerned. The availability of injunctive relief against state officers for intellectual property infringement should lead state agencies to carefully and comprehensively investigate and evaluate intellectual property claims relating to their activities and alter or modify those activities as necessary to avoid or minimize the likelihood of such intellectual property claims.

²⁵³ Garret Sern, *Policy@edu: Will Colleges and Universities Become Cybercops?*, EDUCOM REV. (1999), available at <http://www.educause.edu/ir/library/html/erm9942.html>.

²⁵⁴ Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified in scattered sections of 17 U.S.C.).