CONSTITUTIONAL CONFLICT: INTELLECTUAL PROPERTY RIGHTS AND THE ELEVENTH AMENDMENT

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The Patent and Copyright Clause (Article I, Section 8, Clause 8 of the United States Constitution) gives Congress has the power "[t]o Promote the Progress of Science and useful Arts, by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." Congress has created other limitations besides time, but the patent or copyright holder's protection against infringement is still substantial, even where the government is the infringer. The federal government can use that property without permission but not without compensation, while almost any remedy available against private persons or corporation is also available against State infringers.

The last statement, however, became true only recently. For many years, the infringed could obtain injunctions against the States, while the Eleventh Amendment of the United States Constitution[1] was held to bar damage actions. The Supreme Court has stated the Amendment could fall to Congressional will but only when Congress made itself sufficiently clear. ~~Unfortunately, the~~ Court ~~was not always clear~~ about when Congress was clear, and it never decided a case involving IP rights and the Eleventh Amendment. So the question fell to the lower federal courts; those courts had to try to anticipate the Supreme Court and try to figure out whether Congress said clearly whether it wanted the States subject to IP laws.

This paper will summarize the struggle those courts made over the last thirty years. Then, it will go back and recount what those courts had to work with--the history of the Eleventh Amendment and the Court's relevant decisions. Next, it recounts the Congressional response, which rewrote IP laws to make the States liable for infringement. The penultimate section points out the indirect and unobvious support from the Court for such that Congressional action. Finally, this paper will show Congress finally made itself clearly understood to the judiciary.

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[1]The Eleventh Amendment reads:

> 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.

I. THE LOWER FEDERAL COURTS GRAPPLE WITH INTELLECTUAL PROPERTY RIGHTS AND THE ELEVENTH AMENDMENT

The Eleventh Amendment and IP first collided at the very end of the nineteenth century in Howell v. Miller.[2] Justice Harlan, writing as a Circuit Justice on a Circuit Court of Appeals panel, upheld the right of the infringed to enjoin the State in a copyright infringement case. (The panel refused to grant the injunction for other reasons.) Less than ten years later, the Supreme Court gave its tacit approval to, and expanded the scope of, that decision in Ex Parte Young.[3] So, for most of this century, injunctive relief could be granted against the infringing State officer.

Fifty years later, an infringed sought to recover damages from a State infringer in Withol v. Crow.[4] The plaintiff sued an individual, a church, and an Iowa school district for copying his copyrighted song. Upon holding the school district part of the State and finding the State had not consented to the suit, the Eighth Circuit dismissed the action against the school district because of the Eleventh Amendment.[5]

Two years later, in Parden v. Terminal Railway of Alabama Docks Dept.,[6] the Supreme Court decided the States could implicitly waive their immunity by participating in an activity governed exclusively by Congress. In the decade after Parden, the federal courts decided only two IP cases involving State infringers and those cases ended in different results. In Hercules, Inc. v. Minnesota State Highway Dept.,[7] the district court ignored Parden to focus on Young. In a patent infringement case, the court upheld an injunction against the State but refused to grant any damages to the plaintiff. On the other hand, in Lemelson v. Ampex Corp.,[8] another district court granted damages against a State for patent infringement. The court acknowledged both Hercules and Parden but followed

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[2] 91 F. 129 (6th Cir. 1898).
[3] Ironically, Justice Harlan dissented in this case.
[4] 309 F.2d 777 (8th Cir. 1962).
[5] 309 F.2d, at 781.
[6] See note 28 for citation and accompanying text for elaboration.
[7] 337 F. Supp. 795 (D. Minn. 1972).
[8] 372 F. Supp. 708 (N.D. Ill. 1974).

the latter case.

Five years later, in 1979, the Ninth Circuit faced the issue in Mills Music, Inc. v. State of Arizona.[9] Here, the plaintiff sued the State for using his copyrighted song in promotion of and as part of its annual fair. The Ninth Circuit looked at the Copyright Act of 1976 (Title 17 of the United States Code) and held the term "any person shall infringe" in §501 to be a "sufficient indication of the intent to include states...."[10] The court also held the Patent and Copyright Clause of the Constitution abrogated the States' Eleventh Amendment immunity and preempted the States' ability to interfere with the exclusive rights granted by the Clause.[11]

The controversy, however, did not end. One district court put Mills Music aside.[12] While acknowledging the propriety of injunctions, the district judge focused on the decision in Edelman v. Jordan,[13] which prohibited damage suits against the States. On the other hand, another district court affirmed the holding of Mills Music concerning abrogation.[14]

Then came the Supreme Court's decision in Atascadero State Hospital v. Scanlon.[15] While one court disliked the idea of "allow[ing] states to violate the federal copyright laws with virtual impunity,"[16] no Court of Appeals found sufficient language in the patent or copyright laws to meet the Atascadero standard-that the statute be unequivocal and unmistakable about its intent to abrogate the Eleventh Amendment.[17] As a result, the infringed lacked adequate remedies against State infringement of IP.

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[9]591 F.2d 1278 (9th Cir. 1979).
[10]591 F.2d, at 1285.
[11]591 F.2d, at 1285.
[12]Mihalek Corp. v. Michigan, 595 F. Supp. 903 (E.D. Mich. 1984), affirmed on other grounds, 814 F.2d 290 (6th Cir. 1987).
[13]See note 35, infra for citation and accompanying text for elaboration.
[14]Johnson v. University of Virginia, 606 F. Supp. 321 (W.D. Va. 1985).
[15]See notes 37 and 43, infra for citation and accompanying text for elaboration.
[16]BV Engineering v. University of California, Los Angeles,858 F.2d 1394 (1988).
[17]See BV Engineering, supra; Richard Anderson Photography v. Radford University, 852 F.2d 114 (4th Cir. 1988) (copyright infringement); Lane v. National Bank of Boston, 871 F.2d 166 (1st Cir. 1989) (copyright infringement); Chew v. State of California, 893 F.2d 331 (Fed. Cir. 1990) (patent infringement).

II. THE HISTORY OF THE ELEVENTH AMENDMENT

A. Supreme Court Cases

1. The First Hundred Years

The Eleventh Amendment emerged from the Supreme Court's unpopular decision in Chisolm v. Georgia.[18] Chisolm, a citizen of South Carolina, sued Georgia over a Revolutionary War debt. Unwilling to remit what it owed and believing in its sovereign immunity, Georgia did not even appear for the trial. When it lost, the State asserted its defense at appeal. The Supreme Court, however, found no provision for State sovereign immunity in the Constitution and allowed the judgment to be entered. One member of the Court, Justice Iredell, however, dissented;[19] looking at it from the reverse, he found no provision in the Constitution for a State to be sued in assumpsit by a private citizen in federal court. Justice Iredell's dissent, however, would not be forgotten.

I think you need to discuss & quote Iredell's opinion

After starting the process the day after the Chisolm decision, the first post-Bill of Rights Amendment passed a year later. The Eleventh Amendment seemed written simply to overturn Chisolm. For almost a hundred years, the Supreme Court read it as such. For example, "the [Chief Justice] Marshall Court never found the Eleventh Amendment a bar in any important constitutional case",[20] as "Marshall limited the Amendment to its narrowest, most literal reading."[21] After the Marshall era ended, the Court became more ambivalent; its decisions became very hard to predict and it often overruled itself. Eventually, the pendulum swung the other way as the Court slowly started to bar actions against the States more frequently.

Finally, a late nineteenth-century Supreme Court completely refuted Chisolm and

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[18] 2 U.S. (2 Dall.) 419 (1793).
[19] 2 U.S. (2 Dall.), at 429.
[20] Copyright Liability of States and the Eleventh Amendment: A Report by the Register of Copyrights, 33 (1988).
[21] Ibid., at 35 (discussing Cohens v. Virginia, 19 U.S. (6 Wheat.) 264 (1821)).

read the Eleventh Amendment very broadly. In Hans v. Louisiana,[22] the State issued various bonds and validated by the legislature as a binding contract. Later, the same legislature allowed the interest on those bonds to be spent by the State instead of paid to the bondholders. The plaintiff, as a bondholder, sued Louisiana in federal court under the Contract Clause of the Constitution. The State claimed it was immune from suits in federal court it did not consent to. The Court unanimously upheld the sovereign immunity defense based on the Eleventh Amendment, although the Amendment does not literally include States sued by their own citizens. The writings of Alexander Hamilton and various other Framers as well as Iredell's Chisolm dissent formed the bases for the opinion written by Justice Bradley.

2. The Emergence and Evolution of the Limitations on the Eleventh Amendment

a. The Young Fiction for Injunctive Relief

While the Court significantly broadened the meaning of the Eleventh Amendment in Hans, it soonafter made two limitations-one broad but theoretical and the other more straightforward but limited. The Court created the latter limitation-a small but significant restriction to Hans-in Ex Parte Young.[23] In Young, shareholders in a railroad successfully enjoined the Minnesota Attorney General (AG) from enforcing railroad rates. After being jailed for failing to adhere to the injunction, the AG sought a writ of habeus corpus. In creating its famous fiction, the Court found a State incapable of violating the Constitution; it found State officials, however, to be quite capable of doing so. Since the State likewise could not authorize an unconstitutional act, the official did not enjoy the State's sovereign immunity and could be enjoined from further unconstitutional conduct. The Court denied the writ and allowed the injunction to stand. The decisions in Howell, supra, and in Young gave the infringed the ability to stop State infringers upon discovering the infringements and locating the relevant State official.

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[22]134 U.S. 1 (1890).
[23]209 U.S. 123, 28 S. Ct. 441, 52 L. Ed. 714 (1908).

b. Waiver

The Court created the broad but theoretical limitation when it held States could waive their Eleventh immunity in Clark v. Barnard[24] and reaffirmed this principle in Gunter v. Atlanta Coast Line Railroad.[25] This was not revolutionary; private persons can waive a lack of personal jurisdiction to defend themselves in a trial. The theoretical aspect, however, came from the question of what constituted consent for the States.

The Court first found an implicit consent for two States to be sued in Petty v. Tennessee-Missouri Bridge Commission.[26] When those States entered a compact to build and operate a bridge, they included a provision allowing the commission to "sue or be sued." Writing for the Court, Justice Douglas found this to be a valid waiver of the States' Eleventh Amendment immunity and refused to bar the action.[27]

In Parden v. Terminal Railway,[28] the Court extended the concept of a State's implicit waiver of its Eleventh Amendment immunity. Employees of the Terminal Railway, owned and operated **for profit** by the State of Alabama, suffered injuries during their employment. They sued under the Federal Employees' Liability Act (FELA).[29] From the statute, Justice Brennan found Alabama's operation of a railroad to be an entry into interstate commerce, over which Congress has plenary authority. This entry qualified as implied consent to be sued under FELA.[30]

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[24]108 U.S. 436, 2 S. Ct. 878 (1883) (immunity from suit a personal privilege a State can waive at its pleasure).

[25]200 U.S. 273, 26 S. Ct. 252 (1906) (State can waive its immunity).

[26]359 U.S. 275, 79 S. Ct. 785, 3 L. Ed. 2d 804 (1959).

[27]While Justice Douglas did deliver the opinion of the Court with three Justices dissenting, three other Justices, concurring in the judgment, eviscerated some, if not all, of the reasoning behind the opinion.

[28]377 U.S. 184, 84 S. Ct. 1207, 12 L. Ed. 2d 233 (1964).

[29]45 USC §§51-60. The relevant part of FELA made liable every "common carrier by railroad...engaging in interstate commerce between any of the several States."

[30]Writing for himself and three others, Justice White dissented and disagreed with the implied waiver concept. Citing Murray v. Wilson Distilling Co., 213 U.S. 151, 171, 29 S. Ct. 458, 464, 53 L. Ed.. 742 (1909), he contended the States could waive their Eleventh Amendment immunity only by the most express language or by an overwhelming implication. 377 U.S., at 200; 84 S. Ct., at 1216. For the record, Justice White's reference is improper. While Murray is an Eleventh Amendment case, it has nothing to do with waiving sovereign immunity. The respondents in the case asserted the petitioners were not the State and, therefore, could not assert the sovereign immunity defense. The citation to Murray relates to whether the State had divested itself of certain powers, not whether it had waived its sovereign immunity in federal court. No analogy or other construct is used by Justice White; it is simply cited as legitimate precedent.

A decade later, the plaintiffs in Employees of Department of Public Health and Welfare v. Missouri[31] were less fortunate. As described by the style of the case, they sued their employer for overtime benefits, liquidated damages, and attorney fees under the Fair Labor Standards Act (FLSA).[32] The District Court dismissed the case due to the Eleventh Amendment bar. Believing Parden controlled, the Court of Appeals for the Eighth Circuit panel reversed; it was overruled, however, en banc. Justice Douglas, a Parden dissenter, affirmed the Court of Appeals en banc; he held the FLSA could not be applied to State employees because of the Eleventh Amendment.[33] In distinguishing Parden, Justice Douglas pointed out Missouri operated its hospitals on a not-for-profit basis,[34] and he did not find Congress intended to make those hospitals liable for damages.[35]

The Court also limited the scope of equitable relief. In Edelman v. Jordan,[36] the plaintiff filed a class action suit, alleging State officials improperly administered an aid program and violated federal regulations and the Fourteenth Amendment. The District Court ordered injunctive relief and restitution and the Court of Appeals affirmed. Justice Rehnquist recognized Young's precedential weight in allowing equitable relief against the

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[31]411 U.S. 279, 93 S. Ct. 1614, 36 L. Ed. 2d 251 (1973).

[32]29 U.S.C. 216(b).

[33]Some of Justice Douglas' reasoning in this case is illogical. He noted Congress had changed several sections in the FLSA to include States as defendants, yet he thought Congressional intent was still unclear because one other section involving jurisdiction had been left untouched. Had the Congress not thought the federal courts would have jurisdiction, however, they would not have bothered to change the other sections.

[34]In his dissent, Justice Brennan asserted the majority was completely at odds with Maryland v. Wirtz, 392 U.S. 183, 88 S. Ct. 2017, 20 L. Ed. 2d 1020 (1968). In that case, several States tried to enjoin the FLSA from being enforced against them. Writing for The Court, Justice Harlan refused

> to carve up the commerce power to protect enterprises indistinguishable in their effect on commerce from private businesses, simply because those enterprises happen to be run by the States for the benefit of their citizens.

Wirtz, 392 U.S., at 198-99; 88 S. Ct., at 2025 (footnote deleted). Likewise, the Court refused to grant the injunction.

[35] Justice Douglas, however, did not specify whether he was referring to implied waiver or abrogation. He merely said Congress had not spoken clearly enough. Justice Douglas also maintained his reading of the relevant sections of the FLSA did not make another section of the Act meaningless. Under §16(c) of the FLSA (29 U.S.C. 216(c)), the United States Secretary of Labor had standing to sue in the plaintiff's behalf for an injunction or restitution or both. (While the Court later ruled out any retrospective relief against the States, the Eleventh Amendment does not bar the United States from suing one or more of the individual States. See Principality of Monaco v. Mississippi, 292 U.S. 313, 54 S. Ct. 745, 78 L. Ed. 2d 714 (1934).) For Douglas, that was why Congress had specified the States in the FLSA.

[36]415 U.S. 651, 94 S. Ct. 1347, 39 L. Ed. 2d 662 (1974).

States, but he limited it to prospective, instead of retrospective, relief. As for Parden and Employees, Justice Rehnquist stressed that the present case was different because the relevant statute did not authorize suits against anyone, let alone States.

The Supreme Court did not give waiver as much attention after the Edelman decision. In Atascadero State Hospital v. Scanlon,[37] the Court recited the waiver standard and found that standard had not been met by the State's acceptance of federal funds; for those and other reasons, California's Eleventh Amendment immunity was upheld.[38] After Atascadero, another doctrine eclipsed waiver as the path through the Eleventh Amendment.

c. Abrogation

While the decision in Parden followed up on the concept of implied waiver in Petty, another similar idea also emerged. In writing the Parden opinion, Justice Brennan noted that, with the ratification of the Constitution, Congress had plenary authority to regulate interstate commerce, while, simultaneously, Alabama had ceded all its authority to do so.[39] In other words, Congress could abrogate the Eleventh Amendment under its authority to regulate interstate commerce.

After Parden, abrogation did not make much impact on the Court's Eleventh Amendment decisions. This, however, changed in 1976 with the decision in Fitzpatrick v. Bitzer.[40] Here, male employees of the State of Connecticut alleged the State sexually discriminated against them in its retirement plan in violation of Title VII of the 1964 Civil Rights Act.[41] The Court of Appeals for the Second Circuit had thought the decision in

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[37]473 U.S. 234, 105 S. Ct. 3142, 87 L. Ed. 2d 171 (1985).

[38]While Justice Powell articulated the standard, it is less clear whether he actually applied that standard. In the opinion, he merely wrote the Rehabilitation Act "falls far short of manifesting a clear intent to condition participation in the programs funded under the Act on a State's consent to waive its constitutional immunity." Atascadero, at 3149-50.

[39]377 U.S., at 192; 84 S. Ct., at 1212. Chief Justice Marshall agreed with this sentiment. See J. Orth, The Judicial Power of the United States, The Eleventh Amendment in American History, 39 (1987).

[40]427 U.S. 445, 96 S. Ct. 2666, 49 L. Ed. 2d 614 (1976).

[41]Otherwise known as 42 USC §2000e, it defined persons to include "government, government agencies, and political subdivisions." Likewise, it defined the employees that it covered to include "those subject to the civil service laws of a State government[or] government agency."

Edelman foreclosed Congress' ability to make States liable for damages and other retroactive relief. The Supreme Court reversed. Because of its specific reference to the States, Justice Rehnquist held the fifth clause of the Fourteenth Amendment to be a sufficient constitutional basis to abrogate the Eleventh Amendment and allow **any** form of relief against a defendant State.[42] A State's consent to the suit or its waiver of immunity was not required for it to be a defendant.

Then came Atascadero State Hospital v. Scanlon,[43] where the plaintiff claimed the hospital did not hire him due to a physical handicap in violation of the Rehabilitation Act.[44] The Court of Appeals held the State implicitly consented to the suit by accepting federal funding. The Supreme Court reversed. Answering the plaintiff by summing up three precedents, Justice Powell reaffirmed that Congressional action in abrogating the Eleventh Amendment must be unequivocal, unmistakable, and specific.[45]

While implicitly overruling Parden in Atascadero, the Supreme Court did so more explicitly in Welch v. Texas Dept. of Highways and Public Transportation.[46] The plaintiff, an employee of the State, sued under the Jones Act which applied FELA to sailors. The Court of Appeals en banc found the State immune from the action. In affirming the lower court, the Supreme Court, per Justice Powell, upheld Atascadero and overruled Parden to the extent it did not require unmistakably clear language from Congress in abrogating the Eleventh Amendment.[47]

After being unable to write an Eleventh Amendment opinion for the Court since Parden, Justice Brennan cobbled together four other votes in Pennsylvania v. Union

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[42]In Hutto v. Finney, 437 U.S. 678, 98 S. Ct. 2565, 57 L. Ed. 2d (1978), the Court upheld the granting of attorney fees against a State.

[43]473 U.S. 234, 105 S. Ct. 3142, 87 L. Ed. 2d 171 (1985).

[44]29 USC §794. That statute prohibited discrimination based on a disability "under any program or activity receiving Federal financial assistance." 29 USC §794a stated that remedies were "available to any person aggrieved by any act or failure to act by any recipient of Federal funds."

[45]These criteria come from Employees as well as Pennhurst State School v. Halderman, 465 U.S. 89, 104 S. Ct. 900, 79 L. Ed. 2d 67 (1984) (Pennhurst II) and Quern v. Jordan, 440 U.S. 332, 99 S. Ct. 1139, 59 L. Ed. 2d 358 (1979). None of these criteria, however, appeared in the decision in Fitzpatrick.

[46]483 U.S. 468, 107 S. Ct. 2941, 97 L. Ed. 2d 389 (1987).

[47]Welch, 107 S. Ct., at 2948. The issue of implied waiver was never presented to the Court.

Gas.[48] Here, the State inadvertently ruptured a coal tar deposit and polluted a creek. Being sued by the United States for environmental law violations, the Union Gas Company then sued Pennsylvania as a third party defendant for negligence.[49] The Court of Appeals eventually reversed the District Court, which had dismissed the third-party complaint.

Justice Brennan had two points he wanted to make in Union Gas and did get a majority for each of them; each majority, however, did not include the same justices. In his first point, Brennan found the two relevant environmental statutes,[50] **when read together**, provided a sufficient basis for abrogating the States' sovereign immunity for damage suits. Brennan persuaded four other Justices, including Justice Scalia, to join him. Justice White, joined by the three remaining Justices, dissented on this point.

In his second point, Justice Brennan held the Commerce Clause provided a sufficient basis for Congressional abrogation of the States' sovereign immunity.[51] Brennan had written since Parden the States surrendered their sovereignty with respect to regulating interstate commerce at the country's creation. For Brennan, when Congress got plenary power in that area, the States had to yield their immunity. Brennan examined the rationale behind Fitzpatrick, which allowed Congress to abrogate the Eleventh Amendment in enacting statutes under the authority of the Fourteenth Amendment. He noted that, "[l]ike the Fourteenth Amendment, the Commerce Clause with one hand gives power to Congress, while, with the other, it takes power away from the States."[52] He found that, when Congress passed such environmental laws and regulations, it meant to include States.

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[48]109 S. Ct. 2273 (1989).

[49]Had it wanted to, the United States could have sued Pennsylvania directly. See parenthetical text in note 35, supra.

[50]The two statutes were Comprehensive Environmental Response, Compensation, and Liability Act of 1980 (CERCLA), 42 U.S.C. §9601 et. seq., and the Superfund Amendments and Reauthorization Act of 1986 (SARA).

[51]Several Courts of Appeals have held Congress can abrogate the Eleventh Amendment with its Article I powers. See McVey Trucking v. Illinois, 812 F.2d 311 (7th Cir. 1987) (Bankruptcy Clause); Mills Music , supra (Patent and Copyright Clause) ; Peel v. Florida Department of Transportation, 600 F.2d 1070 (5th Cir. 1979) (War Powers Clause) ; Jennings v. Illinois Office of Education, 589 F.2d 935 (7th Cir. 1979), cert. denied, 441 U.S. 967 (1979) (War Powers Clause); City of Monroe v. Florida, 678 F.2d 1124 (2nd Cir. 1982) (Extradition Clause).

[52]Union Gas, 109 S. Ct., at 2282.

Justice Scalia refused to join on this point because he opposes the idea of Article I powers overcoming the Eleventh Amendment. Bowing to the Court's decision on the first issue, however, Justice White grudgingly agreed with Justice Brennan (while still managing to disagree with much, if not all, of Brennan's reasoning).[53]

B. The Recent Congressional Response to the Judiciary with Respect to Intellectual Property

After several post-Atascadero Court of Appeals decisions upheld the States' Eleventh Amendment immunities in copyright infringement suits,[54] Congress requested the Register of Copyrights to study the issue and report his findings. The Register reported that the only remedy available to the infringed--the injunction--was inadequate, and that Congress had intended to make State infringers liable with the passage of the Copyright Act of 1976.[55] With the Courts of Appeals rulings on the Supreme Court's Atascadero standard, however, Congress had to make itself even clearer in the statute and it started the process that led to the passage of the Copyright Remedy Clarification Act of 1990,[56] the copyright portion of the IPRCActs. Two years later, Congress followed up with the passage of the Patent and Plant Variety Protection Remedy Clarification Act and the Trademark Remedy Clarification Act. All three IPRCActs specify that an infringer, as defined in the respective Acts, includes a State, a State official, or a State instrumentality.[57]

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[53]Part II of Justice White's concurrence reads, in its entirety, as follows:

> My view on the statutory issue has not prevailed[;] however[,] a majority of the Court has ruled the statute, as amended, plainly intended to abrogate the immunity of the States from suit in the federal courts. I accept that judgment. This brings me to the question whether Congress has the constitutional power to abrogate the States' imunity. In that respect, I agree with the conclusion reached by Justice BRENNAN in Part III of his opinion, that Congress has the authority under Article I to abrogate the Eleventh Amendment immunity of the States, although I do not agree with much of his reasoning.
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> Accordingly, I would affirm the judgment of the Court of Appeals.

Union Gas, 109 S. Ct., at 2295. (The bracketed puncuation was transposed in the original. Also, one footnote was omitted.)

[54]See note 17, supra and accompanying text.

[55]Copyright Liability of States, at vii.

[56]This act made similar amendments to the Semiconductor Chip Protection Act of 1984. See next note for citation.

[57]17 USC §§501, 511 (Copyright Act); 17 USC §§901, 911 (Semiconductor Chip Protection Act); 35 USC §§271, 298 (patent statutes); 7 U.S.C. §§2541, 2570 (Plant Variety Protection Act);15 USC §§1141(1), 1121, 1123(a), 1127 (Lanham [Trademark] Act).

Patent and copyright holders have causes of action only in the federal courts.[71] The jurisdiction for enforcement of federally registered trademarks is not so limited, yet State courts cannot match the scale of the federal courts in granting remedies.[72] Denying the infringed a cause of action in federal court would obviously deny patent and copyright holders any chance at a remedy and would frustrate holders of federally registered trademarks trying to protect that trademark in a nationwide scale.[73] A right to a remedy is not specified in the Constitution and cannot be honored in some cases. In those situations, however, a good reason existed for that denial. An example of this would be the superior position a bona fide purchaser of property would have over the original owner, though the vendor did not have proper title. Here, however, "[t]here is no policy justification for full state immunity to copyright damage suits";[74] the same thing could be said about patent and trademark damage suits.

The absence of a right to a remedy has not gone unnoticed by the Supreme Court. In Parden, Justice Brennan noted that reading "a sovereign immunity exception into the Act would result...in a right without a remedy....We are unwilling to conclude that Congress intended so pointless and frustrating result."[75] In Hilton v. South Carolina Public Railways Com'n,[76] the Court did not bar a suit under FELA in State court. Justice Kennedy's "analysis look[ed] to the reliance of the employees who may be without a remedy if FELA does not apply to their state employers."[77]

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[71] 28 USC §1338(a).

[72] In an attempt to reach the level of federal protection, trademark infringement actions would have to be commenced in each of the States' own courts. This process would be neither as efficient nor inexpensive as going into federal court.

[73] Injunctions, of course, would be permitted, but they would often be inadequate, especially if the infringement has occurred for a long time before the infringed becomes aware of it. See note 54, supra, and accompanying text. Also, alternative causes of action are possible, but the outcomes are very uncertain.

[74] H.R. Rep No. 282(I), 101th Cong., 2nd Sess. 10, reprinted in 1990 U.S.C.C.A.N. 3949, 3958 (citing Subcommittee Hearings of the House Committee on the Judiciary Subcommittee on the Courts, Intellectual Property, and the Administration of Justice, April 12, 1989 (Letter to the Honorable Robert Kastenmeier, Chairman, from Robert D. Evans, Director, Governmental Affairs Office, American Bar Association (Mar. 24 1989))).

[75] Parden, 377 U.S., at 190; 84 S. Ct., at 1211-12.

[76] _ U.S. _, 112 S. Ct. 560, 116 L. Ed. 2d 560 (1991)

[77] _ U.S., at _, 112 S. Ct., at 569 (O'Connor, dissenting).

California's motion to dismiss copyright and trademark infringement counts before passage of the relevant portions of the IPRCActs. With respect to the counts after that date, however, the motion was denied.[87] So, the infringed can collect damages and other non-injunctive remedies against a State copyright infringer for infringements beginning in October 19, 1990; for patents and trademarks, they can do so for infringements after October 28, 1992.[88]

[87]1993 WL 254383, at *18.

[88]A credible argument could be made that even that part of the motion to dismiss should be overruled because the Supreme Court has not decided such a case. The success of that argument, however, is very much in doubt.