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## Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?

John C. Beiter

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# RECENT DEVELOPMENT

## Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?

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## I. INTRODUCTION

The federal courts recently have renewed the debate concerning whether a person can sue a state government or its instrumentalities for copyright infringement. The question presents a clash of fundamental constitutional principles between the copyright and patent clause,<sup>1</sup> whose purpose is to promote the free flow of ideas by rewarding creativity,<sup>2</sup> and the eleventh amendment,<sup>3</sup> whose primary purpose is to protect the federal form of government by insulating states from suit in federal court.<sup>4</sup> The Copyright Act of 1976 (the 1976 Act)<sup>5</sup> and its predecessor, the Copy-

1. The copyright and patent clause provides: "The Congress shall have Power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8.

2. See, e.g., *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 546 (1985) (recognizing that "[t]he monopoly created by copyright . . . rewards the individual author in order to benefit the public") (quoting *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (Blackmun, J., dissenting)).

3. The eleventh amendment provides: "The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State." U.S. CONST. amend. XI.

4. See, e.g., *Atascadero State Hosp. v. Scanlon*, 105 S. Ct. 3142, 3145-46 & n.2 (1985) (noting that "the Eleventh Amendment implicates the fundamental constitutional balance between the Federal Government and the States"); Note, *Pennhurst State School & Hospital v. Halderman: Federal Equity Jurisdiction Restricted by Eleventh Amendment Immunity*, 16 LOY. U. CHI. L.J. 149, 158-60 (1984) (asserting that the states, in ratifying the eleventh amendment, guaranteed federalism by "prevent[ing] the federal government, through its courts, from interfering in state governmental functions"). *But see Atascadero*, 105 S. Ct. at 3150-78 (Brennan, J., dissenting) (holding eleventh amendment doctrine not based on principles fundamental to federalism); Gibbons, *The Eleventh Amendment and State Sovereign Immunity: A Reinterpretation*, 83 COLUM. L. REV. 1889, 1894 (1983) (arguing that the eleventh amendment is merely a "narrow and technical redefinition of the two jurisdictional clauses of article III . . . . The amendment did nothing more than amend article III, section 2 of the Constitution to eliminate the power of federal courts to hear suits against states in which the sole basis for jurisdiction" was the presence of a diverse party); Fletcher, *A Historical Interpretation of the Eleventh Amendment: A Narrow Construction of an Affirmative Grant of Jurisdiction Rather Than a Prohibition Against Jurisdiction*, 35 STAN. L. REV. 1033 (1983). See generally Baker, *Federalism and the Eleventh Amendment*, 48 U. COLO. L. REV. 139 (1977).

5. 17 U.S.C. §§ 101-914 (1982 & Supp. III 1985).

right Act of 1909 (the 1909 Act),<sup>6</sup> grant copyright proprietors "exclusive" rights in their works.<sup>7</sup> While 28 U.S.C. § 1338(a) grants federal courts exclusive subject matter jurisdiction to entertain actions concerning copyright infringement,<sup>8</sup> the eleventh amendment generally prohibits suits in federal court against state governments.<sup>9</sup> Thus, absent a waiver or other abrogation of eleventh amendment immunity,<sup>10</sup> a proprietor's rights in a work apparently are not always exclusive; in effect, the owner is required to share his copyright if the infringer is a state government or its instrumentality.

The resolution of this question necessarily requires an examination of two constitutional issues. The first issue is the extent to which a state impliedly waives its eleventh amendment immunity from suit in federal court by engaging in a federally regulated activity.<sup>11</sup> The United States Supreme Court first enunciated the implied waiver doctrine in *Parden v. Terminal Railway*.<sup>12</sup> Federal courts traditionally have interpreted *Parden* to mean that Congress may condition a state's participation in certain federally regulated activities, such as the operation of an interstate railroad,<sup>13</sup> upon the state's waiver of immunity to potential private suits in federal court. In a copyright infringement suit, however, it is un-

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6. Ch. 320, 35 Stat. 1075, revised by Copyright Act of 1976, 17 U.S.C. §§ 101-914 (1982 & Supp. III 1985). The 1909 Act continues to govern works created before passage of the 1976 Act. For purposes of this Recent Development, citations to 17 U.S.C. §§ 1-216 will refer to the 1909 Act, and citations to 17 U.S.C. §§ 101-914 will refer to the 1976 Act.

7. See 17 U.S.C. § 106 (1982 & Supp. III 1985); 17 U.S.C. § 1 (1976).

8. 28 U.S.C. § 1338(a) (1982) (stating that "[t]he district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, . . . [or] copyrights . . . Such jurisdiction shall be exclusive of the courts of the states").

9. U.S. CONST. amend. XI; see, e.g., *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 100 (1984) (holding that "an unconsenting State is immune from suits brought in federal courts by her own citizens as well as by citizens of another state") (quoting *Employees v. Department of Pub. Health and Welfare*, 411 U.S. 279, 280 (1973)). A state agency may be adjudged an "alter ego" of the state and, thus, receive eleventh amendment immunity. See *King v. Caesar Rodney School Dist.*, 396 F. Supp. 423, 425 (D. Del. 1975).

10. A state may waive its eleventh amendment immunity either expressly, see *Clark v. Barnard*, 108 U.S. 436, 447-48 (1883) (express waiver by appearance in court), or by implication, see *Parden v. Terminal Ry.*, 377 U.S. 184 (1964) (implied waiver by participation in federally regulated activity). See generally Note, *Express Waiver of Eleventh Amendment Immunity*, 17 GA. L. REV. 513 (1983); Comment, *Implied Waiver of a State's Eleventh Amendment Immunity*, 1974 DUKE L.J. 925.

11. See generally Comment, *supra* note 10.

12. 377 U.S. 184 (1964); see *infra* notes 49-65 and accompanying text.

13. See *id.*; see also *Briggs v. Sagers*, 424 F.2d 130 (10th Cir.), *cert. denied*, 400 U.S. 829 (1970) (state operation of mental institution); *Chesapeake Bay Bridge & Tunnel Dist. v. Lauritzen*, 404 F.2d 1001 (4th Cir. 1968) (state operation of bridge).

clear whether the state's use of copyrighted material constitutes consent to suit in federal court. Thus, the question of whether the implied waiver doctrine articulated in *Parden* applies in a copyright infringement suit against a state remains unanswered.<sup>14</sup>

The second issue is the continued vitality of the eleventh amendment in light of recent Supreme Court and lower federal court decisions. In *Fitzpatrick v. Bitzer*<sup>15</sup> the Supreme Court discarded, for the first time, the requirement of state immunity waiver and held that in certain instances Congress has the power to unilaterally abrogate eleventh amendment protection.<sup>16</sup> While *Fitzpatrick* concerned a state's violation of a federal statute passed pursuant to section 5 of the fourteenth amendment,<sup>17</sup> later federal court decisions have implied this broad congressional power in other areas.<sup>18</sup> Two federal courts have extended the *Fitzpatrick* holding beyond the context of fourteenth amendment legislation to find that the copyright and patent clause empowers Congress to nullify the eleventh amendment in copyright infringement cases.<sup>19</sup> Under this interpretation, a private party could sue an allegedly infringing state in federal court without the state's express or implied consent. If adopted by the Supreme Court, this broad read-

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14. See *infra* notes 281-92 and accompanying text.

The federal government has expressly consented to federal court suit for copyright infringement. Money damages are the sole remedy for violations by the federal government; injunctive relief is not available. 28 U.S.C. § 1498(b) (1982); see S. REP. NO. 1877, 86th Cong., 2d Sess. reprinted in 1960 U.S. CODE CONG. & ADMIN. NEWS 3444; H.R. REP. NO. 624, 86th Cong., 1st Sess. (1959). See generally W. PATRY, LATMAN'S THE COPYRIGHT LAW 270-71 (1986).

15. 427 U.S. 445 (1976).

16. *Id.* at 456; see *infra* notes 80-88 and accompanying text.

17. *Fitzpatrick*, 427 U.S. at 456. Section 1 of the fourteenth amendment provides: No state shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States; nor shall any state deprive any person of life, liberty, or property, without due process of law; nor deny any person within its jurisdiction the equal protection of the laws.

U.S. CONST. amend. XIV, § 1.

Section 5 of the fourteenth amendment further provides: "The Congress shall have power to enforce, by appropriate legislation, the provisions of this article." U.S. CONST. amend. XIV, § 5.

18. See, e.g., *County of Monroe v. Florida*, 678 F.2d 1124 (2d Cir. 1982), *cert. denied*, 459 U.S. 1104 (1983) (congressional extradition power); *Peel v. Florida Dep't of Transp.*, 600 F.2d 1070 (5th Cir. 1979) (congressional war powers); *Jennings v. Illinois Office of Educ.*, 589 F.2d 935 (7th Cir.), *cert. denied*, 441 U.S. 967 (1979) (congressional war powers); *Oneida Indian Nation v. New York*, 520 F. Supp. 1278 (N.D.N.Y. 1981) (congressional power to regulate commerce with Indian tribes); see also *infra* notes 95-109 and accompanying text.

19. See *Mills Music Inc. v. Arizona*, 591 F.2d 1278, 1285 (9th Cir. 1979); *Johnson v. University of Va.*, 606 F. Supp. 321 (W.D. Va. 1985); *infra* notes 133-48, 162-78 and accompanying text.

ing of Congress' power under the copyright and patent clause would not only establish the amenability of nonconsenting states to copyright infringement suits, but also would contract greatly the boundaries of eleventh amendment immunity.<sup>20</sup>

Copyright proprietors have a great economic stake in the resolution of this issue.<sup>21</sup> State institutions and their local instrumentalities are prodigious users of copyrighted works.<sup>22</sup> One obvious example is the use of copyrighted textbooks by state schools and universities. In addition, sound recordings, sheet music, textbooks, plays, photographs, computer software, and motion pictures play an integral role in the state's performance of its educational, health care, recreational, and law enforcement functions.<sup>23</sup> A textbook publisher would have little economic incentive to continue producing books if the publisher knew that a state could misappropriate the works by purchasing one copy for unlicensed reproduction. One commentator has suggested that this situation would cause purchases of copyrighted works to cease, resulting in a loss of revenue to creators.<sup>24</sup>

20. See Gibbons, *supra* note 4, at 2004. Without deciding the issue, the Supreme Court recently noted this broadening interpretation by lower courts of Congress' power to nullify a state's constitutional immunity from suit in federal court without the state's consent. See *County of Oneida v. Oneida Indian Nation*, 470 U.S. 226, 252 (1985).

21. Goldberg, *Copyright Law: Sovereign Immunity*, N.Y.L.J., Sept. 20, 1985, at 1, col. 1; see, e.g., *Wihtol v. Crow*, 309 F.2d 777, 778 (1962) (recognizing that the plaintiff "depends upon the income from the [infringed] song for his support").

22. Goldberg, *supra* note 21, at 1, col. 1.

23. *Id.* In certain circumstances, such as teaching, scholarship, or research, a state agency's use of portions of copyrighted works may be exempt from copyright restrictions under the "fair use" limitation on a proprietor's exclusive rights. See 17 U.S.C. § 107 (1982) ("Limitations on exclusive rights: Fair use"). In determining whether a state's use of a copyrighted work is exempt, courts should consider four factors: (1) the purpose and character of the use; (2) the nature of the work; (3) the substantiality of the portion used; and (4) the effect of the use on the work's value. *Id.* § 107(1)-(4). For a general discussion of the fair use doctrine, see Walker, *Fair Use: The Adjustable Tool for Maintaining Copyright Equilibrium*, 43 LA. L. REV. 735 (1983). See generally 17 U.S.C. §§ 107-18 (1982) (listing limitations on copyright owner's exclusive rights).

24. Goldberg, *supra* note 21, at 2, col. 4. As one party has argued:

States and state agencies, including schools, colleges, and libraries, make vast use of copyrighted works. They buy countless textbooks, and works of science, biography, history, mathematics, fiction, poetry, philosophy, and other subjects. These state institutions also are a primary medium for the performance of copyrighted plays and musicals . . . . Only the threat of damages awards, and injunctive relief, against States has prevented widespread infringement of them.

Motion on Appeal of the Authors League of Am., Inc. at 2-3, *Mihalek Corp. v. Michigan*, 595 F. Supp. 903 (E.D. Mich. 1984), *appeal docketed*, No. 85-1593 (6th Cir. July 23, 1985); see also Motion on Appeal of the National Music Publishers' Ass'n, Inc. at 3, *Mihalek*, No. 85-1593 (urging that "[t]he potential injury . . . cannot be understated . . . [S]tates could supply thousands of photocopied reproductions of copyrighted music to members of univer-

A related concern is the form of relief available against an infringing state. While the Supreme Court in *Ex parte Young*<sup>25</sup> held that a person could obtain injunctive relief against a state official to prohibit future unconstitutional actions,<sup>26</sup> the eleventh amendment generally protects a state from a damages award.<sup>27</sup> In the case of certain copyrighted works, such as popular songs that often have only a brief period of economic productivity, injunctive relief could come too late to vindicate completely the copyright proprietor's rights.<sup>28</sup> Thus, the issue of state immunity from copyright infringement suits not only has constitutional implications, but also has immediate economic significance to copyright proprietors.

This Recent Development examines the federal court decisions that concern alleged copyright infringement by a state or its instrumentalities. Part II discusses two areas of legal background: (1) the history of eleventh amendment immunity as developed by the Supreme Court; and (2) the federal court of appeals split on the subject of state immunity from copyright infringement suits. Part III examines five recent federal district court cases that analyze, with differing results, copyright owners' attempts to sue states in federal court for alleged infringement. Part IV discusses these infringement cases using the analytical frameworks employed by the Supreme Court in *Parden* and *Fitzpatrick*. Finally, Part V proposes a resolution to the apparent conflict between copyright protection and the states' eleventh amendment immunity. This proposal accommodates several competing interests: copyright owners'

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sity bands, orchestras and glee clubs, who could perform this music without payment of any royalties to its composers and publishers and without fear of monetary sanction").

In addition, federal court immunity for states "could affect not only the rights of copyright owners, but also the rights of owners of other forms of intellectual property, including patents and trademarks, which are widely used by State governmental bodies." Motion on Appeal of the Intellectual Property Law Ass'n at 2, *Mihalek*, No. 85-1593.

25. 209 U.S. 123 (1908).

26. *Id.* at 155-56; see *infra* notes 45-46 and accompanying text.

27. See, e.g., *Edelman v. Jordan*, 415 U.S. 651, 668-71 (1974); see *infra* notes 74-79 and accompanying text.

28. Goldberg, *supra* note 21, at 2, col. 4. One party has argued:

[State immunity from federal court suit would relegate copyright owners] to the sole remedy of prospective injunctive relief against individual state officials—if they can be identified and sued before substantial damage is done. Totally unavailable as the *deterrent* intended by Congress to protect the value of copyrights would be the remedies of recovery of the infringer's profits in addition to the owner's damages, the alternative of statutory damages . . . , as well as recovery of costs and attorney's fees in appropriate cases. 17 U.S.C. §§ 504 and 505.

Motion on Appeal of National Music Publishers' Ass'n, Inc. at 6, *Mihalek*, No. 85-1593 (emphasis in original).

interest in the protection of exclusive rights; states' interest in immunity from federal court suits; and society's interest in responsible government.<sup>29</sup>

## II. LEGAL BACKGROUND

### A. State Immunity Under the Eleventh Amendment

#### 1. Early Developments

The doctrine of sovereign immunity provides that a claimant cannot sue the sovereign without the sovereign's consent.<sup>30</sup> The doctrine arose under the common law of England<sup>31</sup> and quickly was adopted by the independent states of postrevolutionary America.<sup>32</sup> Thus, the states were immune from nonconsensual suits in their own courts.<sup>33</sup> Adoption of the United States Constitution, however, created confusion about the states' immunity from suits brought by private parties in the recently formed federal courts.<sup>34</sup> Specifically, article III, section 2 of the Constitution provides that "[t]he judicial Power shall extend . . . to Controversies . . . between a State and Citizens of another State."<sup>35</sup> A literal reading of this language presented the possibility that federal courts would have jurisdiction over suits between a private party from one state and another independent state.

Five years after ratification of the Constitution, the Supreme Court faced this issue in *Chisholm v. Georgia*.<sup>36</sup> In *Chisholm* two South Carolina creditors sued the State of Georgia in federal court for a Revolutionary War debt that the state allegedly owed. Interpreting article III literally, the Court held that the states were not immune from private suits in federal court by citizens of another

29. See Note, *supra* note 10, at 537. For a discussion of foreign sovereign immunity in the area of intellectual property, see generally Morris, *Sovereign Immunity: The Exception for Intellectual or Industrial Property*, 19 VAND. J. TRANSNAT'L L. 83 (1986).

30. See, e.g., *Hans v. Louisiana*, 134 U.S. 1, 13 (1890) (quoting THE FEDERALIST No. 81 (A. Hamilton)); see also Note, *supra* note 4, at 151.

31. See generally Engdahl, *Immunity and Accountability for Positive Governmental Wrongs*, 44 U. COLO. L. REV. 1, 2-5 (1972); see also Note, *supra* note 10, at 517-18 (discussing evolution of sovereign immunity in societal hierarchy of feudal England).

32. See, e.g., *Employees v. Department of Pub. Health and Welfare*, 411 U.S. 279, 288 (1973) (Marshall, J., concurring); Note, *supra* note 10, at 518.

33. E.g., Wolcher, *Sovereign Immunity and the Supremacy Clause: Damages Against States in Their Own Courts for Constitutional Violations*, 69 CALIF. L. REV. 189, 195 (1981).

34. See, e.g., Note, *Deepening the Anomaly of Sovereign Immunity: Pennhurst State School & Hosp. v. Halderman*, 59 ST. JOHN'S L. REV. 141, 146-47 (1984).

35. U.S. CONST. art. III, § 2, cl. 1.

36. 2 U.S. (2 Dall.) 419 (1793).

state.<sup>37</sup>

The reaction of the states was "loud, angry, and unanimous."<sup>38</sup> Apparently fearing a flood of similar suits seeking repayment of war debts,<sup>39</sup> Congress and the states ratified the eleventh amendment in 1798.<sup>40</sup> While the amendment essentially adopts the states' common law sovereign immunity,<sup>41</sup> the scope of the amendment's immunity provision is limited to the federal courts.<sup>42</sup>

Over the next century and a half, the Supreme Court refined its interpretation of the eleventh amendment. In *Hans v. Louisiana*<sup>43</sup> the Court held that a state's constitutional immunity extends to federal court suits prosecuted by its own citizens.<sup>44</sup> Later, the Court restricted the amendment's purview in *Ex parte Young*,<sup>45</sup> a case in which the Court held that a state official acting under color of state law could be sued in federal court for constitu-

37. *Id.* at 465-66.

38. Comment, *supra* note 10, at 926-27 n.6; see *Edelman v. Jordan*, 415 U.S. 651, 662 (1974) (stating that "[t]he decision in [*Chisholm*] literally shocked the Nation. Sentiment for passage of a constitutional amendment to override the decision rapidly gained momentum").

39. Comment, *supra* note 10, at 926-27 n.6.

40. See, e.g., *Employees*, 411 U.S. at 280.

41. U.S. CONST. amend. XI. *Contra Employees*, 411 U.S. at 290-94 (Marshall, J., concurring) (stating that the eleventh amendment is merely an interpretation of article III); *id.* at 315-22 (Brennan, J., dissenting) (stating that the eleventh amendment merely withdraws a portion of diversity jurisdiction from the federal courts). For the text of the amendment, see *supra* note 3.

42. U.S. CONST. amend. XI; see *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456 (1976); Note, *supra* note 10, at 515-16.

Despite the eleventh amendment's roots in common law sovereign immunity, the distinction between the two doctrines remains critical. While the eleventh amendment generally prohibits suits against states in federal court, the doctrine of sovereign immunity prohibits states from being "sued in [their] own courts without [their] consent, regardless of the nature of the claim." Wolcher, *supra* note 33, at 195; see also Note, *supra* note 10, at 519-20; Comment, *supra* note 10, at 947-49, 955. See generally THE FEDERALIST No. 81, at 416 (A. Hamilton) (J. Cooke ed. 1961) (declaring that "[i]t is inherent in the nature of sovereignty not to be amenable to the suit of an individual *without its consent*") (emphasis in original).

43. 134 U.S. 1 (1890).

44. *Id.* at 21. In *Hans* the plaintiff argued that the eleventh amendment should be read literally to allow suit in federal court against a state by its own citizens. The Court called this "an attempt to strain the Constitution and the law to a construction never imagined or dreamed of." *Id.* at 15.

45. 209 U.S. 123 (1908). *Young* concerned state railroad rate and tariff restrictions that were allegedly confiscatory and, therefore, in violation of the due process clause of the fourteenth amendment. *Id.* at 127-29. In *Young* the plaintiff sought injunctive relief against the Attorney General of Minnesota to prevent the enforcement of an allegedly unconstitutional state statute. *Id.*

tional violations.<sup>46</sup> Despite these modifications, the law remained clear that a state was not amenable to private suit in federal court unless it expressly consented. For example, in *Murray v. Wilson Distilling Co.*<sup>47</sup> the Court held that only express language or an overwhelming implication from the wording of a state statute or constitution would suffice to show a waiver of immunity.<sup>48</sup>

## 2. *Parden v. Terminal Railway* and Progeny—Implied Waiver of Eleventh Amendment Immunity

*Parden v. Terminal Railway*<sup>49</sup> represents an important departure from the Supreme Court's historical analysis of eleventh amendment immunity. For the first time, the Court found a waiver of constitutional immunity implied by a state's actions under a federal statute.<sup>50</sup> In *Parden* employees of a state owned railroad sued the State of Alabama in federal court under the Federal Employees' Liability Act (FELA).<sup>51</sup> The FELA specifically created a cause of action against employers for damages suffered from job-related personal injuries. The railroad employees claimed that the state was liable because, under the FELA, the railroad was a common carrier engaging in interstate commerce and, thus, was amenable to suit in federal court. The state moved to dismiss, arguing that the railway was a state agency<sup>52</sup> and that the state had not

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46. *Id.* at 159-60. The Court adopted the legal fiction that a state official who acts pursuant to an unconstitutional state statute is "stripped of his official or representative character" and, thus, is not protected by the eleventh amendment. *Id.* at 159-60; *see also* *Kentucky v. Graham*, 105 S. Ct. 3099, 3107 n.18 (1985) (holding that "[i]n an injunctive or declaratory action grounded on federal law, the State's immunity can be overcome by naming state officials as defendants") (emphasis in original); *Papasan v. Allain*, 106 S. Ct. 2932, 2940 n.11 (1986) (holding that "[w]hen a state official is sued and held liable in his individual capacity . . . even damages may be awarded") (emphasis in original) (citing *Scheuer v. Rhodes*, 416 U.S. 232, 237-38 (1974)).

47. 213 U.S. 151 (1909).

48. *Id.* at 171. "A federal court may also rely on the decisional law of a state" or a state's "voluntary appearance in a proceeding already properly instituted" to demonstrate an express waiver of eleventh amendment immunity. Comment, *supra* note 10, at 929 n.17 (quoting *Interstate Constr. Co. v. Regents of the Univ. of Idaho*, 199 F. 509 (D. Idaho 1912) (decisional law) and *Gunter v. Atlantic Coast Line R.R.*, 200 U.S. 273, 284 (1906) (voluntary appearance)).

49. 377 U.S. 184 (1964).

50. *Id.* at 192-93.

51. 45 U.S.C. §§ 51-60 (1982).

52. *Parden*, 377 U.S. at 185. The railway consisted "of about 50 miles of railroad tracks in the area adjacent to the State Docks at Mobile . . . . It perform[ed] services for profit under statutory authority . . . . It conduct[ed] substantial operations in interstate commerce." *Id.*

waived its sovereign immunity.<sup>53</sup>

As part of its three-step analysis, the Court first discussed whether Congress, by creating a cause of action under the FELA, intended to subject the states to suit.<sup>54</sup> Reading the language of the statute literally, the Court determined that the phrase "every common carrier by railroad engaged in [interstate] commerce"<sup>55</sup> was broad enough to include state owned railroads as potential defendants. The Court reasoned that absent express language to the contrary, a statutory exception for sovereign immunity should not be presumed.<sup>56</sup> This exception, the Court concluded, would lead to the "pointless and frustrating result" of giving state employees a right without a remedy.<sup>57</sup> Thus, the Court concluded that Congress, by enacting the FELA, intended to subject the states to suits in federal court.

Next, the Court considered whether Congress had the power to subject a state to federal suit notwithstanding the eleventh amendment.<sup>58</sup> The Court determined that in granting Congress the power to regulate interstate commerce, the states had surrendered any part of their sovereign immunity that would impede that regulation.<sup>59</sup> Thus, in exercising its commerce power Congress could override the states' sovereign immunity and render the states amenable to suit under the FELA.<sup>60</sup>

Finally, the Court held that in view of this abrogation of sovereign immunity,<sup>61</sup> the state's subsequent operation of the railroad in interstate commerce implied that Alabama had consented to

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53. *Id.*

54. *Id.* at 187. The Court stated that "[h]ere, for the first time in this Court, a State's claim of immunity against suit by an individual meets a suit brought upon a cause of action expressly created by Congress." *Id.*

55. 45 U.S.C. § 51 (1982). The FELA provides that "[e]very common carrier by railroad while engaging in commerce between any of the several States . . . shall be liable in damages to any person suffering injury while he is employed by such carrier in such commerce." *Id.* The statute further provides that "[u]nder this Chapter an action may be brought in a district court of the United States . . ." *Id.* § 56.

56. *Parden*, 377 U.S. at 190. The Court also looked to the legislative history of the FELA, which stated that the statute was "intended . . . to cover all commerce to which the regulative power of Congress extends." *Id.* at 187-88 n.5 (quoting H.R. REP. No. 1386, 60th Cong., 1st Sess. 1 (1908)).

57. *Parden*, 377 U.S. at 190. "It would be . . . surprising to learn that the FELA does make the [railway] 'liable' to petitioners, but, unfortunately, provides no means by which that liability may be enforced." *Id.* at 197.

58. *Id.* at 190.

59. *Id.*; see Comment, *supra* note 10, at 929-30.

60. *Parden*, 377 U.S. at 191-92.

61. *Id.* at 192.

suit in federal court under the FELA.<sup>62</sup> Congress, the Court declared, conditioned the state's right to operate the railroad upon subjection to the commerce power and consent to suits in federal court.<sup>63</sup> The Court concluded that "when a State leaves the sphere that is exclusively its own and enters into activities subject to congressional regulation, it subjects itself to that regulation as fully as if it were a private person or corporation."<sup>64</sup> While the state argued that its constitution and decisional law did not evidence consent to suit in this case, the Court held that the implied waiver issue was a question of federal, not state, law.<sup>65</sup> Accordingly, the Court held that Congress could condition entry into a federally regulated activity upon a state's amenability to suit in federal court.

Later Supreme Court cases have limited the *Parden* implied waiver doctrine. In *Employees v. Department of Public Health and Welfare*<sup>66</sup> state health facility employees sued the State of Missouri for overtime pay and damages under the Fair Labor Standards Act of 1938 (FLSA).<sup>67</sup> Although the Court concluded that the class of potential defendants, defined in the FLSA as "any employer,"<sup>68</sup> includes states and their agencies,<sup>69</sup> the Court found no congressional intent to subject states to suit in federal court.<sup>70</sup> The Court reasoned that the FLSA authorized suit only in courts

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62. *Id.* The Court stated, "Alabama, when it began operation of an interstate railroad approximately 20 years after enactment of the FELA, necessarily consented to such suit as was authorized by that Act." *Id.*

63. *Id.* The State of Alabama argued that because Congress could not directly remove the states' sovereign immunity, it would be unconstitutional for Congress to impose a condition of amenability to federal suit on the states' entry into interstate commerce. *Id.* at 193 n.11. The Court, however, distinguished *Parden* from the cases cited by the State of Alabama in its "unconstitutional condition" argument, noting that, unlike those cases, *Parden* involved a legitimate exercise of legislative power. *Id.*

64. *Id.* at 196. While not expressly mentioning the distinction between "proprietary" and "governmental" activities of the state, the Court, in dictum, noted that "[s]tates have entered . . . numerous forms of activity which, if carried on by a private person or corporation, would be subject to federal regulation." *Id.* at 196-97. The governmental-proprietary distinction implied by this language has since been abandoned by the Court. *See Garcia v. San Antonio Metropolitan Transit Auth.*, 469 U.S. 528, 537-47 (1985) (overruling *National League of Cities v. Usery*, 426 U.S. 833 (1976)).

65. *Parden*, 377 U.S. at 196.

66. 411 U.S. 279 (1973).

67. 52 Stat. 1069 (codified as amended at 29 U.S.C. §§ 201-19 (1982)).

68. 29 U.S.C. § 216(b) (1982).

69. *Employees*, 411 U.S. at 282-83. Although the FLSA originally had defined "employer" to exclude the states and their political subdivisions, Congress in 1966 expanded the statute to cover "employees of a State, or a political subdivision thereof, employed . . . in a hospital [or] institution." Fair Labor Standards Amendments of 1966, Pub. L. No. 89-601, § 102(b), 80 Stat. 830, 831 (codified as amended at 29 U.S.C. § 203(d) (1982)).

70. *Employees*, 411 U.S. at 285.

of competent jurisdiction; the eleventh amendment, however, rendered federal courts incompetent to deliver a judgment against nonconsenting states.<sup>71</sup> Thus, while reaffirming its *Parden* decision, which held that Congress has the power to subject arguably non-consenting states to suit in federal court, the *Employees* Court distinguished *Parden*, indicating that the "exercise of such power would not be presumed without clear evidence" of congressional intent.<sup>72</sup> Absent clear congressional intent, federal suit by the private parties in *Employees* was barred.<sup>73</sup>

The Supreme Court continued to limit the doctrine of implied waiver of eleventh amendment immunity in *Edelman v. Jordan*.<sup>74</sup> In *Edelman* Illinois state officials allegedly withheld benefits under Aid to the Aged, Blind, or Disabled (AABD),<sup>75</sup> a public aid program authorized under the Social Security Act and funded by the state and federal governments. The *Edelman* Court first noted that, unlike the statutes in *Parden* and *Employees*, the AABD had not created a private cause of action for aggrieved beneficiaries. Absent a statutory cause of action evidencing congressional intent, the Court held that the doctrine of implied waiver would not be available against a state. Furthermore, the Court held that a waiver of eleventh amendment immunity would be found only when a state indicated consent to a suit in federal court "by the most express language or by such overwhelming implications . . . as [will] leave no room for any other reasonable construction."<sup>76</sup> Reasoning that a state's mere operation of a federally assisted aid program was not a "clear declaration" of consent to federal court suit,<sup>77</sup> the Court concluded that Congress had not intended to ab-

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71. *Id.* at 283-84; see 29 U.S.C. § 216(b) (1982).

72. L. TRIBE, *AMERICAN CONSTITUTIONAL LAW* § 3-36, at 135 (1978). The Court additionally noted that the FLSA allowed successful plaintiffs double recovery, *Employees*, 411 U.S. at 286, and stated that "we are reluctant to believe that Congress in pursuit of a harmonious federalism desired to treat the States so harshly," *Id.*

73. The Court's holding, however, did not leave the employees a right without a remedy. The Court noted that the FLSA authorized the Secretary of Labor to sue, on behalf of employees, states violating the statute. *Employees*, 411 U.S. at 285-86. In addition, the Court suggested that "[a]rguably, [the FLSA] permits suit in the [state] courts." *Id.* at 287.

74. 415 U.S. 651 (1974).

75. 42 U.S.C. §§ 1381-83 (1982 & Supp. I 1983). While the plaintiff-applicants sought only declaratory and injunctive relief, the federal district court, in addition to granting their request, ordered the State of Illinois to "release and remit AABD benefits wrongfully withheld to all applicants." *Edelman*, 415 U.S. at 656.

76. *Edelman*, 415 U.S. at 673 (quoting *Murray v. Wilson Distilling Co.*, 213 U.S. 151, 171 (1909)). The *Edelman* Court used the term "constructive," instead of implied, consent.

77. *Id.* The Court noted that "the mere fact that a State participates in a program through which the Federal Government provides assistance for the operation by the State of

rogate the state's constitutional immunity.<sup>78</sup> Under *Edelman*, therefore, without an express federal cause of action, a state will not be found to have impliedly waived its eleventh amendment immunity. The Court, however, held that while the eleventh amendment prohibits "retroactive" monetary relief against state officials, as ordered by the federal district court, the amendment does not preclude "prospective" relief in the form of an injunction against state officials to bar future unconstitutional conduct.<sup>79</sup>

### 3. *Fitzpatrick v. Bitzer* and Later Cases—Congressional Abrogation of Eleventh Amendment Immunity

Twelve years after *Parden* the Supreme Court again substantially reduced the states' eleventh amendment protection. In *Fitzpatrick v. Bitzer*<sup>80</sup> the Court ruled for the first time that state waiver is not always required to abrogate eleventh amendment immunity. In *Fitzpatrick* Connecticut state employees sued the state in federal court, claiming sexual discrimination in violation of Title VII of the Civil Rights Act of 1964 (Title VII),<sup>81</sup> which authorizes the award of damages and attorney's fees to private parties.<sup>82</sup> Because Title VII specifies governments, governmental agencies, and

a system of public aid is not sufficient to establish consent on the part of the State to be sued in the federal courts." *Id.*

78. *Id.* at 672-74.

79. *Id.* at 664-71. Thus, the Court limited the *Young* doctrine to private suits seeking injunctive, but not monetary, relief against state officials. *See supra* notes 45-46 and accompanying text. The Court reasoned that restitution would not come from the defendant-officials, but rather from state funds—a result prohibited by the eleventh amendment. *Id.* at 677 (citing *Ford Motor Co. v. Department of Treasury*, 323 U.S. 459 (1945)). The eleventh amendment generally continues to bar suit against a state or its agencies regardless of the type of relief sought. *See, e.g., Alabama v. Pugh*, 438 U.S. 781, 782 (1978) (per curiam). The *Edelman* Court, in dictum, stated that 42 U.S.C. § 1983 (1982), which authorizes suit against state officials for deprivation of civil rights, does not evince a congressional intent to abrogate a state's eleventh amendment immunity. Thus, under this reading even in a suit brought under § 1983, the claimant cannot seek retroactive relief against a state official if damages would be paid from public funds. *Edelman*, 415 U.S. at 674-77; *see also Quern v. Jordan*, 440 U.S. 332, 338 (1979); *cf. Monell v. Department of Social Servs.*, 436 U.S. 658 (1978) (holding that the class of potential § 1983 defendants includes municipalities); *Alabama v. Pugh*, 438 U.S. 781, 781-82 (1978) (per curiam). *But see Hutto v. Finney*, 437 U.S. at 678, 703 (1978) (Brennan, J. concurring) (stating that it is "surely at least an open question whether § 1983 . . . does not make the States liable for relief of all kinds, notwithstanding the Eleventh Amendment").

80. 427 U.S. 445 (1976).

81. 78 Stat. 253 (codified as amended at 42 U.S.C. §§ 2000e to 20000e-17 (1982)). Title VII provides that employers are liable for damages to employees subjected to discriminatory hiring practices based on race, color, or national origin. 42 U.S.C. § 2000e-2(a) (1982).

82. 42 U.S.C. § 2000e-5(g), (k) (1982).

political subdivisions as possible defendants,<sup>83</sup> the Court found that Congress clearly intended to authorize federal courts to award damages in private suits against the states.<sup>84</sup> Significantly, the Court did not examine whether the state had waived its eleventh amendment immunity.<sup>85</sup> Noting that Congress had passed Title VII under section 5 of the fourteenth amendment, the Court stated:

When Congress acts pursuant to § 5 [of the Fourteenth Amendment] it is exercising that authority under one section of a constitutional Amendment whose other sections by their own terms embody limitations on state authority. We think that Congress may, in determining what is "appropriate legislation" for the purpose of enforcing the provisions of the Fourteenth Amendment, provide for private suits against States or State officials which are constitutionally impermissible in other contexts.<sup>86</sup>

Thus, the Court effectively held that Congress could, if it clearly so intended, unilaterally nullify eleventh amendment immunity without a state's consent, express or implied.<sup>87</sup> While condoning the effective nullification of a constitutional amendment's protection by congressional compulsion, the Court restricted the application of its holding to legislation passed pursuant to the "limited authority" of the fourteenth amendment.<sup>88</sup>

In *Hutto v. Finney*,<sup>89</sup> which concerned a different statute passed under Congress' fourteenth amendment power, the Supreme Court reaffirmed and expanded its *Fitzpatrick* holding. In *Hutto* Arkansas prison inmates brought an action against state officials to correct unconstitutional conditions in the Arkansas prison system. A federal circuit court of appeals, in affirming the district court's remedial orders, assessed attorney's fees under the Civil Rights Attorney's Fees Awards Act of 1976 (Attorney's Fees Act)<sup>90</sup> to cover the cost of services on appeal. The Supreme Court held that a plaintiff could recover attorney's fees in a civil rights case against the state even though the Attorney's Fees Act did not ex-

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83. The Equal Employment Opportunity Act of 1972, 86 Stat. 103, amended Title VII to include states and their governmental subdivisions. See 42 U.S.C. § 2000e-2(a) (1982).

84. *Fitzpatrick*, 427 U.S. at 448-49.

85. Note, *supra* note 10, at 524.

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

87. See *Atascadero State Hosp. v. Scanlon*, 105 S. Ct. 3142, 3145 (1985).

88. *Fitzpatrick*, 427 U.S. at 455 (quoting *Ex parte Virginia*, 100 U.S. 339, 346-48 (1880)).

89. 437 U.S. 678 (1978).

90. *Id.* at 685; see 42 U.S.C. § 1988 (1982). The Attorney's Fees Act "declares that in suits under 42 U.S.C. § 1983 and certain other statutes, federal courts may award prevailing parties reasonable attorney's fees 'as part of the costs.'" *Hutto*, 437 U.S. at 693.

pressly include states in the defendant class.<sup>91</sup> The Court found that the legislative history of the statute clearly indicated Congress' intention to subject the states to suit under the Attorney's Fees Act.<sup>92</sup> In addition, the Court noted that the Attorney's Fees Act allowed the award of attorney's fees as "costs," which are not subject to eleventh amendment immunity.<sup>93</sup> The *Hutto* court, therefore, extended *Fitzpatrick* by finding clear evidence of congressional intent, not in the statute's language but in its legislative history, to nullify eleventh amendment immunity.<sup>94</sup>

Significantly, lower federal courts<sup>95</sup> have cited *Fitzpatrick* in various nonfourteenth amendment cases to find clear congressional intent to abrogate eleventh amendment immunity.<sup>96</sup> For example, in *Peel v. Florida Department of Transportation*<sup>97</sup> the United States Court of Appeals for the Fifth Circuit held that Congress, acting under its article I war power,<sup>98</sup> statutorily could nullify elev-

91. *Hutto*, 437 U.S. at 696-97.

92. *Id.* at 700; see S. REP. No. 1011, 94th Cong., 2d Sess. 5 (1976) (stating that "it is intended that attorney's fees . . . will be collected either . . . from funds of [the official's] agency . . . or from the state or local government"); H.R. REP. No. 1558, 94th Cong., 2d Sess. 7 (1976).

Citing *Fitzpatrick*, the Court reaffirmed that "Congress has plenary power to set aside the States' immunity from retroactive relief in order to enforce the Fourteenth Amendment. When it passed the [Attorney's Fees] Act, Congress undoubtedly intended . . . to authorize fee awards payable by the States when their officials are sued in their official capacities." *Hutto*, 437 U.S. at 693-94.

93. *Hutto*, 437 U.S. at 695.

94. However, the Court's willingness to find congressional intent to abrogate a state's constitutional immunity in a statute's legislative history may be limited to the facts of *Hutto*. In *Atascadero* the Court reiterated that the "statutory language" in question must express an "unmistakable intent" to support a finding of abrogation of eleventh amendment immunity pursuant to Congress' fourteenth amendment power. *Atascadero*, 105 S. Ct. at 3142, 3148; see *infra* notes 110-21 and accompanying text.

95. See *supra* note 18 and accompanying text.

96. See, e.g., *Oneida Indian Nation v. New York*, 520 F. Supp. 1278, 1308 (N.D.N.Y. 1981) (holding that "consent of the State is not required when Congress acts pursuant to its Article I powers").

97. 600 F.2d 1070 (5th Cir. 1979).

98. U.S. CONST. art. I, § 8 provides, in part:

The Congress shall have Power To . . . provide for the common Defense and general Welfare of the United States; . . .

. . . .

To declare War, . . .

To raise and support Armies, . . .

To provide and maintain a Navy;

To make Rules for the Government and Regulation of the land and naval Forces;

. . . .

. . . .

To provide for organizing, arming, and disciplining the Militia, and for governing

enth amendment protection without the state's consent.<sup>99</sup> The court reasoned that, in theory, a state consents to private suit in federal court whenever Congress sufficiently shows an intent to nullify immunity.<sup>100</sup> The court concluded that "[t]his rationale removes the eleventh amendment as a bar whenever Congress validly has exercised its powers."<sup>101</sup> Thus, the court affirmed the district court order reinstating the employee and compensating him for lost wages and benefits.<sup>102</sup>

The dramatic expansion of the Supreme Court's *Fitzpatrick* holding<sup>103</sup> has been characterized by the *Peel* court as the "*sub silentio* merging of the separate state consent requirement into the single inquiry of whether Congress has statutorily waived the state's immunity."<sup>104</sup> In *County of Oneida v. Oneida Indian Nation*<sup>105</sup> the Supreme Court noted that the only argument offered to enforce the state's amenability to federal suit was that "the States necessarily consented to suit in federal court with respect to enactments under [the Commerce] Clause."<sup>106</sup> Thus, the counties argued that the state waived its immunity to suit in federal court merely

such Part of them as may he employed in the Service of the United States, . . .

. . . .

To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers . . . .

U.S. CONST. art. I, § 8.

99. In *Peel* a Florida state employee, discharged because he was absent from work during National Guard training, sued the agency for which he had worked, seeking reemployment and lost wages and benefits. The plaintiff sued under the Veterans' Reemployment Rights Act, 38 U.S.C. §§ 2021-26 (1982), which was passed pursuant to the war powers of Congress and which authorized federal court suits to enforce reemployment rights. *Peel*, 600 F.2d at 1072-73.

100. *Peel*, 600 F.2d at 1080. "[N]othing in the history of the eleventh amendment . . . indicates that Congress, when acting under an article I, section 8 delegated power, lacks the authority to provide for federal court enforcement of private damage actions against the states." *Id.*

101. *Id.* The court stated that under this rationale the eleventh amendment remains effective merely as a "check on the judicial power to imply private damage remedies against the states" when congressional intent is not evidenced sufficiently. *Id.* at 1081.

102. *Id.* at 1073.

103. See, e.g., *County of Oneida v. Oneida Indian Nation*, 470 U.S. 226 (1985) (citing *County of Monroe v. Florida*, 678 F.2d 1124 (2d Cir. 1982), *cert. denied*, 459 U.S. 1104 (1983) and *Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979)).

104. *Peel*, 600 F.2d at 1080.

105. *County of Oneida*, 470 U.S. 226 (1985). In *County of Oneida* Indian tribes sued New York counties under the Nonintercourse Act of 1793 (codified as amended at 25 U.S.C. § 177 (1982)), which provided that no person or entity could buy Indian land without approval by the federal government. The counties, held liable for damages in connection with illegal land purchases, were granted indemnification from the State of New York by the federal district court. *County of Oneida*, 105 S. Ct. at 1249.

106. *County of Oneida*, 105 S. Ct. at 252.

by violating a statute passed pursuant to the commerce power of Congress.<sup>107</sup> Although in *Fitzpatrick* the Court limited its holding to fourteenth amendment enactments,<sup>108</sup> in *County of Oneida* the Court chose not to decide whether the lower courts' expanded readings had gone too far.<sup>109</sup>

The Supreme Court, however, recently clarified its position on eleventh amendment immunity in *Atascadero State Hospital v. Scanlon*.<sup>110</sup> In *Atascadero* the disabled respondent,<sup>111</sup> seeking damages for alleged employment discrimination, sued a state hospital in federal court under the Rehabilitation Act of 1973.<sup>112</sup> The Court held that the eleventh amendment barred recovery from the state<sup>113</sup> even though the statute, passed pursuant to section 5 of the fourteenth amendment, provided for remedies against "any recipient of Federal assistance,"<sup>114</sup> a class that arguably includes the state.<sup>115</sup> The Court ruled that a "general authorization for suit in federal court is not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment."<sup>116</sup> The Court noted that Congress must specifically include the states within the defendant class when intending to subject the states to suit in federal court.<sup>117</sup> The Court also held that the state's mere participation in a federally funded program under the statute did not demonstrate implicit consent to federal jurisdiction. Instead, the Court required "an unequivocal indication" that the state consented to federal jurisdiction.<sup>118</sup>

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107. *Id.*

108. See *supra* text accompanying note 86.

109. "[The counties] contend [that] Congress can abrogate the States' Eleventh Amendment immunity and has done so by enacting the Nonintercourse Acts . . . Assuming without deciding that this reasoning is correct, it does not address the Eleventh Amendment problem here." *County of Oneida*, 470 U.S. at 252.

110. 105 S. Ct. 3142 (1985).

111. Respondent also sought injunctive and declaratory relief. *Atascadero*, 105 S. Ct. at 3144.

112. 87 Stat. 394 (codified as amended at 29 U.S.C. §§ 701-796i (1982)). The Rehabilitation Act provides that "[n]o otherwise qualified handicapped individual . . . shall, solely by reason of his handicap, . . . be subjected to discrimination under any program or activity receiving Federal financial assistance." 29 U.S.C. § 794 (1982).

113. *Atascadero*, 105 S. Ct. at 3150.

114. *Id.* at 3149 (emphasis added by Court) (quoting 29 U.S.C. § 794a (1982)).

115. *Atascadero*, 105 S. Ct. at 3149.

116. *Id.* at 3149. In support of this ruling, the Court noted that "given their constitutional role, the States are not like any other class of recipients of federal aid." *Id.*

117. *Id.* The Court stated that congressional intent to abrogate eleventh amendment immunity pursuant to § 5 of the fourteenth amendment must be "unmistakably clear in the language of the statute." *Id.* at 3147.

118. *Id.* at 3145 n.1 (emphasis added). "The court [of appeals] erred . . . in concluding

In *Atascadero* the Supreme Court restricted its *Fitzpatrick* holding<sup>119</sup> in two important ways. First, the Court reiterated that *Fitzpatrick* held that Congress' augmented power to unilaterally abrogate eleventh amendment immunity without the states' consent was limited to statutes passed pursuant to section 5 of the fourteenth amendment.<sup>120</sup> Second, the Court held that a congressional intent to limit eleventh amendment protection was not evident when Congress generally authorized federal suit against "any recipient of Federal assistance"<sup>121</sup> instead of specifically including states as potential defendants. Thus, absent clear congressional intent, a state's constitutional immunity cannot be abrogated. These statements are the Supreme Court's most current stance on the doctrine of implied waiver of eleventh amendment immunity.

*B. Copyright Protection and the Eleventh Amendment—  
The Circuit Court Split*

The circuit court split over the proper relationship between copyright protection and the eleventh amendment developed because of different interpretations of the 1909 Copyright Act (the 1909 Act).<sup>122</sup> Pursuant to the copyright and patent clause, section 1 of the 1909 Act grants copyright proprietors the "exclusive right," among other things, to "print, reprint, publish, copy, and vend the copyrighted work" and to "perform the copyrighted work publicly for profit if it be a musical composition."<sup>123</sup> The 1909 Act further provides that "any person" who infringes the copyright in "any work" is subject to injunction and liable for damages, illegally

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that . . . a State necessarily consents to suit in federal court by participating in programs funded under the [Rehabilitation Act]." *Id.* at 3150.

In his dissent, Justice Brennan stated that the purpose of the eleventh amendment is to preserve the states' immunity from federal court jurisdiction only in diversity suits and not to bar suits based on a federal question. *Atascadero*, 105 S. Ct. at 3177 (Brennan, J., dissenting). Justice Brennan's dissent included an extensive historical review of eleventh amendment jurisprudence. *See id.* at 3150-78. This narrow reading of the eleventh amendment, which would allow copyright suits against states in federal court, has not been accepted by a majority of the Supreme Court.

119. *See supra* notes 80-88 and accompanying text.

120. *Atascadero*, 105 S. Ct. at 3145.

121. *Id.* at 3149. Significantly, the *Atascadero* Court changed the focus of its inquiry from a determination of whether the statutory defendant class was broad enough to include states, *see, e.g.*, *Parden v. Terminal Ry.*, 377 U.S. 184, 187-90 (1964); *see also supra* notes 49-65 and accompanying text, to a determination of whether the state had been included specifically in the defendant class.

122. 17 U.S.C. §§ 1-216 (1976); *see supra* note 6.

123. 17 U.S.C. § 1 (1976).

earned profits, court costs, and attorney's fees.<sup>124</sup>

### 1. *Wihtol v. Crow*

In *Wihtol v. Crow*<sup>125</sup> the United States Court of Appeals for the Eighth Circuit became the first circuit court to consider whether a state instrumentality could be subjected to federal jurisdiction for alleged copyright infringement. The appellant, a composer who alleged that the choral director of an Iowa junior college and high school copied and rearranged his copyrighted song without permission, sued the director and his employer, the local school district.<sup>126</sup> On appeal from the district court's dismissal of the complaint,<sup>127</sup> the school district argued that it could not be held liable for the actions of an agent acting in a governmental capacity.<sup>128</sup>

The Eighth Circuit held that the eleventh amendment's bar to federal court suits against the states deprived the district court of jurisdiction to hear the case against the school district.<sup>129</sup> The court reasoned that the school district, as part of the state's educational system, was a state instrumentality engaged in performing a state governmental function under state law and at state expense.<sup>130</sup> Because any potential damage judgment would be payable out of state funds, the federal court could not exercise jurisdiction without the state's consent.<sup>131</sup> Thus, while the court found that the choir director infringed the composer's rights in the song, the court held that the school district was entitled to dismissal of the action for lack of jurisdiction.<sup>132</sup>

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124. *Id.* §§ 101, 116.

125. 309 F.2d 777 (8th Cir. 1962).

126. The unauthorized arrangement of the song was performed once by the school choir. *Id.* at 778-79.

127. *See Wihtol v. Crow*, 199 F. Supp. 682 (1961). The federal district court held that the choir director's use of the song was a noninfringing "fair use." *Wihtol*, 309 F.2d at 780. *See generally supra* note 23. The district court, however, further held that regardless of whether the use was "fair," the school district could not be held liable for copyright infringement. *Wihtol*, 309 F.2d at 780.

128. *Wihtol*, 309 F.2d at 778-79.

129. *Id.* at 781-82. "Whether the School District can be subjected to liability for the copyright infringement . . . is a debatable question. A suit against the State of Iowa, for the infringement of a copyright, clearly could not be maintained, because of the Eleventh Amendment . . ." *Id.* at 781.

130. *Id.* at 782. *But see infra* note 207.

131. *See Wihtol*, 309 F.2d at 781-82.

132. In addition, a church at which the choir director also worked and whose choir performed the unauthorized song was found liable under the doctrine of respondeat superior. *Id.* at 783.

Because the *Wihtol* opinion was rendered prior to *Parden v. Terminal Ry.*, 377 U.S. 184

2. *Mills Music, Inc. v. Arizona*

Seventeen years after the *Wihtol* decision the United States Court of Appeals for the Ninth Circuit reconsidered the issue of eleventh amendment immunity in copyright suits. In *Mills Music, Inc. v. Arizona*<sup>133</sup> a music publisher sued the State of Arizona in federal court for the willful infringement of a copyrighted musical composition, which the state allegedly used as the theme song for a state fair promotion.<sup>134</sup> Appealing from the district court's judgment for the publisher, the state argued that the eleventh amendment did not allow the award of damages or attorney's fees.<sup>135</sup> The publisher, however, claimed that the state waived its eleventh amendment immunity through its voluntary participation in a federally regulated activity and through "constitutional subordination of sovereignty."<sup>136</sup>

The Ninth Circuit, citing *Parden v. Terminal Railway*,<sup>137</sup> *Employees v. Department of Public Health and Welfare*,<sup>138</sup> and *Edelman v. Jordan*,<sup>139</sup> enunciated a test for determining whether a state had consented to suit. The court found that a state waives its eleventh amendment immunity "when Congress has authorized suit against a class of defendants that includes states, and the state enters into the activity regulated by federal law."<sup>140</sup> The court first determined that Congress had intended that the states be amenable to suit in the federal courts for copyright infringement. Noting that the 1909 Act defined the class of potential defendants as "any person" who infringes a copyright, the court reasoned that this broad language, "sweeping and without apparent limitation, suggest[s] that Congress intended to include states."<sup>141</sup> Second, the

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(1964), the decision did not discuss the issue of the school district's possible implied consent and did not consider the availability of injunctive relief.

133. 591 F.2d 1278 (9th Cir. 1979).

134. The plaintiff, who sued the State of Arizona and the Arizona Coliseum and Exposition Center Board, a state agency, also alleged unfair competition. *Id.* at 1280-81.

135. *Id.* at 1280. The district court found that the defendants made 64 tapes and broadcast 3,928 radio and television performances of an unauthorized arrangement of the composition. The district court rejected the defendants' argument that, under § 1(e) of the 1909 Act, their use was not for profit and, thus, did not constitute infringement. *Id.* at 1281.

136. *Id.* at 1283. The court initially determined that the defendants had not consented to federal court suit merely because they admitted the district court's jurisdiction and failed to interpose their eleventh amendment defense until after trial. *Id.* at 1282.

137. 377 U.S. 184 (1964); see *supra* notes 49-65 and accompanying text.

138. 411 U.S. 279 (1973); see *supra* notes 66-73 and accompanying text.

139. 415 U.S. 651 (1974); see *supra* notes 74-79 and accompanying text.

140. *Mills Music*, 591 F.2d at 1283.

141. *Id.* at 1284-85. The court noted that "[e]ven the United States is liable for the

court held that the state voluntarily engaged in the federally regulated commercial activity of copyright use,<sup>142</sup> thus fulfilling the second requirement for waiver of eleventh amendment sovereign immunity.

The court next explored the issue of whether the eleventh amendment was subordinate constitutionally to the copyright and patent clause. Citing *Fitzpatrick v. Bitzer*,<sup>143</sup> the court held that the copyright and patent clause empowered Congress to subject infringing states to suits in federal court despite the eleventh amendment.<sup>144</sup> The court decided that the abrogation of a state's eleventh amendment immunity clearly is inherent in the copyright and patent clause and the 1909 Act.<sup>145</sup> The court reasoned that when "Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach."<sup>146</sup> Finding the state amenable to suit in federal court, the *Mills Music* court affirmed the district court's award of damages and attorney's fees. The court acknowledged that its decision was contrary to the Eighth Circuit's holding in *Wihtol*,<sup>147</sup> but nevertheless concluded that a "state may not, consistent with the Constitution, infringe the federally protected rights of the copyright holder, and thereafter avoid the federal system of statutory protections."<sup>148</sup>

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infringement of a copyright . . .; to hold that Congress did not intend to include states within the class of defendants would lead to an anomalous construction of the statute at best." The court reasoned further that "the Copyright and Patent Clause is a specific grant of constitutional power that contains inherent limitations on state sovereignty." *Id.* at 1285.

142. *Id.* at 1286.

143. 427 U.S. 445 (1976); see *supra* notes 80-88 and accompanying text.

144. *Mills Music*, 591 F.2d at 1283, 1285-86.

145. *Id.* at 1285.

146. *Id.* (quoting *Goldstein v. California*, 412 U.S. 546, 560 (1973) (emphasis added)). Significantly, *Goldstein*, on which the court's subordination analysis relied heavily, did not concern copyright infringement but, instead, concerned federal preemption in the copyright field. In *Goldstein* the Supreme Court upheld a state criminal statute despite a preemption objection.

147. *Mills Music*, 591 F.2d at 1286.

148. *Id.* The court noted: "[T]he Eleventh Amendment's sovereign immunity does not permit a state to nullify [copyrights]." *Id.*

Additionally, the United States Court of Appeals for the Eleventh Circuit recently affirmed a federal district court's finding of eleventh amendment immunity from a copyright infringement suit. See *Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc.*, No. 83-1038-Civ.-T-13, slip op. (M.D. Fla. Sept. 6, 1985), *aff'd*, No. 86-3354 (11th Cir. Jan. 27, 1987) (per curiam); *infra* notes 196-205 and accompanying text.

## III. RECENT DEVELOPMENTS

Following *Mills Music* the conflict in the federal courts between the protection of copyright proprietors and the states' constitutional immunity did not reemerge for five years.<sup>149</sup> Recently, however, a federal circuit court of appeals and five federal district courts have rekindled the controversy with decisions on both sides of the issue.

A. *Mihalek Corp. v. Michigan*

In *Mihalek Corp. v. Michigan*<sup>150</sup> the plaintiff sued the state for copyright infringement under the 1909 Act, seeking damages and injunctive relief.<sup>151</sup> The plaintiff claimed that the state's agents misappropriated his copyrighted materials and used them for a promotional campaign to encourage travel and investment in Michigan.<sup>152</sup> The state claimed immunity under the eleventh

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149. A similar split has developed between federal district courts concerning patent infringement by the states. *Compare* *Lemelson v. Ampex Corp.*, 372 F. Supp. 708 (N.D. Ill. 1974) (holding that the eleventh amendment does not bar an award of money damages against a state agency in federal court for patent infringement) *with* *Hercules, Inc. v. Minnesota State Highway Dep't*, 337 F. Supp. 795 (D. Minn. 1972) (holding that a state agency, although subject to injunction, is immune, under the eleventh amendment, from federal court suit seeking money damages for patent infringement).

In *Association of Am. Medical Colleges v. Carey*, 432 F. Supp. 1358 (N.D.N.Y. 1980), the court, citing *Ex parte Young*, 209 U.S. 123 (1908), held that the eleventh amendment did not bar a preliminary injunction against copyright infringement by state officials. See *supra* notes 45-46 and accompanying text. Following *Mills Music* at least three state attorneys general opined that states can be held liable for copyright infringement. See W. PATRY, *supra* note 14, at 272 n.70.

150. 595 F. Supp. 903 (E.D. Mich. 1984), *appeal docketed*, No. 85-1593 (6th Cir. July 23, 1985).

The United States Circuit Court of Appeals for the Sixth Circuit faced the issue of copyright infringement by state officials almost ninety years ago in *Howell v. Miller*, 91 F. 129 (6th Cir. 1898). Although the court refused on other grounds to grant an injunction, it ruled that the eleventh amendment does not bar a federal court suit seeking injunctive relief to prevent infringement by officers and agents of a state. The *Howell* plaintiff did not seek money damages.

151. The defendants were the State of Michigan, the Michigan Department of Commerce and its director, and the governor. In addition to copyright infringement, the plaintiff also brought pendant state claims for unfair competition and misappropriation of work product, as well as claims for violation of trademark and 42 U.S.C. § 1983 (1982) (allowing private damages suit for civil rights deprivations "under color of law"). *Mihalek*, 595 F. Supp. at 904. In *Quern v. Jordan*, 440 U.S. 332, 342 (1979), the Supreme Court held that 42 U.S.C. § 1983 does not abrogate eleventh amendment immunity.

152. "Plaintiff alleges that he entered into agreements with agents of the state of Michigan for creation of [the promotional campaign]. He showed the materials to these people while the work was in progress, and the agents allegedly appropriated the designs for their own use . . ." *Mihalek*, 595 F. Supp. at 904.

amendment.<sup>153</sup>

Noting the earlier circuit court split, the United States District Court for the Eastern District of Michigan rejected the *Mills Music*<sup>154</sup> rationale, which concluded that the 1909 Act had abrogated the states' eleventh amendment immunity, and held that the state was immune from suit in federal court.<sup>155</sup> Relying on *Edelman v. Jordan*,<sup>156</sup> the court first noted that although the copyright and patent clause exhibits a clear federal interest in the area of copyright, the 1909 Act, not the copyright and patent clause, afforded specific protection against infringement.<sup>157</sup> The court concluded that a right against infringement, although guaranteed by federal law, "is deserving of no more protection than is the right to benefits for the aged, blind, and disabled," for which the Supreme Court denied "retroactive" monetary relief in *Edelman*.<sup>158</sup>

The *Mihalek* court held that despite federal statutory copyright protection, the eleventh amendment bars federal jurisdiction to award damages that would be paid out of state funds.<sup>159</sup> Thus, the defendants were immune from the plaintiff's request for monetary damages. Although the state was totally immune from suit, the court acknowledged that under *Ex parte Young*<sup>160</sup> the plaintiff could seek an injunction against future infringement by state agents.<sup>161</sup>

#### B. Johnson v. University of Virginia

*Johnson v. University of Virginia*<sup>162</sup> was the first eleventh amendment case decided under the revised Copyright Act of 1976

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153. The defendants moved to dismiss, arguing that although individual state officials were named in the suit, the action was against the state. *Id.* at 904-05. In addition, the defendants moved for a change of venue, which the court denied. *Id.* at 906-07.

154. See *supra* notes 133-48 and accompanying text. The plaintiffs responded to the defendants' motion to dismiss by arguing that, under *Mills Music*, the eleventh amendment did not bar federal copyright suits against states or state officials. *Mihalek*, 595 F. Supp. at 905.

155. *Mihalek*, 595 F. Supp. at 905-06.

156. 415 U.S. 651 (1974); see *supra* notes 74-79 and accompanying text.

157. *Mihalek*, 595 F. Supp. at 906.

158. *Id.*; see *Edelman*, 415 U.S. at 669.

159. *Mihalek*, 595 F. Supp. at 906. Citing *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89 (1984), the court ruled that the eleventh amendment also bars injunctive relief against state officials in federal court for claims based on state law. *Mihalek*, 595 F. Supp. at 906.

160. 209 U.S. 123 (1908); see *supra* notes 45-46 and accompanying text.

161. *Mihalek*, 595 F. Supp. at 906.

162. 606 F. Supp. 321 (W.D. Va. 1985).

(the 1976 Act).<sup>163</sup> The 1976 Act provides that "anyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright;"<sup>164</sup> liable for damages, profits, costs, and attorney's fees; and subject to injunction.<sup>165</sup> Under the 1976 Act, the copyright proprietor has the exclusive right to reproduce, distribute, perform, display publicly, and prepare derivations of the protected work.<sup>166</sup> One important purpose for this revision of the 1909 Act was to allow Congress to exercise more fully its powers under the copyright and patent clause.<sup>167</sup> Thus, for example, the 1976 Act expressly preempts state law copyright protection for federally protected subject matter<sup>168</sup> and extends protection to all "original works of authorship fixed in any tangible medium of expression."<sup>169</sup>

In *Johnson* the plaintiff alleged that the state university and two employees infringed his copyright in photographs taken at the school's sporting events. The plaintiff sought statutory damages and attorney's fees. The defendants, however, argued that the eleventh amendment barred any claim payable out of the state's treasury.<sup>170</sup> Citing *Mills Music*,<sup>171</sup> the United States District for the Western District of Virginia held that the 1909 and 1976 Acts abrogated the state's constitutional immunity under the eleventh amendment.<sup>172</sup>

The court reasoned that under the *Mills Music* court's reading of *Edelman*<sup>173</sup> a federal statute effectively could nullify a state's eleventh amendment protection if Congress' intent was explicit or

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163. 17 U.S.C. §§ 101-914 (1982 & Supp. III 1985); see *supra* notes 5-6 and accompanying text.

164. 17 U.S.C. § 501 (1982 & Supp. II 1984).

165. *Id.* §§ 502, 504, 505.

166. *Id.* § 106.

167. See *id.* § 301 (1982).

168. *Id.* § 301 (a).

169. *Id.* § 102(a); see 17 U.S.C. § 4 (1976) (stating that "[t]he works for which copyright may be secured under this title shall include *all the writings of an author*") (emphasis added).

170. *Johnson*, 606 F. Supp. at 322. The plaintiff also brought a pendant state claim for the alleged loss of photographic slides. The defendants moved for dismissal or summary judgment, arguing that the infringement claim against the university, and its employees derivatively, actually was against the Commonwealth of Virginia. In addition to this eleventh amendment argument, the defendants also alleged that the plaintiff had "not made the requisite showing for . . . damages and fees." *Id.* at 322.

171. 591 F.2d 1278 (9th Cir. 1979); see *supra* notes 133-48 and accompanying text.

172. *Johnson*, 606 F. Supp. at 324.

173. 415 U.S. 651 (1974); see *supra* notes 74-79 and accompanying text.

overwhelmingly apparent.<sup>174</sup> The court first noted *Mills Music's* holding that the class of potential defendants, defined in the 1909 Act as "any person [who infringes]," was broad enough to evidence an intent to include the states.<sup>175</sup> Turning next to the language of the 1976 Act, the court found that the defendant class, defined as "anyone [who infringes],"<sup>176</sup> was "at least as sweeping, and probably more sweeping" than that of the 1909 Act.<sup>177</sup> Based on the *Mills Music* rationale and the revised statutory text, the court concluded that the 1976 Act nullified the state's eleventh amendment protection against money damages and injunctive relief.<sup>178</sup> Accordingly, the *Johnson* court denied the defendants' motion for dismissal or summary judgment. Having found sufficient congressional intent in the 1976 Act to abrogate the state's eleventh amendment immunity, the court did not consider whether the state had consented to suit in federal court.

### C. *Woelffer v. Happy States of America, Inc.*

In *Woelffer v. Happy States of America, Inc.*<sup>179</sup> an Illinois state agency<sup>180</sup> sought a judicial declaration that the eleventh amendment barred the defendant's potential copyright claim concerning the state's use of a slogan in a tourism campaign.<sup>181</sup> The defendant counterclaimed, alleging copyright infringement and

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174. *Johnson*, 606 F. Supp. at 323-24. "*Wihitol* provides little more than a conclusory statement that the Eleventh Amendment bars suits against the states, their instrumentalities, and their agents . . . . By contrast, *Mills Music* includes a thoughtful examination of the 1909 Act and the recent Supreme Court opinions concerning the Eleventh Amendment . . . ." *Id.* at 323.

175. *Id.* at 323 (citing *Mills Music*, 591 F.2d at 1285); see 17 U.S.C. § 1 (1976).

176. 17 U.S.C. § 501(a) (1982 & Supp. II 1984).

177. *Johnson*, 606 F. Supp. at 324.

178. *Id.* The court, however, granted the defendants' motion requesting dismissal of the pendant state law claim for the lost photographic slides, reasoning that an insufficient nexus existed between that claim and the plaintiff's federal claim. *Id.* See generally *UMW v. Gibbs*, 383 U.S. 715 (1966).

Additionally, the court granted the defendants' request for denial of the plaintiff's statutory damages and attorney's fees claims under the 1976 Act. See 17 U.S.C. § 504(c) (1982) (statutory damages); 17 U.S.C. § 505 (1982) (costs and attorney's fees). The court reasoned that the works were not registered in a timely manner, a prerequisite for such awards under 17 U.S.C. § 412 (1982) (requiring registration as "prerequisite to certain remedies for infringement"). *Johnson*, 606 F. Supp. at 324-25.

179. 626 F. Supp. 499 (N.D. Ill. 1985).

180. The plaintiffs included the Illinois Department of Commerce and Community Affairs, its director, and a private advertising agency whose work product was subject to review by the agency. *Id.* at 501 & n.1.

181. Additionally, the plaintiffs sought a declaration that the state's use of the slogan in question was not a violation of the defendant's federal and state law rights. *Id.* at 501.

seeking declaratory and injunctive relief, costs, and attorney's fees.<sup>182</sup> The United States District Court for the Northern District of Illinois held that the eleventh amendment bars suit against the state agency.<sup>183</sup>

Citing *Mills Music*,<sup>184</sup> the defendant first argued that Congress intended the 1976 Act to abrogate the states' constitutional immunity. The court, however, determined that the Supreme Court's recent decision in *Atascadero State Hospital v. Scanlon*<sup>185</sup> raised questions about *Mills Music*'s continued validity.<sup>186</sup> While the *Mills Music* court found that the language "any person [who infringes]" showed statutory intent to include the states among possible defendants,<sup>187</sup> the *Woelffer* court noted that *Atascadero* required the states' specific inclusion in the defendant class.<sup>188</sup> The court concluded that the general designation of the 1976 Act, "[a]nyone" who infringes a copyright,<sup>189</sup> is not sufficient to show congressional intent to abrogate eleventh amendment immunity.<sup>190</sup>

Again citing *Mills Music*, the defendant argued that regardless

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182. Under the Lanham Act, 15 U.S.C. §§ 1051-1127 (1982 & Supp. II 1984), the defendant also alleged false designation of origin or false description, *see id.* § 1125(a), and presented various pendant state law claims. The plaintiff's counterclaim did not seek money damages. *Woelffer*, 626 F. Supp. at 501 n.1.

183. *Woelffer*, 626 F. Supp. at 505.

Before discussing the issue of abrogation of eleventh amendment immunity, the court first addressed the question of whether the state had voluntarily consented to a countersuit against it by seeking declaratory relief in federal court. Citing *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 102 (1984), the court concluded that the eleventh amendment barred suit against the agency director because the state was the real, substantial party in interest. *Woelffer*, 626 F. Supp. at 501. The court ruled that while the state's request for declaratory relief constituted consent to federal suit for similar relief, the state's suit did not mean that it waived its immunity regarding the injunction or the attorney's fees and costs sought by the plaintiff. *Id.* at 503.

184. 591 F.2d 1278 (9th Cir. 1979); *see supra* notes 133-48 and accompanying text. The defendant also maintained that Congress intended to nullify the states' immunity under the Lanham Act, 15 U.S.C. § 1051-1127 (1982 & Supp. II 1984).

185. 105 S. Ct. 3142 (1985); *see supra* notes 110-21 and accompanying text.

186. The court noted that *Mihalek* rejected the *Mills Music* court's analysis. *Woelffer*, 626 F. Supp. at 503 n.5.

187. *See Mills Music*, 591 F.2d at 1284-85; *supra* notes 140-41.

188. "The watershed principle . . . in *Atascadero* governs . . . . The sweeping language employed by Congress arguably includes states within the class of . . . infringers . . . . The general authorization for suit in federal court against 'anyone' who infringes a copyright . . . is not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment." *Woelffer*, 626 F. Supp. at 504; *see Atascadero*, 105 S. Ct. at 3149.

189. 17 U.S.C. § 501(a) (1982 & Supp. II 1984).

190. For the same reason, the court held that the cause of action under the Lanham Act against "[a]ny person" who falsely represents or falsely designates the origin of goods or services in interstate commerce, 15 U.S.C. § 1125(a) (1982), does not abrogate the states' immunity. *Woelffer*, 626 F. Supp. at 504.

of statutory intent, the eleventh amendment is subordinate to the copyright and patent clause.<sup>191</sup> Thus, the defendant contended, any copyright statute passed pursuant to this constitutional clause inherently would nullify a state's constitutional immunity.<sup>192</sup> Unlike the *Mills Music* court, however, the *Woelffer* court refused to extend the *Fitzpatrick v. Bitzer*<sup>193</sup> holding beyond the context of a statute passed pursuant to section 5 of the fourteenth amendment. Absent the state's consent to suit or implied waiver of immunity, the court would not find abrogation of eleventh amendment immunity merely because Congress enacted a copyright statute.<sup>194</sup> Therefore, the court concluded that the eleventh amendment barred the defendant's counterclaims for an injunction and attorney's fees. The court, however, did permit injunctive relief against future infringement by state officials.<sup>195</sup>

#### D. Cardinal Industries, Inc. v. Anderson Parrish Associates, Inc.

In *Cardinal Industries, Inc. v. Anderson Parrish Associates, Inc.*<sup>196</sup> the plaintiff claimed that officials of a Florida state university infringed its copyrighted architectural plans for a student housing project.<sup>197</sup> The university's officials, who sought summary

191. See *Mills Music*, 591 F.2d at 1278; *supra* notes 143-46 and accompanying text.

192. *Woelffer*, 626 F. Supp. at 504.

193. 427 U.S. 445 (1976); see *supra* notes 80-88 and accompanying text.

194. "Congress did not enact the [1976] Act pursuant to its flexible Fourteenth Amendment powers. This fact obviously cuts against defendant's argument of Congressional abrogation of the Eleventh Amendment." *Woelffer*, 626 F. Supp. at 505 n.9.

The court noted that the Supreme Court recently had assumed, only for purposes of argument, that the reasoning of the *Mills Music* court had been correct. See *County of Oneida v. Oneida Indian Nation*, 470 U.S. 226, 252 (1985); *supra* notes 105-09 and accompanying text. The *Woelffer* court, however, characterized the Court's discussion of *Mills Music* as "inconsequential dictum . . . completely superceded by the subsequent comprehensive analysis is [sic] *Atascadero*." *Woelffer*, 626 F. Supp. at 504 n.8; see *Atascadero*, 105 S. Ct. at 3150; *supra* notes 110-21 and accompanying text. But see *Goldstein v. California*, 412 U.S. 546, 560 (1973) (holding that "[w]hen Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach").

Similarly, the *Woelffer* court held that "[b]ecause the Lanham Act was enacted under the Commerce Clause, [the subordination] argument is inapposite to defendant's false description claim." *Woelffer*, 626 F. Supp. at 504 n.7.

195. *Woelffer*, 626 F. Supp. at 505 (citing, *inter alia*, *Edelman v. Jordan*, 415 U.S. 651 (1974)); see *supra* note 79 and accompanying text. The court ruled, however, that an attorney's fees award would be a state treasury expense barred by the eleventh amendment. In addition, the court ruled that the plaintiff advertising agency did not derivatively enjoy immunity as an agent of the state. *Woelffer*, 626 F. Supp. at 506.

196. No. 83-1038-Civ-T-13, slip op. (M.D. Fla. Sept. 6, 1985), *aff'd*, No. 86-3354 (11th Cir. Jan. 27, 1987) (per curiam).

197. A Florida architectural firm and certain of its employees and officers also were named as defendants. See Brief on Appeal of Appellant, at 2, *Cardinal Indus.*, No. 86-3354.

judgment denying the plaintiff's request for monetary and injunctive relief, claimed eleventh amendment immunity.<sup>198</sup>

Reasoning that the state university was the real and substantial party in interest,<sup>199</sup> the court stated that the eleventh amendment would protect the nominal officials unless the university had waived this protection or Congress had abrogated the state's eleventh amendment immunity.<sup>200</sup> The panel concluded that "[a] review of the statutes and claims involved in this suit convinces this Court that the Eleventh Amendment protection has neither been waived nor abrogated."<sup>201</sup> Thus, the court granted the officials' motion for summary judgment as a matter of law.<sup>202</sup> Significantly, the *Cardinal Industries* court neither cited nor discussed the split of authority in the federal courts.<sup>203</sup> Furthermore, the court discussed neither the Supreme Court's recent *Atascadero* opinion nor the "statutes" that the court claimed it had reviewed.<sup>204</sup> The United States Court of Appeals for the Eleventh Circuit affirmed the district court's decision without discussion.<sup>205</sup>

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The court denied the motion of these defendants for summary judgment. *Cardinal Indus.*, No. 83-1038-Civ-T-13, slip op. at 2. The plaintiff, who also claimed unfair competition, was an Ohio real estate firm whose business included the manufacture and construction of modular housing units. *Id.* at 4.

198. *Cardinal Indus.*, No. 83-1038-Civ-T-13, slip op. at 2-3. "Although named in their individual capacities, the defendants contend that they were working within the scope of their official capacities as the Director of Housing and as a member of the Office of the Facility Planning . . . at the University of South Florida . . ." *Id.* at 2.

In addition to money damages and injunctive relief, the plaintiff also sought destruction of the university's materials that infringed the plaintiff's architectural plans. *Id.* at 4; see 17 U.S.C. § 503 (1982) ("Remedies for infringement: Impounding and disposition of infringing articles").

199. *Cardinal Indus.*, No. 83-1038-Civ-T-13, slip op. at 4 (citing *Pennhurst State School & Hosp. v. Scanlon*, 465 U.S. 89, 101 (1984)).

200. *Cardinal Indus.*, No. 83-1038-Civ-T-13, slip op. at 5 (citing *Clark v. Barnard*, 108 U.S. 436 (1883) (waiver of immunity) and *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976) (abrogation of immunity)).

201. *Cardinal Indus.*, No. 83-1038-Civ-T-13, slip op. at 5. "Before a court will subject a state or its instrumentalities to suit in a federal court, state consent or congressional abrogation must be 'unequivocally expressed.'" *Id.* (quoting *Pennhurst*, 465 U.S. at 99).

202. *Cardinal Indus.*, No. 83-1038-Civ-T-13, slip op. at 5. The court stated that a ruling on the defendants' additional claim of protection under common law sovereign immunity was unnecessary. *Id.*

203. See *supra* notes 122-95 and accompanying text.

204. *Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc.*, No. 83-1038-Civ-T-13, slip op. (M.D. Fla. Sept. 6, 1985), *aff'd*, No. 86-3354 (11th Cir. Jan. 27, 1987) (per curiam).

205. *Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc.*, No. 86-3354 (11th Cir. Jan. 27, 1987) (per curiam).

*E. Richard Anderson Photography v. Radford University*

In the most recent federal district court case addressing the issue, the United States District Court for the Western District of Virginia, only one year after deciding *Johnson*, reached a different result. In *Richard Anderson Photography v. Radford University*<sup>206</sup> the plaintiff sued a state university under the 1976 Act, claiming copyright infringement of photographs made for the institution's student prospectus.<sup>207</sup> The plaintiff sought money damages, claiming that the university subsequently used the photographs in other publications without authority.<sup>208</sup> The defendants claimed eleventh amendment immunity.

The *Anderson* court first considered the issue of unilateral congressional abrogation of eleventh amendment immunity. The court held that Congress, acting pursuant to the copyright and patent clause, did not have the power to abrogate the states' constitutional immunity without the states' consent.<sup>209</sup> Citing *Atas-*

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206. 633 F. Supp. 1154 (W.D. Va. 1986).

207. The university contracted with a design organization, which in turn retained the plaintiff to make the photographs. Although the plaintiff did not register his copyrights until after the alleged infringements occurred, see 17 U.S.C. § 412 (1982) ("Registration as prerequisite to certain remedies for infringement"), the court noted that § 412(2) provides a three month grace period in which to register. *Anderson*, 633 F. Supp. at 1156 & n.2.

In addition to the university, the defendants included the institution's Director of Public Relations and Information and the institution's governing body. *Id.* at 1155, 1160. The court held that the university was an "arm of the state" for purposes of the eleventh amendment and, thus, enjoyed whatever immunity the state enjoyed. *Id.* at 1158 & n.10.

In a footnote the court stated that "[i]nsofar as *Wihol* [v. Crow, 309 F.2d 777 (8th Cir. 1962)] held that local school districts are 'arms of the state' for the purposes of the Eleventh Amendment . . . it may have been incorrectly decided." *Anderson*, 633 F. Supp. at 1160 n.14 (citing *Mt. Healthy City School Dist. Bd. of Educ. v. Doyle*, 429 U.S. 274, 280-81 (1977) (holding that unless state law so provides, school districts are not "arms of the state")); see *supra* notes 129-32 and accompanying text. The court noted that "[t]he Eleventh Amendment applies only to States and agencies and instrumentalities of the States, not to subdivisions such as municipalities and counties." *Anderson*, 633 F. Supp. at 1160 n.14 (citing, *inter alia*, *Monell v. Department of Social Servs.*, 436 U.S. 658, 690 n.54 (1978)); see *Lincoln County v. Luning*, 133 U.S. 529 (1890) (holding that eleventh amendment does not bar suit for money damages against school district); *Atascadero*, 105 S. Ct. at 3155 n.8 (stating that "the Eleventh Amendment is not a bar to suits against local governmental units") (citing *Lincoln County*, 133 U.S. at 530); *Marcus v. Rowley*, 695 F.2d 1171 (9th Cir. 1983) (holding school district liable for copyright infringement).

208. Initially, the plaintiff also sought injunctive relief. However, because the university returned his photographs after he filed the complaint, the plaintiff dropped that request. *Anderson*, 633 F. Supp. at 1156.

209. *Id.* at 1158. The court rejected the plaintiff's argument, supported by *Mills Music*, 591 F.2d at 1285, and *Goldstein v. California*, 412 U.S. 546, 560 (1973), that "the States have no sovereignty, and thus no immunity, when Congress acts pursuant to one of Article I's enumerated powers, such as the Copyright and Patent Clause." *Anderson*, 633 F. Supp. at 1158 n.9. The court found *Goldstein* "inapposite because it deals not with the issue of

*cadereo*<sup>210</sup> and *Fitzpatrick*,<sup>211</sup> the court reasoned that the Supreme Court recognized this power only when Congress acts pursuant to section 5 of the fourteenth amendment.<sup>212</sup> Thus, the court focused not on whether Congress had abrogated the states' immunity, but on whether the state had waived its immunity.<sup>213</sup>

Finding no evidence of express waiver,<sup>214</sup> the *Anderson* court examined whether the State of Virginia, by operating the university, impliedly consented to suit in federal court. The court used a two-part test, first determining whether the 1976 Act authorized suits against "a class of defendants which literally includes states."<sup>215</sup> Citing the interpretation of statutory language in *Mills Music*<sup>216</sup> and *Johnson*,<sup>217</sup> the court held that the general authorization in the 1976 Act for suit against "anyone" who infringes is broad enough to include states.<sup>218</sup>

In the second part of its waiver analysis, the court examined whether the state had given an "unequivocal indication" of consent to federal court suit.<sup>219</sup> Holding that the state had not impliedly waived its eleventh amendment immunity, the court decided that the circumstances did not indicate clearly the state's intent.<sup>220</sup> The court determined that in cases finding implied waiver of eleventh amendment immunity, states generally were faced with the choice of whether to act, usually in the context of accepting or rejecting a benefit provided by a federal statute or program. The court stated that "when it appears from the context of the federal statute granting the benefit that receipt of the benefit by the State is conditioned upon its surrender of its Eleventh Amendment immunity, the courts find that the State's actions constituted a waiver of its

Eleventh Amendment immunity, but with the issue of federal preemption of the copyright field." *Id.*

210. 105 S. Ct. 3142 (1985); see *supra* notes 110-21 and accompanying text.

211. 427 U.S. 445 (1976); see *supra* notes 80-88 and accompanying text.

212. *Anderson*, 633 F. Supp. at 1158.

213. *Id.*

214. *Id.* "A State may, for example, expressly waive its constitutional immunity by a state statute or constitutional provision." *Id.* at 1157 (citing *Atascadero*, 105 S. Ct. at 3145 n.1, 3147); see *supra* notes 47-48 and accompanying text. See generally Note, *supra* note 10.

215. *Anderson*, 633 F. Supp. at 1157 (quoting *Edelman*, 415 U.S. at 672).

216. 591 F.2d 1278 (9th Cir. 1979); see *supra* notes 140-41 and accompanying text.

217. 606 F. Supp. 321 (W.D. Va. 1985); see *supra* notes 162-78 and accompanying text.

218. *Anderson*, 633 F. Supp. at 1159.

219. *Id.* at 1157 (quoting *Atascadero*, 105 S. Ct. at 3145 n.1). "Before a State can be found to have impliedly waived its immunity, its intent to do so must clearly appear from the circumstances." *Anderson*, 633 F. Supp. at 1159.

220. *Anderson*, 633 F. Supp. at 1159.

immunity.”<sup>221</sup>

The *Anderson* court noted that the first implied waiver case, *Parden v. Terminal Railway*,<sup>222</sup> is difficult to reconcile with later Supreme Court cases that seemingly demonstrate a “greater reluctance” to find implied waiver.<sup>223</sup> Distinguishing the cases, however, the court noted that the operation of the railroad in *Parden* was less of a traditional state function than the administration of Social Security funds in *Edelman v. Jordan*<sup>224</sup> and the participation in a program for the handicapped in *Atascadero*.<sup>225</sup> The court suggested that in *Parden* the Supreme Court was more willing to imply waiver because “there was less compulsion for [the state] to choose to operate a railroad that [sic] there would have been had it been dealing with a more basic and fundamental function of the State.”<sup>226</sup>

Examining the instant facts, the court noted that the state function of operating a university necessarily requires the daily use of federally protected copyrights. Because the state, in carrying out this traditional governmental function, effectively was compelled to use copyrighted works, the court reasoned that the state’s activities were analogous to the activities in *Edelman* and *Atascadero*, cases in which waiver was not implied.<sup>227</sup> Therefore, finding no im-

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221. *Id.* “Such was the situation in *Parden* and the Supreme Court held that by choosing to operate a railroad in interstate commerce the state of Alabama had . . . impliedly waived its Eleventh Amendment immunity.” *Id.*

222. 377 U.S. 184 (1964); see *supra* notes 49-65 and accompanying text.

223. *Anderson*, 633 F. Supp. at 1159 & n.12 (citing *Welch v. State Dep’t of Highways and Pub. Transp.*, 780 F.2d 1268 (5th Cir.) (en banc) (noting that later cases, including *Atascadero*, have limited the broad sweep of *Parden*), *cert. granted*, 107 S. Ct. 58 (1986)).

224. 415 U.S. 651 (1974); see *supra* notes 74-79 and accompanying text.

225. *Anderson*, 633 F. Supp. at 1160. The court noted that the distinction between “governmental” and “proprietary” state functions had been rejected in the context of the tenth amendment. *Id.* at 1160 n.13 (citing *Garcia v. San Antonio Metropolitan Transit Auth.*, 469 U.S. 528 (1985)). Assuming that the distinction also was no longer valid in the eleventh amendment context, the court nonetheless believed that an examination of the state function in *Anderson* was helpful in determining “the degree of compulsion that a State was under to furnish a particular service or to accept a given benefit.” *Anderson*, 633 F. Supp. at 1160 n.13.

226. *Id.* at 1160.

227. *Id.* The court declared that the state function of operating a university “per force requires almost daily decision-making with regard to matters governed by Acts of Congress, including the use of property rights created by the copyright law.” *Id.*

While the plaintiff argued that *Johnson*, decided by the same court the preceding year, was dispositive of the issue, the court stated that *Johnson*, in which waiver was implied, would have been decided differently in light of the subsequent *Atascadero* holding. “*Atascadero* imposes a more stringent standard than had been used in the past by requiring courts to find an ‘unequivocal indication’ of a State’s consent to be sued in federal court.” *Id.*; see *supra* text accompanying note 118.

plied waiver of eleventh amendment immunity, the court granted the university's motion to dismiss.<sup>228</sup>

#### IV. ANALYSIS

In a copyright infringement suit against a state, the issue to be resolved is whether the state has waived or Congress has abrogated the state's eleventh amendment immunity. In *Parden v. Terminal Railway*<sup>229</sup> the Supreme Court suggested, although somewhat ambiguously, an appropriate three step analysis<sup>230</sup> for determining implied waiver. First, does Congress have the power to abrogate the state's common law sovereign immunity?<sup>231</sup> Second, does the relevant statute indicate congressional intent to condition the state's right to enter a federally regulated activity upon the state's consent to suit in federal court?<sup>232</sup> Last, in light of this congressional power and intent, does the state's subsequent or continued activity in the federally regulated area imply waiver of its eleventh amendment immunity?<sup>233</sup> *Fitzpatrick v. Bitzer*<sup>234</sup> and *Atascadero State Hospital v. Scanlon*<sup>235</sup> call for an additional inquiry: Does Congress have the constitutional power and statutory intent to unilaterally abrogate constitutional immunity and, thus, remove the requirement of state consent? Federal courts have answered these questions inconsistently in copyright infringement cases.<sup>236</sup>

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228. The court held that the university's governing body enjoyed the same immunity as the university. *Anderson*, 633 F. Supp. at 1160. To the extent that the suit was directed against the public relations director in her official capacity, the court ruled that she also enjoyed constitutional immunity, reasoning that the state was the real party in interest. *Id.* (citing *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 101 & n.11 (1984) (holding that the state is a real party in interest when "the judgment sought would expend itself on the public treasury or domain, or interfere with the public administration, or if the effect of the judgment would be to restrain the Government from acting, or compel it to act"). The court, however, left open the possibility that the director might be personally liable. *Anderson*, 633 F. Supp. at 1161.

Finally, the court granted the plaintiff's motion to amend his complaint to allege the state's unlawful taking of property in violation of the fourteenth amendment. The court invited counsel to submit briefs "on the applicability of Eleventh Amendment immunity to this constitutional claim." *Id.*

229. 377 U.S. 184, 187, 192 (1964); see *supra* notes 49-65 and accompanying text.

230. See Note, *supra* note 10, at 520 n. 44; cf. Comment, *supra* note 10, at 958-59 (suggesting a similar two step analysis).

231. See *supra* note 42 for a discussion of the distinction between common law sovereign immunity and eleventh amendment immunity.

232. See *Parden*, 377 U.S. at 187, 192.

233. See *id.* at 192.

234. 427 U.S. 445 (1976); see *supra* notes 80-88 and accompanying text.

236. 105 S. Ct. 3142 (1985); see *supra* notes 110-21 and accompanying text.

236. *Compare Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979) with *Woelf-*

A. *Congressional Power to Abrogate Common Law Sovereign Immunity*

When considered without reference to the eleventh amendment, the copyright and patent clause gives Congress sufficiently broad power to abrogate the states' common law sovereign immunity.<sup>237</sup> In granting Congress the constitutional power to regulate copyright protection, the states surrendered any part of their sovereignty that would interfere with that regulation.<sup>238</sup> As the *Parden* Court noted, "The sovereign power of the states is necessarily diminished to the extent of the grants of power to the federal government."<sup>239</sup> In *Goldstein v. California*,<sup>240</sup> which concerned federal preemption of state copyright protection, the Supreme Court declared that "the States cannot exercise a sovereign power which, under the Constitution, they have relinquished to the Federal Government for its exclusive exercise . . . . When Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach."<sup>241</sup>

Thus, because the cause of action created in the 1909 and 1976 Acts is within the congressional copyright power, common law sovereign immunity does not bar application of the Acts against infringing states.<sup>242</sup> The Constitution, however, may prescribe limitations on Congress' copyright power to nullify the state's immunity from suit.<sup>243</sup> The eleventh amendment's prohibition of infringement suits in federal court against nonconsenting states acts as such a limitation.<sup>244</sup> Absent express waiver of this immunity, a

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fer v. Happy States of America, Inc., 626 F. Supp. 499 (N.D. Ill. 1985).

237. See Comment, *supra* note 10, at 947 n.121 (stating that "[t]he power of Congress to lift the common law immunity of the states is not questioned") (citing *Parden*, 377 U.S. at 198 (White, J., dissenting)).

238. Cf. *Parden*, 377 U.S. at 191-92 (holding that "[b]y empowering Congress to regulate commerce . . . the States necessarily surrendered any portion of their sovereignty that would stand in the way of such regulation").

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

240. 412 U.S. 546 (1973).

241. *Id.* at 552, 560, quoted in *Mills Music*, 591 F.2d at 1285; see *supra* note 146 and accompanying text.

242. Cf. *Parden*, 377 U.S. at 192 (holding that "[s]ince imposition of the FELA right of action upon interstate railroads is within the congressional regulatory power, it must follow that application of the Act to [the state run] railroad cannot be precluded by sovereign immunity").

243. Cf. *Gibbons v. Ogden*, 22 U.S. (9 Wheat.) 1, 196-97 (1824) (declaring that "[the commerce] power, like all others vested in congress, is complete in itself, may be exercised to its utmost extent, and acknowledges no limitations other than are prescribed in the constitution").

244. See U.S. CONST. amend. XI; see also *Mills Music*, 591 F.2d at 1283, 1286.

state still might impliedly consent to a federal court infringement suit.

### B. Congressional Intent

The next question under the *Parden* analysis is whether the 1909 and 1976 Acts show congressional intent to abrogate eleventh amendment immunity by conditioning a state's participation in the copyright field upon amenability to federal court suit.<sup>245</sup> Traditionally, analysis of congressional intent required an examination of the statutory language and legislative history to determine whether Congress meant to include states within the class of potential defendants when it created a cause of action.<sup>246</sup> The Supreme Court's pronouncements on this issue, however, have been inconsistent.<sup>247</sup>

In *Parden*<sup>248</sup> the FELA<sup>249</sup> created a cause of action against "every common carrier by railroad" engaged in interstate commerce.<sup>250</sup> The Supreme Court found this language sufficiently broad to authorize federal suit against the state.<sup>251</sup> The Court reasoned that, absent express language to the contrary, it should not presume congressional intent to exclude states from the statute's reach.<sup>252</sup>

In *Employees v. Department of Public Health and Welfare*,<sup>253</sup> however, the Court reversed the presumption of congressional intent to subject the states to suit. The *Employees* Court held that "Congress, acting responsibly, would not be presumed to take such

245. See *Parden*, 377 U.S. at 192.

246. See *id.* at 187-90; *Employees v. Department of Pub. Health and Welfare*, 411 U.S. 279, 285 (1973); *Atascadero*, 105 S. Ct. at 3147-49; see also *Mills Music*, 591 F.2d at 1284 n.7 (stating that "[t]he class of defendants intended by Congress must be ascertained from the language of the statute, the legislative history of the statute, and the context in which it applies.").

247. See cases cited *supra* note 246. For a general discussion of the rules of statutory construction, see C. D. SANDS, *STATUTES AND STATUTORY CONSTRUCTION* (9th ed. 1975).

248. 377 U.S. 184 (1964). In *Wihtol v. Crow*, 309 F.2d 777 (1962), decided before *Parden*, the court did not discuss the possibility of implied waiver of eleventh amendment immunity. See *supra* note 132.

249. 45 U.S.C. §§ 51-60 (1982); see *supra* notes 54-56 and accompanying text.

250. 45 U.S.C. at §§ 51, 56 (1982); see *Parden*, 377 U.S. at 185-86.

251. *Parden*, 377 U.S. at 187 (stating that "[w]e think that Congress, in making the FELA applicable to 'every' common carrier by railroad in interstate commerce, meant what it said"); *id.* at 189 (recognizing that "[t]he fact that Congress chose to phrase the coverage of the [FELA] in all-embracing terms indicates that state railroads were included within it") (quoting *California v. Taylor*, 353 U.S. 553, 564 (1957)).

252. *Parden*, 377 U.S. at 189-90.

253. 411 U.S. 279 (1973); see *supra* notes 66-73 and accompanying text.

action silently.”<sup>254</sup> Although the defendant class under the FLSA included “any employer” who violated the statute, the Court found that this language and the legislative history of the FLSA did not refer to the states.<sup>255</sup> Thus, the *Employees* Court significantly narrowed the *Parden* holding by ruling that congressional intent to nullify constitutional immunity must be apparent from the “clear language” of the statute.<sup>256</sup> Specifically, the Court stated that in the context of the statutory language and the legislative history, the words “any employer” did not evince this intent.<sup>257</sup>

In *Mills Music, Inc. v. Arizona*<sup>258</sup> the Ninth Circuit noted the “sharp contrast”<sup>259</sup> between *Parden* and *Employees*, but chose not to follow *Employees*’ presumption in favor of immunity. The court found that the 1909 Act authorized suit against “any person [who] shall infringe,” using language apparently as broad and indefinite as the “any employer” language in *Employees*.<sup>260</sup> The court, however, stated that in ascertaining congressional intent, a court should examine “the language of the statute in the context of the activity regulated.”<sup>261</sup> The court determined that a narrow construction of statutory intent was necessary in *Employees* because Congress, acting under its broad commerce power, potentially could have placed a great burden on the state treasury.<sup>262</sup> The court, however, reasoned that because the potential financial burden to states would be minimal when Congress acts pursuant to its narrow copyright power, a less strict statutory construction of congressional intent was possible.<sup>263</sup> Thus, in *Mills Music* the court found that broad statutory language weighed against immunity, even though the Supreme Court in *Employees* previously con-

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254. *Employees*, 411 U.S. at 284-85; see *supra* notes 68-72.

255. *Employees*, 411 U.S. at 285; see 52 Stat. 1069 (codified as amended at 29 U.S.C. §§ 201-19 (1982)).

256. *Employees*, 411 U.S. at 285.

257. *Id.* at 283-85. The Court noted that, unlike the FELA in *Parden*, the FLSA mandated double compensation for successful claimants, potentially creating large fiscal burdens for the states. *Id.* at 284.

In *Edelman v. Jordan*, 415 U.S. 651 (1974), the Court held that a statute that does not expressly create a cause of action shows no congressional intent to abrogate eleventh amendment immunity. *Id.* at 674.

258. 591 F.2d 1278 (9th Cir. 1979); see *supra* notes 133-48 and accompanying text.

259. *Mills Music*, 591 F.2d at 1283 (quoting *Riggle v. California*, 577 F.2d 579, 583 (9th Cir. 1978)).

260. *Mills Music*, 591 F.2d at 1284-85; see *supra* note 141 and accompanying text.

261. *Mills Music*, 591 F.2d at 1284-85.

262. *Id.* at 1285.

263. *Id.*

cluded differently.<sup>264</sup>

In *Johnson v. University of Virginia*<sup>265</sup> a Virginia federal court accepted the *Mills Music* rationale. Examining the 1976 Act, the court held that the defendant class, defined as "anyone [who] infringes," was at least as broad as the "any person [who] infringes" definition of the defendant class contained in the 1909 Act and, therefore, evidenced an intent to include the states.<sup>266</sup> The *Johnson* court assumed, contrary to *Employees* but in accord with *Mills Music*, that the broad language weighed against immunity.<sup>267</sup>

Subsequently, in *Atascadero State Hospital v. Scanlon*<sup>268</sup> the Supreme Court appears to have settled the uncertainty concerning congressional intent. The Court required that congressional intent, in order to make states amenable to suit, must be shown to specifically include the states in the statute's defendant class.<sup>269</sup> Thus, the Court appeared to reaffirm the spirit of *Employees* by demanding that Congress, when desiring to include states in the defendant class, make an express inclusion.<sup>270</sup> In *Richard Anderson Photography v. Radford University*<sup>271</sup> the court incorrectly disregarded the Supreme Court's presumption in favor of immunity and, instead, relied on the discredited rationale of *Mills Music* and *Johnson* to find the statutory defendant class "sufficiently broad to include the States."<sup>272</sup> Despite the court's incorrect reasoning, however, the *Anderson* court reached the correct conclusion on the issue of congressional intent.

*Atascadero* does not prohibit a search of all relevant statutory language in defining the defendant class.<sup>273</sup> Although the 1909 and 1976 Acts do not explicitly include states as potential defendants, the Acts, read as a whole, indicate that Congress specifically intended to include the states in the defendant class.<sup>274</sup> Both Acts create specific exemptions from infringement suits for certain uses

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264. See *supra* notes 242-46 and accompanying text.

265. 606 F. Supp. 321 (W.D. Va. 1985); see *supra* notes 162-78 and accompanying text.

266. *Johnson*, 606 F. Supp. at 323-24; see 17 U.S.C. § 501 (1982 & Supp. II 1984).

267. *Johnson*, 606 F. Supp. at 324; see *supra* notes 173-78 and accompanying text.

268. 105 S. Ct. 3142 (1985).

269. *Id.* at 3149; see *supra* text accompanying note 117.

270. *Atascadero*, 105 S. Ct. at 3149.

271. 633 F. Supp. 1154 (W.D. Va. 1986).

272. *Id.* at 1159.

273. See Supplemental Brief on Appeal of Amici Curiae at 12, *Mihalek Corp. v. Michigan*, 595 F. Supp. 903 (E.D. Mich. 1984), appeal docketed, No. 85-1593 (6th Cir. July 23, 1985) (stating that "nowhere does the *Atascadero* opinion limit the inquiry to a single section of the Copyright Act.").

274. See, e.g., *Mills Music*, 591 F.2d at 1284 n.7; *supra* note 246.

of copyrighted works by various parties, including state agencies.<sup>275</sup> For example, the 1976 Act provides that unauthorized importation of copies of works acquired outside the United States constitutes copyright infringement.<sup>276</sup> The Act, however, generally exempts the “importation of copies or phonorecords under the authority or for the use of . . . any State or political subdivision of a State.”<sup>277</sup> One plaintiff argued that “the exemptions and exceptions carefully carved out by Congress would not be necessary if Congress did not clearly intend the States and their political subdivisions be subject to the [1976] Act.”<sup>278</sup> Assuming that this statutory language is not superfluous, Congress evidently intended states to be immune from copyright suits in federal court only when Congress specifically provides a statutory exemption.<sup>279</sup> Thus, by the text’s negative implication, which leaves “no room for any other reasonable construction,”<sup>280</sup> the states have been included in the defendant class of both Acts with sufficient specificity to evince clear congressional intent.

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275. “The [1976] Act . . . contains at least seven express exemptions from suit for infringement for state agencies, applicable in specific, narrowly defined circumstances . . . .” Supplemental Brief on Appeal of Amici Curiae at 6, *Mihalek*, No. 85-1593; see 17 U.S.C. §§ 107 (“Limitation of exclusive rights: Fair use”); 110(6) (“Limitations on exclusive rights: Exemption of certain performances and displays”); 111(a) (“Limitations on exclusive rights: Secondary transmissions”); 112(b) (“Limitations on exclusive rights: Ephemeral recordings”); 118(d)(3) (“Scope of exclusive rights: Use of certain works in connection with noncommercial broadcasting”); 601(b) (“Manufacture, importation, and public distribution of certain copies”); 602(a) (“Infringing importation of copies or phonorecords”) (1982).

Similarly, the 1909 Act exempts from its importation prohibition the good faith use of one copy of a book by, among other institutions, “any State, school, college, university, or free public library in the United States.” See 17 U.S.C. § 107 (1976).

276. See 17 U.S.C. § 602(a) (1982).

277. *Id.* § 602(a)(1).

278. Appellants’ Brief on Appeal at 15, *Mihalek*, No. 85-1593.

279. See *id.* at 14. One can argue, however, that to the extent that these provisions protect local school districts and local and county governments, which are not immune from federal court suit under the eleventh amendment, see *supra* note 207, the specific statutory exemptions are not superfluous. See *supra* notes 275-78 and accompanying text.

280. *Atascadero*, 105 S. Ct. at 3146 (quoting *Edelman v. Jordan*, 415 U.S. 651, 673 (1974)).

Professor Nimmer has stated that “since nothing in the Copyright Act purports to immunize state entities from liability, the Supremacy Clause of the Constitution prevents state impairment of this federal law. This principle has been expressly invoked in copyright cases not involving the sovereign immunity issue.” 3 M. NIMMER, NIMMER ON COPYRIGHT § 121.01[E][2][a], at 12-19 (1986).

### C. Implied Waiver

Because the 1909 and 1976 Acts meet the specificity test of *Atascadero*, the only remaining question under the three-part *Parden* analysis is whether a state, by its actions, impliedly has consented to suit in federal court. In *Parden* the Court held that, given congressional intent to nullify eleventh amendment immunity, the state's subsequent activity in the regulated area of interstate commerce implied the requisite consent to federal jurisdiction.<sup>281</sup> Similarly, the *Mills Music* court found implied waiver of constitutional immunity by the state's entry "in[to] an activity regulated by federal [copyright] law."<sup>282</sup> An examination of the relevant facts and language in later cases, however, indicates that the *Mills Music* rationale is of doubtful validity for two reasons. The issue centers on when "engaging" in the federally regulated activity of copyright use constitutes voluntary submission to federal jurisdiction.<sup>283</sup>

First, as the *Anderson* court recently noted, the Supreme Court requires that "an unequivocal indication" of implied consent to federal suit "clearly appear from the circumstances."<sup>284</sup> A state's use of copyrighted works—the federal activity in which it engages—does not "clearly" and "unequivocally" evince this consent. The *Anderson* court declared that for a state's actions truly to imply consent, the state "must have had a choice to act or not act."<sup>285</sup> The court correctly concluded that the states, as a practical matter, have no choice but to utilize copyrighted material in carrying out the basic functions of government.<sup>286</sup> Congress could not effectively prevent the states from using those materials; the workings of state government quickly would grind to a halt if Congress could prevent the availability of copyrighted works such as books, films, computer software, and maps. For this reason, the necessary use of these works in carrying out state governmental functions fundamentally differs from the discretionary operation of a railroad, the activity from which the *Parden* Court first implied waiver.<sup>287</sup>

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281. *Parden*, 377 U.S. at 192-93; see *supra* notes 61-65 and accompanying text.

282. *Mills Music*, 591 F.2d at 1283, 1286; see *supra* note 142 and accompanying text.

283. See *Parden*, 377 U.S. at 193 & n.11.

284. *Anderson*, 633 F. Supp. at 1159 (citing *Atascadero*, 105 S. Ct. at 3145 n.1).

285. *Anderson*, 633 F. Supp. at 1159.

286. *Id.* at 1159-60.

287. In his concurrence in *Employees v. Department of Pub. Health and Welfare*, 411 U.S. 279 (1973), Justice Marshall said, "To suggest that the State had the choice of either ceasing operation of these vital public services or 'consenting' to federal suit suffices . . . to demonstrate that the State had no true choice at all and thereby that the State did not

Second, the cases following *Parden* have limited the factual settings in which waiver will be implied. Although *Parden* concerned permission to operate a railroad, the *Anderson* court observed that implied waiver cases usually arise in the narrow context "of a state's accepting or rejection of a federally provided benefit."<sup>288</sup> In *Atascadero* the Supreme Court noted that a state may consent to federal court suit either expressly "or by otherwise waiving its immunity to suit in the context of a particular federal program."<sup>289</sup> Thus, the Court appears implicitly to have limited *Parden*, suggesting that waiver of constitutional immunity in the future would be implied only when a state accepts, under a federal program, a benefit that Congress could have withheld. Because a state's use of copyrighted works does not fall within this narrow context, consent to federal court suit cannot be implied under *Atascadero*.<sup>290</sup> The *Mills Music* and *Johnson v. University of Virginia*<sup>291</sup> rationale, therefore, no longer is valid. A state does not impliedly waive its constitutional immunity from infringement suits in exchange for the availability of copyrighted works.<sup>292</sup>

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voluntarily consent to the exercise of federal jurisdiction." *Id.* at 296 (Marshall, J., concurring); see *Anderson*, 633 F. Supp. at 1157 n.6 (requiring that a "State's consent must not be illusory").

288. *Anderson*, 633 F. Supp. at 1159; see *Atascadero*, 105 S. Ct. at 3142 (federal financial assistance under the Rehabilitation Act of 1973); *Edelman v. Jordan*, 415 U.S. 651 (1974) (federal funding under AABD). The *Anderson* court noted that "*Parden* is difficult to reconcile with some of the Court's later cases . . . which seem to evidence a greater reluctance on the part of the Court to find an implied waiver." *Anderson*, 633 F. Supp. at 1159; see *Welch v. State Dep't of Highways and Transp.*, 780 F.2d 1268 (5th Cir.) (en banc) (holding broad sweep of *Parden* limited by later Supreme Court opinions, including *Atascadero*), cert. granted, 107 S. Ct. 58 (1986); *Anderson*, 633 F. Supp. at 1159 n.12.

289. *Atascadero*, 105 S. Ct. at 1435 n.1. Significantly, in *Atascadero* the Supreme Court did not cite *Parden* in its discussion of implied consent. See *id.* at 3149-50.

290. But see Supplemental Brief on Appeal of Amici Curiae at 7, *Mihalek*, No. 85-1593 (urging that "[t]here is . . . a world of difference between a state's passive receipt of federal funds and a state's active infringement of a copyright . . . The former may well be found not [sic] imply a waiver of immunity, while the latter surely does constitute 'purposeful activity' implying waiver").

291. 606 F. Supp. 321 (W.D. Va. 1985); see *supra* notes 162-78 and accompanying text. The *Johnson* court accepted the *Mills Music* rationale.

292. See *Parden*, 377 U.S. at 192. One can argue, however, that a state instrumentality that not only uses a copyrighted work without authority, but also attempts to register the work as its own, see 17 U.S.C. §§ 408-412 (1982) (covering registration of copyrights), may have impliedly waived constitutional immunity; an infringer's registration arguably is analogous to *Parden's* requirement of participation in a federally regulated activity, see *supra* note 64 and accompanying text. Telephone conversation with Frank R. Jakes, attorney with Shackelford, Farris, Stallings & Evans, Tampa, Fla. (Nov. 26, 1986).

D. *Unilateral Congressional Abrogation of Eleventh Amendment Protection*

Absence of implied consent does not always preclude suits against the states in federal court. In *Fitzpatrick v. Bitzer*<sup>293</sup> the Supreme Court held that a statute passed pursuant to the fourteenth amendment could subject states to suit in federal court because the eleventh amendment is inherently subordinate to the fourteenth amendment.<sup>294</sup> Thus, in the context of fourteenth amendment legislation, state consent to federal jurisdiction is unnecessary if a plaintiff sufficiently demonstrates congressional intent to nullify constitutional immunity.

The *Mills Music* court, extending the *sui generis Fitzpatrick* holding beyond its fourteenth amendment context, stated that the eleventh amendment also is inherently subordinate to the copyright and patent clause.<sup>295</sup> If the court's determinations were valid, inquiry into state consent to federal infringement suits also would be unnecessary as long as statutory intent to allow these infringement suits existed. The requisite congressional intent to include states in the defendant class is specified sufficiently in both the 1909 and 1976 Acts.<sup>296</sup>

Because, however, the Supreme Court expressly limited its *Fitzpatrick* holding to statutes passed pursuant to the fourteenth amendment,<sup>297</sup> *Mills Music's* expansive reading appears to be "constitutionally impermissible."<sup>298</sup> The *Woelffer v. Happy States of America, Inc.*<sup>299</sup> court noted this probability. In *County of Oneida v. Oneida Indian Nation*<sup>300</sup> the Supreme Court cited the *Mills Music* holding on congressional abrogation of eleventh amendment immunity, but refused to decide whether the *Mills Music* rationale was correct.<sup>301</sup> Thus, the Court left open the possibility that congressional intent and statutory violation alone were

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293. 427 U.S. 445 (1976); see *supra* notes 80-88 and accompanying text.

294. *Id.* at 456; see *supra* notes 86-88 and accompanying text.

295. See *supra* notes 143-46 and accompanying text. In *Johnson v. University of Virginia*, 606 F. Supp. 321 (W.D. Mich. 1985), the court accepted the *Mills Music* reasoning without discussing *Fitzpatrick*. See *id.* at 322-24.

296. See *supra* notes 245-80 and accompanying text.

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

298. See *id.*

299. 626 F. Supp. 499, 503-05 (N.D. Ill. 1985); see *supra* notes 191-94 and accompanying text.

300. 470 U.S. 226 (1985).

301. *Id.* at 252; see *supra* notes 105-09 and accompanying text.

sufficient in infringement suits to force a state into federal court.<sup>302</sup>

More recently, however, the *Atascadero*<sup>303</sup> Court reiterated that *Fitzpatrick* was limited to legislation passed under the fourteenth amendment.<sup>304</sup> As the *Mihalek* and *Anderson* courts correctly concluded, Congress, acting pursuant to the copyright and patent clause, has no power to unilaterally abrogate a state's eleventh amendment immunity.<sup>305</sup> State consent, express or implied,

302. Taken literally, this analysis presents trial courts with the problem of requiring that the jurisdictional question be answered based on a determination of a state's liability for a statutory violation. As a practical matter, a federal court obviously cannot find liability for copyright infringement until it first decides whether it has jurisdiction over the defendant state.

303. 105 S. Ct. 3142 (1985).

304. The Court said, "There are . . . certain well-established exceptions to the reach of the Eleventh Amendment. For example, . . . when acting pursuant to § 5 of the Fourteenth Amendment, Congress can abrogate the Eleventh Amendment without the States' consent." *Id.* at 3145-46; see *supra* notes 110-21 and accompanying text. *But see* *Gibbons*, *supra* note 4, at 2004 (arguing that the Supreme Court should "acknowledg[e] that Congress can eliminate state immunity with respect to any subject on which it has legislative authority"); Reply Brief on Appeal of Appellant at 18, *Cardinal Indus., Inc. v. Anderson Parrish Assocs., Inc.*, No. 83-1038-Civ-T-13, slip op. (M.D. Fla. Sept. 6, 1985), *aff'd*, No. 86-3354 (11th Cir. Jan. 27, 1987) (per curiam) (stating that "[t]here is no statement in *Atascadero* . . . which holds . . . that *only* when Congress is acting pursuant to Sec. 5 of the Fourteenth Amendment may Congress abrogate Eleventh Amendment immunity"); *supra* notes 196-205 and accompanying text.

One commentator notes that the *Atascadero* holding "was premised on the availability of state courts to entertain such suits." W. PATRY, *supra* note 14, at 272 n.70; see *Atascadero*, 105 S. Ct. at 3146 n.2 (recognizing that "the issue is not the general immunity of the States from private suit . . . but merely the susceptibility of the States to suit before federal tribunals") (quoting *Employees v. Department of Pub. Health and Welfare*, 411 U.S. 279, 293-94 (1973) (Marshall J., concurring in the result)). Because 28 U.S.C. § 1338(a) (1982) gives federal courts exclusive jurisdiction of copyright suits and prohibits these suits in state courts, "[a]pplying the *Atascadero* . . . holding to a copyright suit against a state would . . . result in *no* forum for infringement of a federal right." W. PATRY, *supra* note 14, at 272 n.70. While the question remains whether Congress contemplated and intended such a result, one party has noted that the Supreme Court apparently has never "upheld an Eleventh Amendment bar where Congress has granted exclusive federal court jurisdiction." Supplemental Brief on Appeal of Amici Curiae at 9, *Mihalek*, No. 85-1593; see *infra* notes 311-14 and accompanying text.

305. See *Mihalek*, 595 F. Supp. at 905-06; *Anderson*, 633 F. Supp. at 1158; cf. *Wolcher*, *supra* note 33, at 207 n.66 (noting arguable theory that "Congress' art. 1 powers antedate the eleventh amendment and might therefore be seen as having been impliedly limited by it," and that "unlike the fourteenth amendment . . ., Congress' art. 1 powers do not 'by their own terms embody limitations on state authority'") (quoting *Fitzpatrick*, 427 U.S. at 456).

One can argue, however, that state copyright infringement does constitute a fourteenth amendment violation. The fifth amendment proscription that "private property [shall not] be taken for public use, without just compensation," U.S. CONST. amend. V, has been applied to the states through the fourteenth amendment. See *Penn Central Transp. Co. v. New York City*, 438 U.S. 104 (1978). This argument fails, however, because the Supreme Court has recognized a fourteenth amendment limitation on constitutional immunity only

remains a necessary ingredient to nullify constitutional immunity in infringement cases. In addition, consent is not implicit in the mere violation of a federal copyright statute.<sup>306</sup> Because state consent to federal jurisdiction is absent, a state's alleged infringement, without more, does not constitute implied waiver. The eleventh amendment, therefore, continues to protect states from copyright infringement suits in federal court.

### E. A Proposed Solution

Copyright proponents might argue that because infringement claims are exclusive to the federal courts,<sup>307</sup> the foregoing analysis would leave owners of works infringed by states a right without a

when Congress expressly limits such protection by "appropriate legislation." See, e.g., *Atascadero*, 105 S. Ct. at 3145 (quoting *Fitzpatrick*, 427 U.S. at 456); see also *Porter v. United States*, 473 F.2d 1329, 1337 (5th Cir. 1973) (holding that "[copyright] infringement is not a 'taking' as the term is constitutionally understood . . . [and that] infringement of copyright . . . constitutes a tort"). But see *Lemelson v. Ampex Corp.*, 372 F. Supp. 708 (N.D. Ill. 1974) (holding that patent infringement constituted "unlawful taking"). Alternatively, a potential claim that infringement constitutes a deprivation of civil rights under color of state law, see 42 U.S.C. § 1983 (1982), would not override automatically a state's eleventh amendment immunity. See *Quern v. Jordan*, 440 U.S. 332, 342 (1979) (holding that 42 U.S.C. § 1983 does not abrogate eleventh amendment immunity). Thus, a claim of "taking" or of a § 1983 violation by a state, to be brought in federal court, still might require a finding of state waiver of constitutional immunity.

However, in *Maine v. Thiboutot*, 448 U.S. 1 (1980), the Supreme Court ruled that § 1983 was available to remedy violations of federal statutory rights by state agents. The availability of this remedy was limited in a later Supreme Court case. In *Middlesex County Sewerage Auth. v. National Sea Clammers Ass'n*, 453 U.S. 1 (1981), the Court held that a comprehensive remedial scheme provided by Congress precludes additional private remedies under § 1983. The 1976 Act can be viewed as a "comprehensive remedial scheme," thereby making § 1983 unavailable in copyright infringement suits against states. But see *Wright v. City of Roanoke Redevelopment and Hous. Auth.*, 55 U.S.L.W. 4119 (U.S. Jan. 14, 1987) (No. 85-5915) (holding that the Housing Act and the Brooke Amendment are not sufficiently comprehensive to indicate a congressional intent to preclude § 1983 claims to enforce tenants' federal statutory rights).

Under Justice Brennan's revisionist interpretation of the eleventh amendment, see *supra* note 118, which has not been accepted by a majority of the Court, federal court infringement suits against the states could be brought under a statute passed pursuant to the copyright and patent clause. Dissenting for a minority of four in *Atascadero*, Justice Brennan stated that "[i]f federal jurisdiction is based on the existence of a federal question . . . , the Eleventh Amendment has no relevance. There is thus no Article III limitation on otherwise proper suits against States by citizens, non-citizens, or aliens . . . ." *Atascadero*, 105 S. Ct. at 3178 (Brennan, J., dissenting); see also W. PATRY, *supra* note 14, at 272 n.70 (stating that "copyright suits are based on a constitutional right (Article 1 § 8 cl. 8), ceded by the states to the federal government and thus cannot be said to 'implicate[] the fundamental constitutional balance between the Federal government and the states'" (quoting *Atascadero*, 105 S. Ct. at 3145-46)).

306. See *Parden*, 377 U.S. at 192; *supra* notes 273-80 and accompanying text.

307. See 28 U.S.C. § 1338(a) (1982).

remedy.<sup>308</sup> While the Supreme Court in *Parden* stated that such a “pointless and frustrating” result would be surprising,<sup>309</sup> the *Employees* Court stated that it also would be surprising to infer abrogation of constitutional immunity without a showing of clear congressional intent.<sup>310</sup> Viewing the 1909 and 1976 Acts in conjunction with Supreme Court implied immunity holdings, the analyses suggested by *Parden*, *Fitzpatrick*, and later cases lead to the conclusion that Congress does not have the power to effect, nor did the states consent to, abrogation of eleventh amendment protection in infringement cases. The correct legal analysis, however, does not necessarily lead to the proper outcome. Copyright protection against the states remains a legitimate economic concern to owners.

Two possible judicial and legislative approaches could provide this protection. Federal courts might follow *Mills Music*'s expansion of the *Fitzpatrick* holding and find congressional power to unilaterally nullify the eleventh amendment in the copyright field. The right to sue infringing states in federal court, however, would come at a great cost. Allowing federal suit against nonconsenting states whenever Congress desired would render the eleventh amendment practically void. This expansion of *Fitzpatrick* arguably would allow Congress, when acting pursuant to its article I powers, to unilaterally nullify sections of the Constitution at will—a clearly unconstitutional result.<sup>311</sup>

Conversely, eleventh amendment immunity need not preclude vindication of the copyright owner's rights. Because the 1909 and 1976 Acts have nullified common law sovereign immunity in infringement cases,<sup>312</sup> a copyright claim could be brought in state court if federal court copyright jurisdiction were no longer exclusive, but merely concurrent with state court jurisdiction.<sup>313</sup> In fact, many states expressly have waived tort liability in state constitutions, statutes, and judicial decisions.<sup>314</sup> Thus, in order to afford

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308. See, e.g., Appellant's Brief on Appeal at 9-10, *Mihalek*, No. 85-1593. In addition, the eleventh amendment remains a bar where federal courts are given exclusive jurisdiction not by Congress, but by the Constitution itself, as in *in rem* admiralty cases. See U.S. CONST. art. III, § 2; *In re State of New York*, 256 U.S. 490 (1921).

309. *Parden*, 377 U.S. at 190, 197.

310. *Employees*, 411 U.S. at 285.

311. See U.S. CONST. art V (detailing procedure for amending U.S. Constitution).

312. See *supra* notes 237-44 and accompanying text.

313. See 28 U.S.C. § 1338(a) (1982) (containing exclusive federal copyright jurisdiction).

314. See, e.g., ALASKA CONST. art II, § 21 (outlining the procedure and requirements

copyright owners a remedy when their rights are infringed by a state, Congress need only amend the jurisdictional statute for copyright claims.<sup>315</sup>

While exclusive jurisdiction empowering only federal courts to hear copyright claims may guarantee parties the expertise of a judge familiar with issues of federal law, state court judges are not incompetent to hear copyright cases. State courts, for example, often entertain pendant federal questions.<sup>316</sup> Although granting state courts the sole jurisdiction to hear federal copyright claims against the states appears anomalous, an exception to the jurisdictional statute would provide at least some forum to hear otherwise unvindicated federal copyright claims.<sup>317</sup> Theoretically, this solution is more sound than amending the 1976 Act to specifically include states as defendants. In light of current Supreme Court eleventh amendment jurisprudence, a statutory amendment to the 1976 Act would rest upon the incorrect premise that Congress has the power to abrogate nonconsenting states' eleventh amendment immunity in the copyright field.<sup>318</sup>

for private suits against the state); HAWAII REV. STAT. §§ 662-2, -3 (1984) (granting tort immunity waiver and vesting state circuit courts with exclusive jurisdiction to entertain claims); *Lockaby v. Wayne County*, 406 Mich. 65, 276 N.W.2d 1 (1979) (allowing relief for intentional torts by the state). See generally Note, *supra* note 10, at 526-37.

315. One party has argued:

While 28 U.S.C. § 1338(a) grants federal courts exclusive jurisdiction over federal statutory copyright infringement actions, such was not always the case. Prior to 1870 state courts had concurrent jurisdiction for all copyright infringement lawsuits. *Woolsey v. Judd*, 11 How. Pr. 49, 52 (N.Y. Sup. Ct. 1855) . . .; see Revised Statutes § 711 (1906); Act of July 8, 1870, ch. 230, 16 Stat. 215; *Boucicault v. Fox*, 3 F. Cas. 977, 981 (C.C.S.D.N.Y. 1862) (No. 1,691) ("the jurisdiction of the state courts, in suits to protect the owners of manuscripts, is complete"). Thus, a copyright owner's inability to seek redress against an infringing state is not the fault of the Eleventh Amendment, but rather of Congress due to its refusal to grant state courts concurrent jurisdiction.

Brief on Appeal of Appellee at 29, *Cardinal Indus.*, No. 86-3354.

Although the success of this tactic appears improbable, a copyright owner also could seek passage of a private bill in the state legislature granting compensation for state infringement.

316. See, e.g., *Smith v. Bull Run School Dist.* No. 45, 722 P.2d 27, 29 (Ore. App. 1986) (deciding appeal concerning claims against a school district under federal equal pay statutes, passed pursuant to the commerce clause, which would be barred from federal court by the eleventh amendment). In addition, state courts have concurrent jurisdiction over trademark infringement cases arising under the Lanham Act. See *Flagship Real Estate Corp. v. Flagship Banks, Inc.*, 374 So. 2d 1020 (Fla. Dist. Ct. App. 1979); 1 J. GIBSON, TRADEMARK PROTECTION AND PRACTICE § 8.02 (1985).

317. See *Atascadero*, 105 S. Ct. at 3146 n.2 (stating that "[i]t denigrates the judges who serve on the state courts to suggest that they will not enforce the supreme law of the land") (citing, *inter alia*, *Martin v. Hunter's Lessee*, 1 Wheat, 304, 341-344 (1816)).

318. See *supra* notes 293-306 and accompanying text.

## V. CONCLUSION

The recently renewed but judicially unresolved debate concerning copyright protection against infringement by the states brings into sharp focus the competing values expressed in the eleventh amendment and the copyright and patent clause. The current proliferation of copyright infringement suits against states requires timely resolution of the immunity issue. A proper resolution will serve not only the federal government's interests in promoting both federalism and individual creativity, but also the copyright owner's economic interests. One must assume that Congress, by granting federal courts exclusive jurisdiction to hear copyright cases, intended, in light of the eleventh amendment, to preclude federal court copyright suits against states. Instead of the drastic course followed in *Mills Music*, amendment of the jurisdictional statute would afford copyright owners relief from state infringement while avoiding the otherwise inevitable evisceration of the eleventh amendment. Accordingly, this Recent Development concludes that Congress should amend 28 U.S.C. § 1338(a) to provide that private individuals may sue infringing states in state court for copyright infringement. This approach best reconciles the conflict between a proprietor's interest in his work, protected by the 1909 and 1976 Acts, and the states' immunity from suit in federal court, guaranteed by the eleventh amendment.

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