NOTE

Big Brother Stole My Patent: The Expansion of the Doctrine of State Sovereign Immunity and the Dramatic Weakening of Federal Patent Law

TABLE OF CONTENTS

INTRODUCTION

The Supreme Court is on a crusade to hand authority back to the states.[1] The Court is convinced that the federal government has too much authority over the states.[2] This constitutional battle seems far away from the world of business, but one of the Court's latest states' rights rulings could harm many corporations and individual inventors.[3] Beware if you publish software that a state university wants for free, or if you own a patent on a medical procedure that a doctor at a state school wants to exploit.[4] States now have the freedom to ignore U.S. intellectual property law and use your patent without compensating you.[5] All of the hard work and investment you put into creating a patent in hopes of an early retirement or huge corporate profit could very likely be for nothing.[6]

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[1] *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 664 (1999) (Stevens, J., dissenting) (stating that Court is championing states' rights); Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 705 (1999) (Breyer, J., dissenting) (arguing that Court is expanding doctrine of sovereign immunity to counter productive levels); Andrew S. Williamson, *Policing the States After* Seminole, 85 GEO. L.J. 1739, 1739-46 (1997) (discussing curtailment of congressional authority over states).

[2] *See* Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 59 (1996) (observing that expansion of federal power has detrimentally altered balance of state and federal power); *see also* City of Boerne v. Flores, 521 U.S. 507, 519 (1997) (noting that Congress has no authority to judge constitutionality of state actions); Christina Bohannan & Thomas F. Cotter, *When the State Steals Ideas: Is the Abrogation of State Sovereign Immunity from Federal Infringement Claims Constitutional in Light of* Seminole Tribe?, 67 FORDHAM L. REV. 1435, 1438 (1997) (stating that *Seminole Tribe* prevents Congress from providing federal forum for various actions against states).

[3] *See* Mike France, *How The High Court Is Penalizing Corporate America*, BUS. WK., Aug. 2, 1999, at 74 (arguing that Court's states' rights agenda harms commerce between states and businesses); *see also* Erwin Chemerinsky, *Permission to Litigate, Sovereign Immunity Lets States Decide Who Can Sue Them*, 85 A.B.A. J. 42, 42-43 (1999) (arguing that Court has revived sovereign immunity by broadening states' Eleventh Amendment immunity).

[4] *See* Jacobs Wind Elec. Co. v. Fla. Dep't of Transp., 919 F.2d 726, 727-28 (Fed. Cir. 1990) (describing patent infringement suit against state of Florida); Chew v. California, 893 F.2d 331, 333-36 (Fed. Cir. 1990) (denying plaintiff relief in state court regardless of whether remedy existed in federal court); 137 CONG. REC. 7330 (1991) (statement of Sen. DeConcini) (noting that state universities commercializing biotechnology will increasingly assert sovereign immunity defense).

[5] *See Florida Prepaid*, 527 U.S. at 653-54 (Stevens, J., dissenting) (noting that states can willfully infringe on patents); *see also* Akhil Reed Amar, *Of Sovereignty and Federalism*, 96 YALE L.J. 1425, 1475-81 (1987) (noting that sovereign immunity is oppressive doctrine because it allows states to commit wrongdoings without fear of punishment).

[6] *See, e.g.*, *Chew*, 893 F.2d at 336 (implying that inventor would be left without remedy for patent infringement).

For example, researchers who developed and patented a leading anticancer drug would seem to be the owners of a highly lucrative product.[7] But once Big State University sees the treasure trove that the patented drug has produced, it will be able to manufacture and sell the drug without having to compensate the researchers.[8] The researchers and the University will be in direct competition, but the researchers will be at a huge disadvantage because federal patent law will not protect their commercial rights.[9] Once Big State University chooses to invoke sovereign immunity, it will not be subject to suit in federal court.[10] Thus, researchers will never invest their time, effort, or money into developing other promising anticancer drugs that can be freely infringed upon by state entities. This scenario represents the kind of conduct that the Supreme Court has endorsed in one of its most recent decisions regarding state sovereign immunity.[11]

On June 23, 1999, the United States Supreme Court decided *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank.*[12] The dispute in *Florida Prepaid* centered around College Savings Bank's patent on a special kind of certificate of deposit.[13] When a Florida state agency, Florida Prepaid Postsecondary Education Expenses Board ("Florida Prepaid"), began selling a similar product, the bank sued for patent infringement.[14] The Supreme Court held that the doctrine of

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[7] *Cf. id.* at 332-35 (noting that state infringed upon inventor's potentially profitable invention).

[8] *See, e.g.*, Mascheroni v. Board of Regents, 28 F.3d 1554, 1559 (10th Cir. 1994) (holding that state university enjoys Eleventh Amendment immunity); Hutsell v. Sayer, 5 F.3d 996, 999-1003 (6th Cir. 1993) (holding that Eleventh Amendment bars suit against state university and employees in their official capacities); Kaimowitz v. Board of Trs., 951 F.2d 765, 767 (7th Cir. 1991) (holding that University of Illinois is alter ego of state and not subject to suit in federal court); Dube v. State Univ., 900 F.2d 587, 594 (2d Cir. 1990) (holding that Eleventh Amendment bars plaintiff's claim against State University of New York); BV Eng'g v. U.C.L.A., 858 F.2d 1394, 1398 (9th Cir. 1988) (holding that state's voluntary participation in copyright field did not demonstrate intent to waive Eleventh Amendment immunity); Harden v. Adams, 760 F.2d 1158, 1164 (11th Cir. 1985) (holding that University of Alabama's board of trustees is entitled to sovereign immunity).

[9] *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 701 (1999) (Breyer, J., dissenting) (noting that Court's holding in *Florida Prepaid* will make it more difficult for private individuals to protect their intellectual property).

[10] *See* Genentech, Inc. v. Regents of the Univ. of Cal., 143 F.3d 1446, 1454 (Fed. Cir. 1998) (detailing how state university invoked sovereign immunity in biotechnology patent case).

[11] Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627 (1999).

[12] *Id.*

[13] *Id.* at 630-31.

[14] *Id.* at 632-33 (detailing bank's claim that State of Florida infringed upon its patent).

sovereign immunity constitutionally immunized the State of Florida from federal intellectual property laws.[15] *Florida Prepaid* extends states' rights to an unprecedented level.[16] States are now virtually free to ignore federal intellectual property law.[17]

This Note examines the Court's condoning of state infringement of patents through the doctrine of sovereign immunity. This Note also explains how *Florida Prepaid* will have the overarching effect of denying patent owners compensation for invasion of their patent rights. Part I describes the legal background of patent protection and state sovereign immunity. Part II examines the facts and the rationale of the Supreme Court's decision in *Florida Prepaid*. Part III argues that for patent law to function as intended, Congress must possess the authority to overcome sovereign immunity for the sake of patent regulation.

I. BACKGROUND

A. Congress's Fourteenth Amendment Power To Abrogate State Sovereign Immunity

The doctrine of sovereign immunity dictates that, under the federal system established by the Constitution, the states retain a residuary and inviolable sovereignty.[18] The Eleventh Amendment confirmed sovereign

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[15] *Id.* at 630 (holding that Congress did not properly design Patent Remedy Act to enforce guarantees of Fourteenth Amendment's Due Process Clause).

[16] *See id.* at 665 (Stevens, J., dissenting) (commenting that Court is expanding sovereign immunity to dramatic level only defined by constitutional penumbras); Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 699 (1999) (Breyer, J., dissenting) (remonstrating Court's extension of sovereign immunity); *see also* France, *supra* note 3, at 74 (commenting on Florida's astonishing defense of constitutional immunity from federal patent law).

[17] *See Florida Prepaid*, 527 U.S. at 652 (Stevens, J., dissenting) (arguing states will now be able to undermine patent law); *College Savings*, 527 U.S. at 701 (Breyer, J., dissenting) (stating that federal remedies will no longer protect intellectual property owners from states).

[18] *See* Alden v. Maine, 527 U.S. 706, 714 (1999) (noting that states retain full dignity of sovereignty); Puerto Rico Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc., 506 U.S. 139, 146 (1993) (recognizing that states maintain attributes of sovereignty, including sovereign immunity); Blatchford v. Native Village of Noatak, 501 U.S. 775, 779 (1991) (stating that states joined into federalist system as sovereign entities); David P. Currie, Ex parte Young *After* Seminole Tribe, 72 N.Y.U. L. REV. 547, 548-50 (1997) (noting that framers forced Supreme Court to recognize sovereign immunity by enacting Eleventh Amendment); *see also* THE FEDERALIST NO. 15, at 108 (Alexander Hamilton) (Clinton Rossiter ed., 1961) (reflecting belief that sovereign must have undividable, final, and unlimited authority). *See generally* Louis L. Jaffe, *Suits Against Governments and Officers: Sovereign Immunity*, 77 HARV. L. REV. 1, 1-15 (1963) (discussing English cases that provided relief against officers of king,

immunity as a constitutional principle.[19] That principle is rooted in a recognition that the states, although a Union, maintain certain attributes of sovereignty.[20]

The Eleventh Amendment presupposes two key concepts.[21] First, each state is a sovereign entity within the federal system.[22] Second, an inherent attribute of sovereignty is immunity from federal lawsuit by individuals.[23] The only exception to this rule occurs when a state consents to suit.[24] Thus, the constitutional principle of sovereign

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despite king's sovereign immunity).

[19] *See Alden*, 527 U.S. at 717-28 (tracing text and history of Eleventh Amendment to preserve state sovereign immunity); Hans v. Louisiana, 134 U.S. 1, 12 (1890) (holding that language of Eleventh Amendment and structure of Constitution presuppose doctrine of state sovereign immunity). *See generally* JOHN E. NOWAK & RONALD D. ROTUNDA, CONSTITUTIONAL LAW § 2.11, at 44-54 (5th ed. 1995) (discussing historical background of Eleventh Amendment).

[20] *See Alden*, 527 U.S. at 757 (noting that principle of sovereign immunity reflects proper balance between supremacy of federal law and separate sovereignty of states); Atascadero State Hosp. v. Scanlon, 473 U.S. 234, 238 (1985) (stating that sovereign immunity embodies fundamental constitutional balance between federal government and states); Chisholm v. Georgia, 2 Dall. 419, 1 L. Ed. 419, 434-35 (1793) (Iredell, J., dissenting) (stating that Constitution clearly intended sovereign immunity doctrine); THE FEDERALIST NO. 81, AT 487-88 (Alexander Hamilton) (Clinton Rossiter ed., 1961) (assuring that Constitution would not take away states' sovereign immunity)

[21] *See* U.S. CONST. amend. XI (stating that judicial power of federal government will not extend to suits against states).

[22] *See Alden*, 527 U.S. at 715 (commenting that advocates of Constitution's ratification recognized states' immunity from suit during Constitutional Convention, and that states still retain sovereignty today); Pennhurst State Sch. & Hosp. v. Halderman, 465 U.S. 89, 98 (1984) (recognizing existence of state sovereign immunity embodied in Eleventh Amendment).

[23] *See* Edelman v. Jordan, 415 U.S. 651, 662-63 (1974) (finding that even though terms of Eleventh Amendment did not bar suits against state by its own citizens, spirit of Eleventh Amendment barred all suits against states); Principality of Monaco v. Mississippi, 292 U.S. 313, 322-23 (1934) (noting that states possess attributes of sovereignty and are immune from suits without their consent); *see also* John T. Cross, *Intellectual Property and the Eleventh Amendment After* Seminole Tribe, 47 DEPAUL L. REV. 519, 532 (1998) (stating that Eleventh Amendment is basically restriction on jurisdiction of federal courts). *But see* John J. Gibbons, *The Eleventh Amendment and State Sovereign Immunity: A Reinterpretation*, 83 COLUM. L. REV. 1889, 1910 (1983) (discussing history of Eleventh Amendment and arguing that Congress did not intend Amendment to remove federal courts' jurisdiction over federal question cases).

[24] *See Principality of Monaco*, 292 U.S. at 322-23 (observing that sovereign immunity does not bar federal jurisdiction over suits against consenting states); Clark v. Bernard, 108 U.S. 436, 447-48 (1883) (holding that states may waive immunity from suit at their pleasure); NOWAK & ROTUNDA, *supra* note 19, § 2.11, at 50-51 (noting that state may expressly waive its sovereign immunity to class of suits or for particular suit); Harold J. Krent, *Reconceptualizing Sovereign Immunity*, 45 VAND. L. REV. 1529, 1530-35 (1992) (noting that doctrine of sovereign immunity means that government is only liable for claims it deems appropriate).

immunity poses a significant bar to federal jurisdiction over suits against nonconsenting states.[25] However, sovereign immunity is not an absolute bar to suits against the states by private individuals.[26]

The Fourteenth Amendment to the federal Constitution guarantees that every citizen will receive equal protection under the law.[27] In particular, the Fourteenth Amendment prohibits states from arbitrarily depriving citizens of their private property.[28] Section Five of the Fourteenth Amendment, the Enforcement Clause, grants Congress the power to enforce the protections of the Fourteenth Amendment by appropriate legislation.[29] The Supreme Court has made clear that the Enforcement Clause empowers Congress to secure the protections of the Fourteenth Amendment by abrogating states' Eleventh Amendment immunity.[30]

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[25] *See* Calvin R. Massey, *State Sovereignty and the Tenth and Eleventh Amendments*, 56 U. CHI. L. REV. 61, 67 (1989) (noting overarching principle that individuals cannot sue states in federal court unless states consent); *see also Alden*, 527 U.S. at 712 (holding that states retain immunity from private suit in their own courts, and Congress cannot abrogate that immunity through use of Article I powers); Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 72 (1996) (holding Congress lacks power to abrogate states' sovereign immunity in suits commenced or prosecuted in federal courts).

[26] *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 637 (1999) (stating that legislation pursuant to Enforcement Clause of Fourteenth Amendment could justify Congress abrogating state sovereign immunity); *see also Alden*, 527 U.S. at 756 (recognizing that Congress may authorize suits against non-consenting states in accordance with Enforcement Clause powers); Fitzpatrick v. Bitzer, 427 U.S. 445, 456 (1976) (holding that Congress retains authority to abrogate state sovereign immunity pursuant to Fourteenth Amendment). *See generally* Amar, *supra* note 5, at 1429-40 (discussing contradictions that abound in Eleventh Amendment jurisprudence regarding Congress's power to abrogate state sovereign immunity).

[27] *See* U.S. CONST. amend. XIV, § 1 (guaranteeing that states will not deprive individuals of their life, liberty or property without due process of law); *see also* United Bhd. of Carpenters v. Scott, 463 U.S. 825, 831 (1983) (holding that Equal Protection Clause of Fourteenth Amendment prohibits states from denying any person equal protection of laws); Shelley v. Kraemer, 334 U.S. 1, 23 (1948) (holding that states cannot deny citizens equal protection of laws guaranteed by Fourteenth Amendment).

[28] *See* U.S. CONST. amend. XIV, § 1 (guaranteeing that states will not deprive persons of property without due process of law); *see also* United States v. Prince, 383 U.S. 787, 789 (1966) (holding that Congress has right to protect citizens against deprivation of property without due process of law).

[29] *See* U.S. CONST. amend. XIV, § 5 (granting Congress authority to enforce provisions of Fourteenth Amendment against states); *see also Alden*, 527 U.S. at 731 (noting Congress may enact appropriate legislation to enforce Fourteenth Amendment); City of Boerne v. Flores, 521 U.S. 507, 530 (1997) (recognizing that Enforcement Clause grants Congress legislative power); Saikrishna Prakash, *A Comment on Congressional Enforcement*, 32 IND. L. REV. 193, 211 (1998) (arguing that Enforcement Clause clearly permits Congress to enforce Fourteenth Amendment against both states and individuals).

[30] *See Seminole Tribe*, 517 U.S. at 72 (reaffirming that Congress has power to abrogate states' Eleventh Amendment immunity); Dellmuth v. Muth, 491 U.S. 223, 227 (1989)

The Court must resolve two issues to determine whether Congress has validly abrogated state sovereign immunity.[31] First, the Court must determine whether Congress has unequivocally expressed its intent to abrogate Eleventh Amendment immunity.[32] Second, the Court must find that Congress acted pursuant to a valid exercise of its power under the Enforcement Clause.[33] The Court clarified the second prong of this test in *City of Boerne v. Flores*.[34]

In *Boerne*, the Archbishop of the Catholic Church applied for a building permit to enlarge a church in Boerne, Texas.[35] Local zoning authorities denied the permit, relying on a local historic preservation ordinance.[36] The Archbishop challenged the decision as a violation of the Religious Freedom Restoration Act of 1993 ("RFRA").[37] RFRA prohibited the government from substantially burdening an individual's exercise of religion.[38] Under RFRA, the government could only justify a burden on religion if it was in furtherance of a compelling governmental interest

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(holding that Congress may abrogate states' sovereign immunity pursuant to Enforcement Clause of Constitution); Pennsylvania v. Union Gas Co., 491 U.S. 1, 7 (1989) (describing abrogation exception to sovereign immunity); Atascadero State Hosp. v. Scanlon, 473 U.S. 234, 238 (1985) (noting that Enforcement Clause is well established exception to sovereign immunity); *Fitzpatrick*, 427 U.S. at 456 (holding that Congress may enforce Fourteenth Amendment by providing for private suits against states); *see also Ex parte* Virginia, 100 U.S. 339, 345 (1879) (observing that framers intended Fourteenth Amendment to be limitation on state power and enlargement of Congress's authority).

[31] *See Alden*, 527 U.S. at 755-56 (noting two express limits on principal of sovereign immunity); *Seminole Tribe*, 517 U.S. at 55 (explaining that Court must resolve two questions to decide if Congress can properly abrogate state sovereign immunity).

[32] *See Seminole Tribe*, 517 U.S. at 55 (noting that Congress must make clear legislative statement describing intent to abrogate state sovereign immunity); *Atascadero*, 473 U.S. at 242 (requiring Congress to show intent to abrogate Eleventh Amendment); Green v. Mansour, 474 U.S. 64, 68 (1985) (holding that Congress must clearly express intent to abrogate state sovereign immunity); Pennhurst State Sch. & Hosp. v. Halderman, 465 U.S. 89, 99 (1984) (requiring unequivocal expression of congressional intent to abrogate Eleventh Amendment).

[33] *See City of Boerne*, 521 U.S. at 536 (noting that Congress can make its own informed judgment on meaning of Constitution when acting within its proper sphere of power); *Seminole Tribe*, 517 U.S. at 55 (holding that Court must consider whether Congress has constitutional authority to enact legislation); *see also Fitzpatrick*, 427 U.S. at 460 (noting that Congress can abrogate state sovereign immunity only if Constitution grants such authority to Congress).

[34] *See City of Boerne*, 521 U.S. at 519-20 (holding that for Congress to invoke Enforcement Clause, Congress must identify conduct that violates Fourteenth Amendment, and tailor legislation to remedy or prevent that conduct).

[35] *Id.* at 507.

[36] *Id.* at 511.

[37] *Id.*

[38] *Id.* at 516 (noting that RFRA applied to both federal and state authorities).

and done in the least restrictive manner possible.[39] The Archbishop contended that RFRA was a legitimate use of Congress's Enforcement Clause powers to protect the free exercise of religion.[40]

The Court held that Congress must design remedial or preventative legislation enacted under the Enforcement Clause in a manner that is congruent and proportional with the injury to be remedied.[41] For Congress to satisfy this requirement, it must identify conduct violating the Fourteenth Amendment and tailor its legislative scheme to remedy or prevent that conduct.[42] The Court found RFRA unconstitutional because RFRA's reach and scope extended Congress's enforcement powers too broadly.[43]

The *Boerne* Court reaffirmed that Congress has wide latitude in determining how to secure individuals' Fourteenth Amendment protections against deprivation of property without due process of law.[44] The Court stated that the Enforcement Clause is a positive grant of legislative power to Congress.[45] The Court further emphasized that the Enforcement Clause grants Congress broad discretion to decide what legislation is necessary to secure the guarantees of the Fourteenth Amendment.[46] Congress's power to constrain the states also extends

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[39] *Id.* at 515-16 (noting that Congress would have to design RFRA in least intrusive manner to further compelling governmental interest).

[40] *Id.* at 529 (arguing that RFRA is reasonable way to protect freedom of religion).

[41] *Id.* at 520 (warning that without this connection, congressional legislation would violate Constitution by interpreting law for itself).

[42] *Id.* at 530 (noting Congress must address each type of constitutional harm with appropriate measures).

[43] *Id.* at 536 (stating Congress would damage separation of powers and federal balance by enforcing RFRA).

[44] *See id.* at 520 (stating that Court allows Congress leeway in determining remedies for unconstitutional acts). *But see* Douglas Laycock, *Conceptual Gulfs in* City of Boerne v. Flores, 39 WM. & MARY L. REV. 743, 767 (1998) (noting Court's concern in *Boerne* that allowing Congress to enact substantive law would violate principles necessary to separation of powers and federalism).

[45] *See City of Boerne*, 521 U.S. at 517 (noting that legislation which deters constitutional violations can fall within Congress's enforcement powers); Ronald D. Rotunda, *The Powers of Congress Under Section Five of the Fourteenth Amendment After* City of Boerne v. Flores, 32 IND. L. REV. 163, 174 (1998) (noting *Boerne's* focus on crucial difference between use of Enforcement Clause to enact substantive law and its use to remedy or prevent constitutional violations).

[46] *See City of Boerne*, 521 U.S. at 535 (stating that Congress has duty to make its own decision on meaning of Constitution when acting within its legitimate constitutional powers). *See generally* Akhil Reed Amar, *Intratextualism*, 112 HARV. L. REV. 747, 818 (1999) (noting that *Boerne* intricately intertwined issues of federalism, separation of powers, and free exercise of religion).

beyond the Fourteenth Amendment.[47]

B. Other Exceptions to Sovereign Immunity: Ex parte Young, Discretionary Grants, and Implied Waivers

The Enforcement Clause does not represent the limit of Congress's ability to regulate state activities.[48] Congress can link federal funds given to the states with concomitant restraints on state behavior.[49] Moreover, the Supreme Court has recognized two doctrines, the legal fiction of *Ex parte Young* and the implied waiver doctrine, both of which limit states' sovereign immunity.[50]

1. Discretionary Waivers

Congress can force states to waive their Eleventh Amendment immunity by accepting federal funds.[51] Congress may, in the exercise of its spending power, condition its grant of funds to the states upon their taking certain actions that Congress could not otherwise compel.[52] The only limitation is that Congress must clearly specify the conditions, and

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[47] *See* Parden v. Terminal Ry. of Ala. Docks Dep't, 377 U.S. 184, 191 (1964) (holding that Congress can exercise its Commerce Clause power to require states to waive their immunity); *see also Ex parte* Young, 209 U.S. 123, 149-50 (1908) (holding that Court will not regard suit seeking injunctive relief against state officers as suit against state for purposes of sovereign immunity).

[48] *See Parden*, 377 U.S. at 196-97 (holding that states can waive defense of sovereign immunity by engaging in interstate commerce); *Ex parte Young*, 209 U.S. at 159-60 (holding that plaintiffs may hold state officials amenable to suit in federal court).

[49] *See* South Dakota v. Dole, 483 U.S. 203, 207-15 (1987) (holding that Congress can condition states' receipt of federal funds on states' acting in accordance with congressional mandates).

[50] *See Parden*, 377 U.S. at 196-97 (holding that when state enters into activities subject to congressional regulation, Congress can regulate state as fully as private person or corporation); *Ex parte Young*, 209 U.S. at 159 (holding that plaintiffs can sue to enjoin state officials and employees from ongoing violations of federal law).

[51] *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 696 (Breyer, J., dissenting) (recognizing that states' acceptance of federal funds creates agreement to waive their sovereign immunity); New York v. United States, 505 U.S. 144, 161, 183-86 (1992) (reaffirming Congress's power to attach conditions to transfer of funds to states so that states will act in accordance with congressional specifications); *Dole*, 483 U.S. at 207-15 (holding that Congress could condition state's receipt of federal highway funding on condition that state adopt minimum drinking age of twenty-one); Petty v. Tennessee-Missouri Bridge Comm'n, 359 U.S. 275, 280 (1959) (holding that Congress could require bistate commission to waive its immunity as condition of receiving Congress's approval of interstate compact).

[52] *See College Savings*, 527 U.S. at 704 (Breyer, J., dissenting) (noting that Congress can require states to take certain actions if states choose to accept federal funds).

design them to further the public interest.[53] The conditions must also be reasonably related to the expenditure.[54] Acceptance of the funds by the state constitutes an agreement to its waiver of state sovereign immunity.[55]

2. The *Ex parte Young* Doctrine

In *Ex parte Young*, the Supreme Court created an exception to state sovereign immunity for suits against state officials.[56] The *Young* Court found individual state officials, but not the states themselves, subject to suit when plaintiffs seek an injunction blocking a continuing violation of federal law.[57] The Court found that when state officers' official conduct

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[53] *See Dole*, 483 U.S. at 210 (listing guidelines for Congress to follow when attempting to use federal funding to compel states to take certain actions); *see also* Daniel J. Meltzer, *The* Seminole *Decision and State Sovereign Immunity*, 1996 SUP. CT. REV. 1, 50-55 (noting conditional spending power of Congress); Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 HARV. L. REV. 1413, 1456-70 (1991) (noting that there is idea that fourth condition of germaneness exists and may limit Congress's aggressive use of its commerce power).

[54] *See Dole*, 483 U.S. at 211 (noting that Congress's goal of state adopting minimum drinking age must be reasonably related to federal highway funding).

[55] *See College Savings*, 527 U.S at 696 (Breyer, J., dissenting) (noting that Congress often asks states to choose between their sovereign immunity and gifts or gratuities); *Dole*, 483 U.S. at 210 (noting that Congress cannot require states to engage in unconstitutional activities).

[56] *See College Saving*, 527 U.S. 666, 704 (1999) (Breyer, J., dissenting) (recognizing that Congress may achieve federal regulatory objective through *Ex parte Young* doctrine); Alden v. Maine, 527 U.S. 706, 756-57 (1999) (noting that sovereign immunity does not bar *Ex parte Young* actions); Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 73 (1996) (noting that Court has often permitted suits against state officials to end continuing violations of law); *Ex parte Young*, 209 U.S. at 159-60 (creating exception to general doctrine of state sovereign immunity). *But see* Currie, *supra* note 18, at 550 (arguing that *Seminole* may preclude use of *Ex parte Young* doctrine in cases involving statutory rights). *See generally* RICHARD H. FALLON ET AL., HART AND WECHSLER'S THE FEDERAL COURTS AND THE FEDERAL SYSTEM 1073-84 (4th ed. 1996) (summarizing federal courts' use of *Ex parte Young* doctrine).

[57] *See, e.g.*, Puerto Rico Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc., 506 U.S. 139, 146 (1993) (noting that *Ex parte Young* doctrine only permits suits against state officials to prevent ongoing or future violations of law); Quern v. Jordan, 440 U.S. 332, 337 (1979) (holding that federal courts can enjoin state officials to conform their future conduct in accordance with federal law); Bivens v. Six Unknown Named Agents of Fed. Bureau of Narcotics, 403 U.S. 388, 400 (1971) (recognizing cause of action for damages against federal officials for violating plaintiff's Fourth Amendment rights); *see also Alden*, 527 U.S. at 757 (noting that sovereign immunity does not bar actions against state officers for injunctive or declaratory relief); Norman Redlich & David R. Lurie, *Federalism: A Surrogate for What Really Matters*, 23 OHIO N.U. L. REV. 1273, 1291 (1997) (speculating that after *Seminole*, two main avenues around state sovereignty would be *Ex parte Young* relief and congressional abrogation under Enforcement Clause of Fourteenth Amendment).

violates federal law, those officers act without true authority.[58] Therefore, their conduct is not state conduct for purposes of the Eleventh Amendment.[59] However, *Ex parte Young* is only effective where damages are not important because injunctive relief is the sole remedy available under the doctrine.[60] Thus, if Congress is to abrogate state sovereign immunity so that it may award damages, it will have to explore other options.[61]

3. Congress's Commerce Clause Power to Abrogate State Sovereign Immunity Under the Implied Waiver Doctrine

Implied waivers represent another way that Congress can overcome sovereign immunity without invoking the Enforcement Clause.[62] The

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[58] See *Ex parte Young*, 209 U.S. at 150-56 (concluding that federal courts can enjoin state officials from commencing proceedings to enforce unconstitutional act).

[59] The *Ex parte Young* doctrine overcomes the defense of state officials who claim Eleventh Amendment immunity protection. *See id.* at 152. When the officials act in conflict with the superior authority of the Constitution, they are stripped of their official capacity and are subjected to the consequences of their individual conduct. *See id.* at 154. The state cannot impart to the officials any immunity from responsibility. *See id.* at 159; *see also* Papasan v. Allain, 478 U.S. 265, 281 (1986) (holding that Court will not bar an Equal Protection claim against state official); Green v. Mansour, 474 U.S. 64, 68 (1985) (recognizing that suit challenging constitutionality of state official's actions is not suit against state); Pennhurst State Sch. & Hosp. v. Halderman, 465 U.S. 89, 102 (1984) (reaffirming *Ex parte Young* doctrine).

[60] *See College Savings*, 527 U.S. at 704 (Breyer, J., dissenting) (noting that *Ex parte Young* doctrine is only effective where plaintiff does not seek damages); Hafer v. Melo, 502 U.S. 21, 30 (1991) (noting that *Ex parte Young* doctrine is not permissible where plaintiff seeks damages from public treasury); Kentucky v. Graham, 473 U.S. 159, 169 (1985) (holding that Eleventh Amendment does not allow award of damages in action against state in federal court, absent state waiver or proper congressional abrogation); Scheuer v. Rhodes, 416 U.S. 232, 237-38 (1974) (commenting that plaintiff in *Ex parte Young* action can only seek money damages against state officer personally, but not from state treasury); *see also* Ann Althouse, *When to Believe a Legal Fiction: Federal Interests and the Eleventh Amendment*, 40 HAST. L.J. 1123, 1144 (1989) (arguing that prospective relief against state officers is more important than retrospective relief); Vicki C. Jackson, *The Supreme Court, the Eleventh Amendment and State Sovereign Immunity*, 98 YALE L.J. 1, 72-75 (1988) (discussing distinction between permissible prospective relief and impermissible retroactive relief).

[61] *See College Savings*, 527 U.S. at 704 (Breyer, J., dissenting) (noting that Congress could achieve results by embodying state waivers into federal funding programs).

[62] *See id.* at 699-701 (Breyer, J., dissenting) (explaining that Congress has power to regulate both states and private persons to enact effective regulatory programs). *See generally* 11 U.S.C. § 106(a) (1994) (subjecting states to suit for violation of Lanham Act); 17 U.S.C. § 511(a) (1994) (subjecting states to suit for copyright infringement); 35 U.S.C. § 271(h) (1994) (subjecting states to suit for patent infringement). *But see* James E. Pfander, *An Intermediate Solution to State Sovereign Immunity: Federal Appellate Court Review of State-Court Judgments After* Seminole Tribe, 46 UCLA L. REV. 161, 192 (1998) (noting Court has moved away from implied consent doctrine in recent years and has expressed general

implied waiver doctrine recognizes Congress's Commerce Clause power to treat states the same as identically situated private citizens when necessary to accomplish the objectives of a federal regulatory program.[63] The Court endorsed this doctrine in *Parden v. Terminal Railroad of Alabama Docks Department*.[64]

In *Parden*, the State of Alabama owned and operated a railroad engaged in interstate commerce.[65] An employee of the railroad sued under the Federal Employers' Liability Act ("FELA") for injuries suffered while on the job.[66] The State of Alabama moved to dismiss the action because the railroad was a state agency, and the state had not waived its sovereign immunity from suit.[67] The District Court granted Alabama's motion, and the Circuit Court affirmed.[68] The United States Supreme Court reversed.[69]

The Court focused on two issues: whether Congress intended FELA to apply to the states, and whether Congress had the power to extend FELA's application to the states.[70] First, the Court found that FELA applied to every common carrier, including state owned railroads.[71] The Court held that because Congress did not distinguish between state and privately operated common carriers, Congress intended FELA to apply to both.[72] Second, the Court held that the Interstate Commerce Clause

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hostility to constructive consent).

[63] *See College Savings*, 527 U.S. at 694 (Breyer, J., dissenting) (stating Congress can include states within its substantive regulatory rules to achieve objectives of federal program); Parden v. Terminal Ry. of Ala. Docks Dep't, 377 U.S. 184, 192, 196 (1964) (noting that when states engage in activity which private persons might carry on, they are subject to congressional regulation); *cf.* United States v. California, 507 U.S. 746, 757-58 (1993) (noting that even federal government's rights and remedies may differ when it acts not in its sovereign capacity but as contractor similar to private enterprise).

[64] *See Parden*, 377 U.S. at 196 (recognizing doctrine of implied waivers as empowering Congress to abrogate state sovereign immunity).

[65] *Id.* at 187-96 (concluding that Congress's power to regulate commerce necessarily means states surrender any sovereignty that would hinder such regulations).

[66] *Id.* at 185.

[67] *Id.*

[68] Parden v. Terminal Ry. of Ala. Docks Dep't, 311 F.2d 727, 740 (Fed. Cir. 1964) (holding that railroad had not waived its sovereign immunity).

[69] *Parden*, 377 U.S. at 185.

[70] *Id.* at 187.

[71] *Id.* (holding that Congress made FELA applicable to both state owned and privately owned railroads); *see also* Briggs v. Sagers, 424 F.2d 130 (10th Cir. 1969), *cert. denied*, 400 U.S. 829 (1970) (involving state operation of mental institution); Chesapeake Bay Bridge & Tunnel Dist. v. Lauritzen, 404 F.2d 1001 (4th Cir. 1968) (involving state operation of bridge).

[72] *Parden*, 377 U.S. at 189 (noting fact that Congress chose to phrase coverage of FELA in all embracing terms meant that state railroads were included within it).

granted Congress a constitutional basis to enact FELA.[73]

The Court reasoned that the states surrendered a portion of their sovereignty when they granted Congress the power to regulate commerce.[74] The Commerce Clause, therefore, served as a basis to waive a state's sovereign immunity.[75] Because Alabama voluntarily operated the railroad after Congress enacted FELA, the Court held that Alabama consented to the suit in federal court under FELA, thereby waiving its sovereign immunity.[76]

However, in *Seminole Tribe of Florida v. Florida* the Court reexamined Congress's power to abrogate state sovereign immunity under the Commerce Clause.[77] The dispute in *Seminole Tribe* centered on Congress's enactment of the Indian Gaming Regulatory Act ("IGRA"), which governed gambling operations run by Indian tribes.[78] IGRA imposed upon the states a duty to negotiate with the tribes on gaming issues and authorized tribes to bring suit in federal court to compel negotiations.[79] The Court held that Congress does not have the authority under its Commerce Clause power to abrogate state sovereign immunity.[80]

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[73] *Id.* at 190 (noting Congress enacted FELA under constitutional power to regulate commerce).

[74] *Id.* at 192 (stating that Congress's authority to regulate commerce allowed it to abrogate state sovereign immunity and subject states to suit in federal court).

[75] *Id.* at 191 (holding that Congress has power under Commerce Clause to subject states to suit).

[76] *Id.* at 196 (holding that plaintiff could proceed with suit in federal court). FELA did not specify whether it applied to the states. *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 676 (1999) (noting ambiguity in language of FELA). Succeeding cases have required that Congress express its intent to subject the states to private suits in unmistakably clear language. *See* Welch v. Texas Dep't of Highways & Pub. Transp., 483 U.S. 468, 478 (1987) (noting that Congress must unequivocally express its intent to abrogate state sovereign immunity); Employees of the Dep't of Pub. Health & Welfare v. Department of Pub. Health & Welfare, 411 U.S. 279, 285 (1973) (holding that Congress must clearly express intent to hold states amenable to suit in federal court).

[77] *See* Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 47 (1996) (holding that state sovereign immunity does not yield to Congress's Commerce Clause powers); *see also* Alden v. Maine, 527 U.S. 706, 711 (1999) (noting resurgence of state sovereign immunity in *Seminole* decision); Elizabeth Gibson, *Sovereign Immunity in Bankruptcy: The Next Chapter*, 70 AM. BANKR. L.J. 195, 212 (1996) (doubting that Court will uphold implied waiver doctrine that would abrogate state sovereign immunity); Williamson, *supra* note 1, at 1744 (commenting that *Seminole* decision ended congressional power to abrogate states' sovereign immunity pursuant to Commerce Clause).

[78] *See Seminole*, 517 U.S. at 47.

[79] *See id.* at 49.

[80] *See id.* at 71-72 (holding that Commerce Clause cannot circumvent states' constitutional guarantee of sovereign immunity); *see also* Laura M. Herpers, *State Sovereign Immunity: Myth or Reality After* Seminole Tribe of Florida v. Florida?, 46 CATH. U. L. REV.

The Court reasoned that Congress enacted the Eleventh Amendment after the Commerce Clause and, therefore, Congress expanded state authority at the expense of its own Commerce Clause powers.[81] The Court confined congressional authority to abrogate a state's immunity to the enforcement of the Fourteenth Amendment.[82] The Court supported this interpretation of congressional power by noting that the Fourteenth Amendment contains express terms intended to limit a state's power.[83] The Court further pointed out that the Commerce Clause does not contain any such language.[84]

In the companion decision to *Florida Prepaid, College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*, the Court overruled *Parden*'s implied waiver theory citing the authority of *Seminole Tribe*.[85] In *College Savings*, College Savings Bank sued Florida Prepaid Postsecondary Expense Board alleging unfair competition under the Lanham Act.[86] College Savings Bank based its claim on Florida Prepaid's alleged false advertising.[87] The Court decided that states invoking the

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1005, 1038 (examining Court's holding that Congress could abrogate state sovereign immunity only through use of Enforcement Clause of Fourteenth Amendment). *See generally* Erwin Chemerinsky, *Restricting Federal Court Jurisdiction*, TRIAL, July 1996, at 18 (discussing judicial review and implications of *Seminole* decision).

[81] *See Seminole*, 517 U.S. at 64 (noting well established principle that state sovereign immunity limits federal courts' jurisdiction over suits by private parties against states); *see also* Blatchford v. Native Village of Noatak, 501 U.S. 775, 779 (1991) (holding that states retained their sovereign immunity when they entered federal system). *See generally* Meltzer, *supra* note 53, at 3-7 (criticizing Court's decision in *Seminole*).

[82] *See Seminole*, 517 U.S. at 59 (recognizing that Fourteenth Amendment expanded federal power at expense of state autonomy). *See generally* Currie, *supra* note 18, at 550 (noting that *Seminole* decision will have significant effect on actions involving statutory rights); David G. Savage, *States on a Winning Steak*, A.B.A. J., June 1996, at 46 (discussing *Seminole* decision and balance between state sovereignty and authority of Congress).

[83] *See Seminole*, 517 U.S. at 59 (noting that Fourteenth Amendment contains clear prohibitions directed at states).

[84] *See id.* at 64-65 (stating that Congress could not read Commerce Clause as any type of limitation upon state sovereign immunity). *See generally* Sarah Bond, *Counterpoint*: Seminole Tribe of Florida v. Florida: *A Victory for States Rights; Indian Gaming Act Caught in the Crossfire*, MONT. LAW., July-Aug. 1996, at 11-23 (discussing Court's rationale in *Seminole Tribe* decision); Vicki C. Jackson, Seminole Tribe, *the Eleventh Amendment, and the Potential Evisceration of Ex parte Young*, 72 N.Y.U. L. REV. 495, 495-510 (1997) (arguing that Court should abandon *Seminole* decision as soon as possible).

[85] *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 679 (1999) (labeling implied waiver doctrine as anomaly in jurisprudence of sovereign immunity).

[86] *See id.* at 669-670 (noting that Lanham Act grants private right of action against any person who uses false descriptions or makes false representations in commerce).

[87] *See id.* (stating that College Savings alleged that Florida Prepaid violated Lanham Act by making false statements about its certificates of deposits in its brochures and annual

benefits of the federal patent system do not waive any defense of sovereign immunity in patent litigation.[88] The Court specifically rejected the implied waiver doctrine as an anomaly in constitutional law.[89]

By invalidating implied waivers, the Court severely limited Congress's power to regulate state conduct.[90] This curtailment of congressional power threatens several areas of federal law.[91] Most significantly, the Court has found states immune from federal patent laws.[92]

C. Background of Patent Law

The Patent Clause of the Constitution empowers Congress to promote scientific advancement by securing inventors the exclusive right to their inventions for limited periods of time.[93] Accordingly, Congress has authorized the issuance of patents under a system that encourages both the creation and the public disclosure of new advances in technology.[94] In exchange for the inventors' creative efforts, Congress grants the inventor an exclusive monopoly over the patent for a defined period of time.[95]

The substantive laws that govern patent infringement cases are entirely federal.[96] From the inception of the Constitution, Congress has

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reports).

[88] *See id.* at 682 (holding that Court shall treat state sovereign immunity in same manner as right to trial by jury in criminal cases in that both must be express).

[89] *See id.* at 679 (criticizing *Parden* Court's poorly conceived implied waiver doctrine).

[90] *See id.* at 694 (Breyer, J., dissenting) (arguing that Court's rejection of implied waiver doctrine denies Congress ability to effectively regulate states).

[91] *See id.* at 697 (Breyer, J., dissenting) (illustrating effect of Court's decision in intellectual property and computer related fields).

[92] *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 633-640 (1999) (holding that Congress cannot abrogate state sovereign immunity under Patent Remedy Act).

[93] *See* U.S. CONST. art. I, § 8, cl. 8 (stating that Congress has authority to promote technological creation by granting authors and inventors exclusive rights to their writings and inventions for limited period of time); *see also Florida Prepaid*, 527 U.S. at 648 (Stevens, J., dissenting) (noting that Constitution gives Congress complete authority over patents and copyrights).

[94] *See* Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 63 (1998) (noting that federal government designs patent law to promote creation in technology).

[95] *See* Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 229-30 (1964) (holding that patent entitles owner to exclude others from making, using, or selling protected invention for defined period of time); *cf.* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 546 (1985) (recognizing that Congress grants authors monopoly over their copyright for benefit of public).

[96] *See* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 162 (1989) (recognizing that Congress has lodged exclusive jurisdiction of patent law suits in federal courts); Campbell v. City of Haverhill, 155 U.S. 610, 625 (1895) (noting that Congress

given patentees the right to bring a federal action for patent infringement.[97] Congress granted this right because of the strong federal interest in having a uniform interpretation of the patent statutes.[98] Congress also sought to ensure the constitutional goals of stimulating invention and rewarding inventors for disclosing novel and useful advances in technology.[99] Congress has mandated that patent law's consistency and uniformity are matters of overriding significance.[100]

The Supreme Court has acknowledged that patents are a form of property, and that the Fourteenth Amendment protects those property rights.[101] Patents give their owners a right to exclude others from using an invention without permission for a certain period of time.[102] The rights of exclusion and compensation for unauthorized uses of the patent are essential to the property interest.[103] Thus, the Court has recognized Congress's legitimate ability to exercise its substantive powers under the Patent Clause as necessary to protect patent holders' property interest in

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provided for exclusive jurisdiction of patent infringement litigation in federal courts).

[97] *See* Brief for the United States at 13, *Florida Prepaid* (No. 98-531) (stating that since 1790, patent code has assumed that patent holders are in best position to assert their rights against infringers); *see also* THE FEDERALIST NO. 43 (James Madison) (commenting that states cannot effectively regulate either patents or copyrights because of lack of uniformity).

[98] *See Florida Prepaid*, 527 U.S. at 649 (Stevens, J., dissenting) (noting need for uniformity in patent statutes so that there will be continued advances in technology).

[99] *See* Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 9 (1966) (recognizing strong federal interest in uniform interpretation of patent law as necessary to reward new and productive advances in technology).

[100] *See Bonito Boats*, 489 U.S. at 162 (stating that Congress's channeling of patent cases into federal courts recognizes that patent law requires unusual degree of uniformity and consistency); Christianson v. Colt Indus. Operating Corp., 486 U.S. 800, 813 (1988) (commenting that Congress was determined to create Federal Court of Appeals which would apply uniform standard to patent cases).

[101] *See Florida Prepaid*, 527 U.S. at 641 (acknowledging that Court considers patents property for purposes of Due Process Clause); Transparent-Wrap Mach. Corp. v. Stokes & Smith Co., 329 U.S. 637, 643 (1947) (noting that patents are form of property); Special Equip. Co. v. COE Comm'r of Patents, 324 U.S. 370, 382 (1945) (noting that patents are another form of private property); Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 425 (1908) (stating that patents are property and have same rights as other forms of property); Brown v. Duchesne, 60 U.S. 183, 197 (1856) (noting that rights of patent holders are same as those of private property owners).

[102] *See* Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 480 (1974) (stating that patents give owners ability to exclude others from making, selling, or using their invention for limited period of time).

[103] *See* Kaiser Aetna v. United States, 444 U.S. 164, 176 (1979) (noting that right of exclusion is essential to property interest); *see also* Brief for the United States at 3, *Florida Prepaid* (No. 98-531) (arguing right to compensation for infringement is necessary to property interest).

their patents.[104]

Congress has continually taken measures to protect patent holders' property rights.[105] Congress provided federal courts with exclusive jurisdiction over patent infringement cases to protect the strong federal interest in the development of a consistent and uniform body of patent law.[106] In 1982, Congress further strengthened its policy of promoting uniform development of patent law by establishing the United States Court of Appeals for the Federal Circuit.[107] Congress vested this court with exclusive jurisdiction over all appeals in cases arising under federal patent law.[108] Congress created this court because patent infringement litigation raises complicated technical issues that are difficult for judges to comprehend.[109] The history of frequent disagreement among federal circuit courts regarding patent law also fueled the grant of exclusive jurisdiction.[110] Congress feared that if it did not channel patent appeals into one court, forum shopping would sharply increase amongst plaintiffs searching for circuits regarded as pro or anti-patent.[111]

The Ninth Circuit decision of *Chew v. California* caused Congress to enact the Patent Plant Variety Protection Remedy Clarification Act of 1992 ("Patent Remedy Act"), which further solidified federal control

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[104] *See* Act of July 4, 1836, ch. 357, § 14, vol. 5, Stat. 123 (extending congressional authority over federal patent law); Act of Apr. 17, 1800, ch. 25, § 3, 2 Stat. 38 (solidifying Congress's control over patent law); Act of Feb. 21, 1793, ch. 11, § 5, 1 Stat. 322 (extending congressional power over patents); Act of Apr. 10, 1790, ch. 7, § 4, Stat. 111 (granting Congress authority to protect patents).

[105] *See Florida Prepaid*, 527 U.S. 650-652 (Stevens, J., dissenting) (detailing how Congress has promoted patent infringement litigation in federal courts over past 200 years).

[106] *See* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 162 (1989) (noting that Congress has historically given federal courts exclusive jurisdiction over cases arising under patent law).

[107] *See* Federal Courts Improvement Act of 1982, Pub. L. No. 97-164, § 127(a), 96 Stat. 37, 37-39 (1983) (granting exclusive jurisdiction over patent litigation to federal courts). *See generally Florida Prepaid*, 527 U.S. 650-652 (Stevens, J., dissenting) (discussing reasons for Congress's decision to channel all patent appeals to Court of Appeals for Federal Circuit).

[108] *See Florida Prepaid*, 527 U.S. at 650 (Stevens, J., dissenting) (stating that Court of Appeals for Federal Circuit has jurisdiction over all federal trial court appeals).

[109] *See id.* (Stevens, J., dissenting) (noting that difficult technical issues were important justification for Congress to consolidate appellate jurisdiction in patent law cases). *See generally* HENRY J. FRIENDLY, FEDERAL JURISDICTION: A GENERAL VIEW 157 (1973) (commenting that many patents are beyond ability of judges to properly comprehend).

[110] *See Florida Prepaid*, 527 U.S. at 650 (Stevens, J., dissenting) (noting that Congress consolidated appellate jurisdiction of patent appeals because federal circuits were diverging in their interpretation of patent law).

[111] *See* H.R. REP. NO. 97-312, pt.1, at 20-21 (1981) (noting that plaintiffs will forum shop because patent cases produce different outcomes in different courtrooms in substantially similar circumstances).

over patent infringement cases.[112] Chew invented a method for testing automobile engine exhaust emissions and secured a patent on her invention.[113] The State of California required testing of auto exhaust emissions by a process that Chew asserted infringed upon her patent.[114] She sued the State of California in federal court for infringement.[115] California filed a motion to dismiss on Eleventh Amendment grounds.[116] The District Court granted the motion and the Circuit Court affirmed.[117] The Federal Circuit Court held that Congress had not clearly expressed its intent to abrogate state sovereign immunity under the patent laws.[118] The court implied that its decision would have been the same regardless of the availability of state court as a possible forum.[119]

Before enacting the Patent Remedy Act, Congress heard testimony from a Professor Merges that Chew might not be able to draft her infringement suit as a tort claim under California law.[120] Merges further stated that Chew would be unable to sue California in federal court because of state sovereign immunity.[121] Thus, Chew would have no avenue of recovery in either federal or state court.[122]

Congress responded to *Chew* by enacting the Patent Remedy Act.[123] The Patent Remedy Act expressly abrogated the Eleventh Amendment immunity of states or state instrumentalities in patent infringement

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[112] *See Florida Prepaid*, 527 U.S. at 654 (Stevens, J., dissenting) (stating that *Chew* was catalyst that prompted Congress to enact Patent Remedy Act); Chew v. California, 893 F.2d 331, 331-36 (Fed. Cir. 1990) (leaving patent holder without remedy against state patent infringement); H.R. REP. NO. 101-960, pt. 1, at 7 (1990) (describing testimony Congress heard regarding *Chew*).

[113] *Chew*, 893 F.2d at 332.

[114] *Id.*

[115] *Id.*

[116] *Id.*

[117] *Id.*

[118] *See id.* at 334 (holding that Congress did not demonstrate intent to abrogate state sovereign immunity in patent statute).

[119] *See id.* at 336 (refraining from resolving question of whether Chew was entitled to remedy under state law).

[120] *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 655-56 (1999) (Stevens, J., dissenting) (recounting Professor Merges's testimony to Congress that it might be impossible for Chew to draft her tort claim under California law).

[121] *See id.* at 656-60 (Stevens, J., dissenting) (noting testimony of Professor Merges that sovereign immunity would prevent plaintiffs from bringing suit against state entities in federal court).

[122] *See id.* (Stevens, J., dissenting) (stating that relief under state statutes would not be viable avenue for recovery in patent infringement cases).

[123] *See id.* at 654-55 (Stevens, J., dissenting) (noting that *Chew's* holding that congressional intent to abrogate state sovereign immunity in patent infringement cases was not clear and forced Congress to enact Patent Remedy Act).

suits.[124] The Patent Remedy Act authorizes patent infringement actions against states, state instrumentalities, and any officer or employee of a state acting in that person's official capacity.[125] Congress created the Patent Remedy Act to punish states attempting to deprive patent holders of their property interests without due process of law.[126]

II. FLORIDA INFRINGES ON PATENT AND INVOKES THE DOCTRINE OF SOVEREIGN IMMUNITY

In *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, College Savings Bank marketed and sold certificates of deposit that financed future college expenses.[127] College Savings obtained a patent for its financing methodology, which it designed to guarantee investors sufficient funds to pay college tuition.[128] Florida Prepaid, an entity created by the State of Florida, began to administer prepayment contracts identical to those of College Savings.[129] Florida Prepaid's contracts provided a return on invested funds that was guaranteed to be adequate to finance the costs of a college education at specified dates in the future.[130]

College Savings sued Florida Prepaid in federal court for patent infringement.[131] Florida Prepaid moved to dismiss the action on the grounds of sovereign immunity.[132] Florida Prepaid argued that the Patent Remedy Act represented an unconstitutional extension of Congress's Commerce Clause power to abrogate state sovereign

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[124] *See* 35 U.S.C. § 271(h) (1994) (stating that any officer or employee of state is subject to suit in federal court); *id.* § 296(a) (stating that any state actor will not be immune under doctrine of sovereign immunity); *see also* Patent and Plant Variety Protection Remedy Clarification Act, Pub. L. No. 102-560, preamble, 106 Stat. 4230 (1992) (clarifying that law subjects states to suit in federal court); *Florida Prepaid*, 527 U.S. at 632 (noting that Patent Remedy Act clearly stated plaintiffs could sue states in federal court for patent infringement). *See generally* H.R. REP. NO. 101-960, pt. 1, at 7, 33 (1990) (discussing reasons for Congress enacting Patent Remedy Act).

[125] *See* 35 U.S.C. § 271(h) (listing all state entities that shall incur liability for patent infringement).

[126] *See Florida Prepaid*, 527 U.S. at 660 (Stevens, J., dissenting) (stating that Congress passed Patent Remedy Act because of threat that states would be unable or unwilling to give adequate remedies for their own patent infringement violations).

[127] *Id.* at 630.

[128] *Id.* at 630-31.

[129] *Id.* at 631.

[130] *Id.*

[131] *Id.*

[132] *Id.* at 633.

immunity.[133] College Savings asserted that Congress had properly exercised its power under the Enforcement Clause to enforce the guarantees of the Due Process Clause of the Fourteenth Amendment.[134]

The District Court agreed with College Savings and denied Florida Prepaid's motion to dismiss.[135] The Federal Circuit Court affirmed, holding that Congress clearly expressed its intent to abrogate the states' immunity from suit in federal court for patent infringement.[136] The court further held that Congress had the power under the Enforcement Clause to abrogate state sovereign immunity.[137]

The United States Supreme Court reversed.[138] The Court observed that, under *Seminole Tribe*, Congress cannot abrogate state sovereign immunity pursuant to its Commerce or Patent Clause powers.[139] The Court also reiterated its holding in College Savings Bank that *Parden*'s implied waiver doctrine did not pass constitutional muster.[140]

The Court noted that appropriate legislation pursuant to the Enforcement Clause could abrogate state sovereign immunity.[141] But this requires a congruence and proportionality between the injury to be prevented and means adopted to that end.[142] Therefore, Congress must

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[133] *Id.*

[134] *Id.*

[135] Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 948 F. Supp. 400, 412 (D.N.J. 1996), *aff'd*, 148 F.3d 1343 (Fed. Cir. 1998), *rev'd*, 527 U.S. 666 (1999).

[136] *College Savings*, 148 F.3d at 1353.

[137] *Id.* at 1347-53 (holding that Congress had sufficient factual findings of patent infringement by states to justify abrogating state sovereign immunity). The court reasoned that patents are property subject to the protections of the Due Process Clause. *See id.* at 1349-50 (noting that patents are form of property). The court also found that the Patent Remedy Act was permissible because Congress sought to prevent states from depriving patent owners of property without due process of law. *See id.* (discussing history of states infringing on patents). Finally, the court held that the Patent Remedy Act was a proportionate response to state patent infringement and an appropriate measure to protect patent owners' property. *See id.* at 1349 (justifying Congress's use of its Enforcement Clause powers to prevent states from continuing to infringe on patents). The court concluded that significant harm results when states infringe on private patents. *See id.* at 1353-54 (noting that states could leave private patent holders with no forum to bring their patent infringement cases).

[138] *See Florida Prepaid*, 527 U.S. at 634 (holding that Congress designed Patent Remedy Act too broadly).

[139] *See id.* at 635-36 (reaffirming that Court has overruled *Parden*'s implied waiver doctrine).

[140] *See id.* (stating that implied waiver doctrine is no longer viable option for Congress).

[141] *See id.* at 637 (noting that Congress retains authority to abrogate state sovereign immunity pursuant to Fourteenth Amendment).

[142] *See id.* at 638-39 (noting that Congress must find connection between conduct violating Fourteenth Amendment and must carefully design means to remedy violation).

identify conduct violating the Fourteenth Amendment, and must tailor its remedial scheme to prevent such conduct.[143] The Court agreed that states infringing on patents could violate the Fourteenth Amendment.[144] However, the Court found that the Patent Remedy Act's legislative history offered little support for the conclusion that states actively violated the Fourteenth Amendment.[145] Scant evidence existed of states invoking sovereign immunity and, thereby, depriving patent owners of property without due process of law.[146] Thus, the Court could not identify the targeted constitutional evil that Congress designed the Act to remedy.[147]

The Court found that the provisions of the Patent Remedy Act were not proportional because they would prohibit constitutional state actions.[148] For example, individuals could still sue states in federal court, even if the states adhered to the Fourteenth Amendment by providing adequate remedies for patent infringement in their own courts.[149] The Act made all states amenable to suit for an indefinite duration in federal court for all possible types of patent infringement.[150] The Court found the scope of the Act too broad for the small amount of constitutional violations that it might remedy.[151] The Court held that the Enforcement Clause could not sustain the Patent Remedy Act because of the Act's unreasonably broad coverage.[152] *Florida Prepaid* essentially leaves Congress powerless to directly regulate patent infringement by the states.[153]

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[143] *See id.* at 639-40 (holding that Congress must find evil to remedy and identify pattern of constitutional violations).

[144] *See id.* (noting that underlying conduct of states infringing on patents without giving patent owners any compensation would be violation of Fourteenth Amendment).

[145] *See id.* (stating that Congress did not find any pattern of patent infringement by states).

[146] *See id.* at 640-41 (finding few cases involving patent infringement claims against states).

[147] *See id.* at 645-46 (noting that many acts Patent Remedy Act prohibited would likely be constitutional).

[148] *See id.* (stating that Congress did nothing to limit Patent Remedy Act to remedy only certain types of infringement).

[149] *See id.* at 645-47 (noting that only where state affords no remedy, or inadequate remedy, is there violation of Fourteenth Amendment).

[150] *See id.* (arguing that Patent Remedy Act was far too overreaching).

[151] *See id.* (stating that provisions of Patent Remedy Act were so out of proportion that Congress did not design them to prevent unconstitutional behavior).

[152] *See id.* (holding that Court cannot sustain Patent Remedy Act because of its indeterminate, yet possibly overreaching scope).

[153] *See id.* at 664-65 (Stevens, J., dissenting) (arguing that *Florida Prepaid* decision is just one of many Supreme Court decisions expanding states' rights to detriment of Congress's

III. ANALYSIS

In *Florida Prepaid*, the Supreme Court erred in finding that there is no congressional authority for the Patent Remedy Act for two reasons.[154] First, the Due Process rights involved bring patent law under the Fourteenth Amendment's auspices.[155] Second, the Patent Remedy Act is both congruent with and proportional to the wrong of state patent infringement.[156]

Florida Prepaid also demonstrates that notions of fairness and justice support the implied waiver doctrine.[157] Moreover, state courts are not an appropriate forum for patent infringement cases and Congress's alternative options to abrogate state sovereign immunity are ineffective.[158] The Court should not have overturned *Parden*, and *Florida Prepaid* exemplifies the need for the Court to restore implied waivers.[159]

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regulatory powers).

[154] *See* Brief for the United States at 9, *Florida Prepaid* (No. 98-531) (stating that there is factual basis for Congress to conclude that states are depriving patent owners of property, then Patent Remedy Act is in accordance with Enforcement Clause). *See generally* City of Boerne v. Flores, 521 U.S. 507, 529 (1997) (stating that preventative legislation can be appropriate remedial measure under Enforcement Clause).

[155] *See Florida Prepaid*, 527 U.S. at 648-49 (Stevens, J., dissenting) (arguing that absence of state remedies for patent infringement justified Congress to enact Patent Remedy Act); Coll. Sav. v. Fla. Prepaid Postsecondary Educ. Expense Bd., 948 F. Supp. 400, 422 (D.N.J. 1996) (stating that patents and copyrights are property, and that congressional protection of these forms of property is appropriate legislation in accordance with Fourteenth Amendment), *aff'd*, 148 F.3d 1343 (Fed. Cir. 1998), *rev'd*, 527 U.S. 627 (1999); Brief for the United States at 14, *Florida Prepaid* (No. 98-531) (stating that it is undisputed that plaintiffs may sue state entities in federal court for engaging in unlawful conduct such as patent infringement); *see also* Genentech v. Regents of the Univ. of Cal., 939 F. Supp. 639, 643 (S.D. Ind. 1996) (noting that patents are protected property rights, and court cannot allow states to infringe on that right thereby denying patent owners of their property without due process of law).

[156] *See Florida Prepaid*, 527 U.S. at 662-63 (Stevens, J., dissenting) (arguing that Patent Remedy Act will only impact unconstitutional state action).

[157] *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 701 (1999) (Breyer, J., dissenting) (arguing that Court's overruling of implied waiver doctrine will harm nation's ability to enact economic legislation, especially in intellectual property arena).

[158] *See id.*

[159] *See id.* (Breyer, J., dissenting) (noting that Court will deprive Congress of ability to create private remedial schemes in intellectual property and computer related fields).

A. The Enforcement Clause Authorizes the Patent Remedy Act

The Enforcement Clause empowers Congress to abrogate states' sovereign immunity to secure the protections of the Fourteenth Amendment.[160] The Enforcement Clause grants Congress broad power to enact legislation necessary to secure the guarantees of the Fourteenth Amendment.[161] The Enforcement Clause requires only that a congruence and proportionality exist between the injury to be prevented or remedied and the means adopted to that end.[162] To pass this test, the Patent Remedy Act had to satisfy two requirements.[163] First, Congress had to design the Patent Remedy Act to prevent states from depriving patent owners of their property without due process of law.[164] Second, Congress had to carefully tailor the legislation so that it was not over inclusive in barring constitutional state action.[165]

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[160] *See* U.S. CONST. amend. XIV, § 5 (stating that Congress has power to enforce Fourteenth Amendment); *College Savings*, 948 F. Supp. at 422 (noting that patents and copyrights are property and that Congress may appropriately protect them under Fourteenth Amendment); Brief for the United States at 14, *Florida Prepaid* (No. 98-531) (stating that plaintiffs may sue state entities in federal court for engaging in unlawful conduct such as patent infringement); *see also Genentech*, 939 F. Supp. at 643 (noting that patents are protected property rights, and if Court allowed states to infringe that right, then states would deprive patent owners of property without due process of law).

[161] *See* U.S. CONST. amend. XIV, § 5 (noting that Congress can use appropriate legislation to enforce protections of Fourteenth Amendment); City of Boerne v. Flores, 521 U.S. 507, 520 (1997) (stating that Congress must have great latitude in deciding what measures to use to prevent unconstitutional action).

[162] *See* U.S. CONST. amend. XIV, § 5 (noting that Congress can only enforce provisions of Fourteenth Amendment through appropriate legislation); *City of Boerne*, 521 U.S. at 519-20 (warning that legislation without congruence and proportionality would be substantive law, and hence, not within power of Congress to enact). The Court made clear that Congress only has the power to enforce the law, and that Congress does not have the authority to determine constitutional violations. *See id.* at 519 (discussing limitations on Congress's legislative authority). *See generally* Anti-Fascist Refugee Comm'n v. McGrath, 341 U.S. 123, 162-63 (1951) (Frankfurter, J., concurring) (noting that due process is not fixed concept unrelated to current circumstances); Martin H. Redish & Lawrence C. Marshall, *Adjudicatory Independence and the Values of Procedural Due Process*, 95 YALE L.J. 455, 456-70 (1986) (commenting that courts have not made much progress in creating guidelines for answering question of how much process is due).

[163] *See* 35 U.S.C. § 271 (1994 & Supp III 1997) (authorizing private causes of action for patent infringement); Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 653-60 (1999) (Stevens, J., dissenting) (noting first step of inquiry is to determine what injury Congress sought to remedy or prevent with Patent Remedy Act, and second, legislation must satisfy proportionality component).

[164] *See Florida Prepaid*, 527 U.S. at 639-40 (stating that conduct at issue is state infringement of patents and states' use of sovereign immunity to deny patent owners compensation for violations of patent rights).

[165] *See id.* at 645-47 (stating that Congress must limit coverage of Patent Remedy Act to suits involving arguable constitutional violations, and must confine reach to only certain

1. Congress Designed the Patent Remedy Act to Prevent States from Depriving Patent Owners of their Property without Due Process

Congress adhered to the first part of the congruence and proportionality test when it passed the Patent Remedy Act.[166] Congress sought to prevent patent infringement by the states through the Patent Remedy Act.[167] Congress concluded that securing inventors' patent rights required the abrogation of states' sovereign immunity from federal patent law.[168] Congress uncovered ample evidence demonstrating that states did infringe on private patents.[169] First, Congress identified a clear pattern of patent infringement by the states.[170] The legislative record of the Patent Remedy Act discloses significant

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types of infringement).

[166] *See* 35 U.S.C. § 271 (securing against unauthorized uses of patented inventions); H.R. REP. NO. 101-960, pt. 1, at 33-38 (1990) (noting need to prevent states from continuing to infringe on patents); *see also Florida Prepaid*, 527 U.S. at 660-63 (Stevens, J., dissenting) (arguing that Congress passed Patent Remedy Act to prevent due process violations based on substantiated fear that states would not provide adequate remedies).

[167] *See* 35 U.S.C. § 271(h) (stating that plaintiffs can enforce patent rights against states); H.R. REP. NO. 101-960, pt. 1, at 15-38 (noting Congress's intent to compensate inventors for patent infringement by states); *see also Florida Prepaid*, 527 U.S. at 632 (stating that Congress enacted Patent Remedy Act to clarify that law subjects states to suit in federal court for patent infringement).

[168] *See* 35 U.S.C. § 296(a) (1994) (requiring that federal courts hold state actors amenable to suit in patent law cases); Brief for the United States at 8, *Florida Prepaid* (No. 98-531) (arguing that Congress has authority to enact legislation to protect property rights conferred under federal patent law); *see also* Carlos Manuel Vazquez, *What Is Eleventh Amendment Immunity?*, 106 YALE L.J. 1683, 1747-48, 1752 (arguing that any statute with mandatory obligations creates property rights).

[169] *See* H.R. REP. NO. 101-960, pt. 1, at 15-38 (referencing several cases of patent infringement involving states); *see also Florida Prepaid*, 527 U.S. at 657 (Stevens, J., dissenting) (noting that state universities have been involved in many patent infringement cases). *See generally* Regents of Univ. of Minn. v. Glaxo Welcome Inc., 44 F. Supp. 2d 998, 1007-08 (D. Minn. 1999) (involving declaratory judgment action filed by University of Minnesota in patent suit); University of Colo. Found., Inc. v. American Cyanamid Co., 974 F. Supp. 1339, 1347 (D. Colo. 1997) (describing patent infringement action filed by University of Colorado); Gen-Probe, Inc. v. Amoco Corp., Inc., 926 F. Supp. 948, 955 (S.D. Cal. 1996) (detailing plaintiff's suit filed against various parties alleging that Regents of University of California induced patent infringement by Amoco).

[170] *See* H.R. REP. NO. 101-960, pt. 1, at 14-40 (noting increasing involvement of states in patent infringement cases); *see also Florida Prepaid*, 527 U.S. 657-58 (Stevens, J., dissenting) (noting that congressional record lists many cases of patent infringement by states); *Hearing Before the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on the Judiciary*, 101st Cong., 2d Sess., 60 (1990) (citing Lemelson v. Ampex Corp., 372 F. Supp. 708, 710-12 (N.D. Ill. 1974) (detailing suit against State of Illinois) and Hercules, Inc. v. Minnesota State Highway Dep't, 337 F. Supp. 795, 796-98 (D. Minn. 1972) (describing suit against State of Minnesota)).

instances of patent infringement by the states or state entities.[171] For example, Congress heard testimony concerning the case of *Chew v. California* before it passed the Patent Remedy Act.[172] *Chew* demonstrated to Congress what would happen if Congress did not afford inventors a forum in federal court to sue state entities for patent infringement.[173] *Chew* indicated that, in the absence of the Patent Remedy Act, patent holders might not have any forum, federal or state, in which to file suit for patent infringement.[174]

Second, Congress reasonably believed that the danger of state patent infringement would increase in the future.[175] The legislative background of the Patent Remedy Act showed that state entities fully engage in the intellectual property marketplace, often asserting their own patent rights.[176] Congress foresaw a future in which the developing lucrative

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[171] *See* H.R. REP. NO. 101-960, pt. 1, at 14-39 (detailing involvement of states in patent infringement actions). *See generally* Jacobs Wind Elec. Co. v. Fla. Dep't of Transp., 919 F.2d 726, 727-29 (Fed. Cir. 1990) (noting that plaintiff held patent on tidal flow system that Florida Department of Transportation allegedly infringed upon); Chew v. California, 893 F.2d 331, 332-33 (Fed. Cir. 1990) (holding that State of California was immune from suit in patent infringement action); Watts v. University of Del., 622 F.2d 47, 48-53 (3d Cir. 1980) (discussing suit by plaintiff against University of Delaware for infringing on design of chair); Kersevage v. University of Tenn., 731 F. Supp. 1327, 1328-30 (E.D. Tenn. 1989) (describing University professor bringing suit against University of Tennessee for infringing structural design patent); *Lemelson*, 372 F. Supp. at 710-12 (detailing patent infringement suit against Illinois state agency); *Hercules*, 337 F. Supp. at 796-98 (describing patent infringement suit against Minnesota State Highway Department).

[172] *See* H.R. REP. NO. 101-960, pt. 1, at 7 (noting that Congress heard testimony about case of *Chew v. California*, 893 F.2d 331 (Fed. Cir. 1990), in which California allegedly infringed on inventor's patent).

[173] *See Chew*, 893 F.2d at 335 (indicating that plaintiff would be unable to bring her patent infringement suit in federal court).

[174] See *Florida Prepaid*, 527 U.S. at 655-56 (Stevens, J., dissenting) (discussing that Congress heard testimony that state remedies would prove insufficient in patent infringement cases).

[175] *See* H.R. REP. NO. 101-960, pt. 1, at 38 (stating that Congress listened to testimony indicating that states would invoke defense of sovereign immunity in growing number of cases); *see also* 137 CONG. REC. 7330 (1991) (statement of Sen. Deconcini) (noting that state universities are increasingly active in intellectual property field). *See generally* Federal Sign v. Texas S. Univ., 951 S.W.2d 401, 405-06 (Tex. 1997) (stating that sovereign immunity protects states from lawsuits seeking damages unless state waives sovereign immunity); Withers v. University of Ky., 939 S.W.2d 340, 345 (Ky. 1997) (extending sovereign immunity to University of Kentucky Medical Center as branch of Kentucky state government).

[176] *See* H.R. REP. NO. 101-960, pt. 1, at 20-38 (noting that states have litigated many patent infringement suits against private entities); *see also* Genentech, Inc. v. Regents of Univ. of Cal., 143 F.3d 1446, 1454 n.6 (Fed. Cir. 1998) (discussing press report stating that in 1994 University of California received $50.2 million in royalties, filed 389 patent applications, and received 126 patents); Rebecca S. Eisenberg, *Public Research and Private Development: Patents and Technology Transfer in Government-Sponsored Research*, 82 VAND. L. REV. 1663, 1708, 1726 (1996) (indicating that state universities are obtaining increasing

markets in technology and intellectual property would increasingly tempt state entities to infringe on private actors' patents.[177] Congress needed to protect patent owners by ensuring them an adequate remedy.[178] The Patent Remedy Act provided the most effective means for Congress to guarantee this protection.[179]

Finally, Congress heard testimony that state remedies would likely prove inadequate to compensate inventors victimized by state entities.[180] The Court assumed in *Florida Prepaid* that patent owners would be able to pursue state court remedies against patent infringement by the states.[181] Patent owners could avail themselves of whatever tort remedies a state might make available in its own courts.[182] However, the Court failed to recognize that nothing guarantees that state courts will provide adequate remedies for patent infringement.[183] Two states, Arkansas and

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number of patents).

[177] *See Florida Prepaid*, 527 U.S. at 657 (Stevens, J., dissenting) (describing how states are heavily involved in federal patent system and enormous amount of revenues that states have generated from their patents). *See generally* Joe F. Canterbury, Jr., *The King Can Do Wrong: The Supreme Court Has the Chance to Abolish the Archaic Doctrine of Sovereign Immunity in Contract Cases*, TEX. LAW., Mar. 17, 1997, at 30 (arguing that sovereign immunity is tyrannical use of government authority).

[178] *See Florida Prepaid*, 527 U.S. at 660 (Stevens, J., dissenting) (criticizing Court for damaging Congress's power to enact preventative legislation to protect patent holders from infringement by states).

[179] *See id.* at 664 (Stevens, J., dissenting) (arguing that Patent Remedy Act is paradigm of proper use of Congress's Enforcement Clause powers).

[180] *See id.* at 656; Chew v. California, 893 F.2d 331, 335 (Fed. Cir. 1990) (leaving patent holder without remedy for patent infringement by state); H.R. REP. NO. 101-960, pt. 1, at 34 (explaining testimony of Professor Merges at congressional hearing that reliance on state adjudication of patent claims would prove insufficient and not offer valid means of recovery). *See generally* L. Katherine Cunningham & Tara D. Pearce, *Contracting With the State: The Daring Five-the Achilles' Heel of Sovereign Immunity?*, 31 ST. MARY'S L.J. 255, 255-75 (1999) (discussing growth of sovereign immunity as shield of protection for State of Texas against complaining parties).

[181] *See Florida Prepaid*, 527 U.S. at 656-59 (Stevens, J., dissenting) (commenting on irony of Court using Congress's failure to review remedies in each state as support for argument that states would provide adequate remedies for patent infringement); General Oil v. Crain, 209 U.S. 211, 226-27 (1908) (standing for proposition that state courts must entertain private individuals' suits against states that doctrine of sovereign immunity has barred from federal courts); *see also* Hilton v. South Carolina Pub. Rys. Comm'n, 502 U.S. 197, 204-05 (1991) (upholding state court jurisdiction over federal cause of action that Eleventh Amendment barred from lower federal courts).

[182] See H.R. REP. NO. 101-960, pt. 1, at 7 (noting that Court's approach forces patent holders to defend against patent infringement in every state in which their product is sold). *See generally* Earl F. Hamm, Jr., *The Reemergence of the Sovereign Immunity Doctrine in Kentucky*, 87 KY. L.J. 439, 439-60 (1998) (noting that State of Kentucky extended sovereign immunity to University of Kentucky Medical Center).

[183] *See* Brief for the United States at 10-11, *Florida Prepaid* (No. 98-531) (noting fact that

West Virginia, have not waived their sovereign immunity at all.[184] Other states have imposed significant limitations on their waivers of immunity from tort actions, including limitations that would likely prevent the successful prosecution of patent infringement suits.[185] There are states, such as Florida, that have waived their right to immunity from suit for conversion and other tort acts.[186] However, it is still not clear that these states' courts would construe their tort law to encompass claims for patent infringement.[187] Therefore, serious doubt existed as to whether patent holders would be able to litigate patent infringement claims against state entities in state court.[188]

Thus, Congress had sufficient evidence of state patent infringement to employ the Enforcement Clause to remedy or prevent due process violations.[189] First, evidence of a pattern of states infringing on patents existed.[190] Second, there was a realistic threat that states would continue

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even though some states have waived their sovereign immunity for certain torts, this does not guarantee that remedies will be available for patent infringement); *see also* Jaffe, *supra* note 18, at 29 (regarding suits involving enforcement of contracts, treasury liability in tort, and adjudication of interests in property held by government, as against state itself); Ann Woolhander, *The Common Law Origins of Constitutionally Compelled Remedies*, 107 YALE L.J. 77, 153-54 (1997) (expressing doubt that Congress can expect state courts to entertain federal rights of action against state entities).

[184] *See, e.g.*, W. VA. CONST. art. VI, § 35 (stating that state cannot be defendant in any court of law or equity); Brown v. Arkansas State HVACR Licensing Bd., 984 S.W.2d 402, 403-05 (1999) (declaring that all suits against state are expressly forbidden under doctrine of sovereign immunity).

[185] *See* Brief for State of Ohio at 4, 14, *Florida Prepaid* (No. 98-531) (describing how states have prevented suits against state entities); *see also* Conrod v. Missouri State Highway Patrol, 810 S.W.2d 614, 617, 618 (Mo. Ct. App. 1991) (holding that sovereign immunity bars state tort law conversion claims against state entities); Townsend v. State, 871 P.2d 958, 959-60 (N.M. 1994) (holding that plaintiff could not bring suit against state of New Mexico).

[186] *See* Jacobs Wind Elec. Co. v. Fla. Dep't of Transp., 626 So. 2d 1333, 1337 (Fla. 1993) (holding State of Florida immune from suit in federal court). The court did not confirm whether Florida would offer a remedy for patent infringement. *See id.* (granting state court jurisdiction over case but not issuing any form of relief). The court also did not determine if a claim of patent infringement would be a state tort claim. *See id.* at 1336-37 (stating that patent holder may be able to assert takings claim in state court).

[187] *See id.* (choosing not to clarify whether plaintiffs would be able to bring patent infringement actions against state entities).

[188] *See id.* (refusing to hold that when state infringes on patent, that this would constitute tort within meaning of state constitution).

[189] *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 660 (1999) (Stevens, J. dissenting) (explaining that Congress was justified in enacting Patent Remedy Act because of evidence of actual and potential constitutional violations).

[190] *See* Chew v. California, 893 F.2d 331, 332-33, 336 (Fed. Cir. 1990) (describing California state entity's infringement on car exhaust patent); Watts v. University of Del., 622 F.2d 47, 48-53 (3d Cir. 1980) (discussing State of Delaware's infringing upon patent of chair design); Kerservage v. University of Tenn., 731 F. Supp. 1327, 1328-30 (E.D. Tenn.

to infringe on patents in the future.[191] Finally, Congress had a substantiated fear that states would be unable or unwilling to provide adequate remedies for their own violations of patent holders' rights.[192] The Court should not have restricted Congress's power to provide remedial or preventative measures to protect inventors' Fourteenth Amendment rights.[193] The *Florida Prepaid* decision leaves inventors with no adequate remedy against patent infringement by the states.[194]

States' rights proponents have argued that when a state infringes on a patent, that does not by itself violate the Constitution.[195] Instead, an unconstitutional deprivation of property only occurs when the state provides no remedies, or inadequate remedies, to injured patent owners

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1989) (detailing State of Tennessee's infringing upon structural design patent); Lemelson v. Ampex Corp., 372 F. Supp. 708, 710-12 (N.D. Ill. 1974) (examining State of Illinois' patent infringement against private individual); Hercules Inc. v. Minnesota State Highway Dep't, 337 F. Supp. 795, 796-98 (D. Minn. 1972) (detailing patent infringement suit against State Highway Department); *Jacobs*, 626 So. 2d at 1334-35 (detailing Florida state agency's infringement upon tidal flow system patent).

[191] *See* H.R. REP. NO. 101-960, pt. 1, at 38 (1990) (describing testimony that states would increasingly invoke sovereign immunity to free themselves from litigation in federal court).

[192] *See Florida Prepaid*, 527 U.S. at 658-660 (Stevens, J., dissenting) (raising concerns about impartiality of state courts in cases against state entities).

[193] *See Florida Prepaid*, 527 U.S. at 660-61 (Stevens, J., dissenting) (recognizing that Court has greatly weakened Congress's broad powers to deter or remedy constitutional violations); City of Boerne v. Flores, 521 U.S. 507, 519-520 (1997) (holding that Court should give Congress discretion in deciding measures to remedy or prevent unconstitutional actions); *see also* Michael W. McConnell, *Institutions and Interpretation: A Critique of* City of Boerne v. Flores, 111 HARV. L. REV. 153, 184 (1997) (arguing that because due process requirements are very hazy, Court should have focused on whether congressional interpretation was within reasonable range of plausible explanations). *See generally* JESSE CHOPPER, JUDICIAL REVIEW AND THE NATIONAL POLITICAL PROCESS 202-03 (1980) (arguing that Congress is just as competent as Court to resolve federalism issues); LAURENCE H. TRIBE, AMERICAN CONSTITUTIONAL LAW § 5-14, at 341 (2d ed. 1988) (discussing question of whether Congress has power to define constitutional rights without interference from judicial branch); Larry Kramer, *Understanding Federalism*, 47 VAND. L. REV. 1485, 1500-03 (1994) (noting that courts do not have capacity to gather and evaluate data relevant to decide where power should be allocated in federalist system).

[194] *See* Brief for the United States at 10, *Florida Prepaid* (No. 98-531) (commenting that Congress reasonably concluded that certain and predictable statutory remedies for patent infringement were necessary because of questions about adequacy of remedies in state courts); *see also* Cross, *supra* note 23, at 522 (concluding that Court's continued expansion of sovereign immunity will mean that individuals will have no forum for redress of certain state violations).

[195] *See* Brief of the Regents of the University of California at 2, *Florida Prepaid* (No. 98-531) (noting that Court has held that state actions do not offend due process when states remedy violations through post deprivation remedies); *cf.* Dennis v. Higgins, 498 U.S. 439, 460 (1991) (Kennedy, J., dissenting) (suggesting that § 1983 be available to vindicate rights arising under Article I of Constitution only where states fail to provide remedy, thereby creating separate violation of Due Process Clause).

for its infringement of their patent.[196] States' rights proponents assert that there is no evidence in the legislative record that states would not provide remedies for patent infringement in their own courts.[197]

The states' rights proponents argument is factually unsupported.[198] The legislative record clearly supports Congress's fear that state remedies insufficiently compensate inventors wronged by state patent infringement.[199] At a congressional hearing, Congress heard testimony that failure to enact the Patent Remedy Act would force patent holders to pursue uncertain, possibly non-existent, remedies under state law.[200] Moreover, witnesses informed Congress that requiring patent owners to ascertain the validity of their claims under the differing laws of the fifty states would create a substantial disincentive to suing.[201] The evidence made very clear that there was a real threat that states would not provide adequate remedies for patent infringement.[202] Thus, Congress appropriately enacted the Patent Remedy Act to insure protection for patent holders by giving federal jurisdiction over all patent infringement claims.[203] The Patent Remedy Act guarantees that patent holders will have a forum to adjudicate their claims against infringing state entities.[204]

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[196] *See* Zinermon v. Burch, 494 U.S. 113, 125 (1990) (holding that state action against protected interest is not in itself unconstitutional, only deprivation without due process of law violates Constitution); Williamson County Reg'l Planning Comm'n v. Hamilton Bank, 473 U.S. 172, 194-97 (1985) (holding that no constitutional violation of Takings Clause occurs by mere fact of taking, so long as state has procedure for compensation that property owner can use); Hudson v. Palmer, 468 U.S. 517, 532-33 (1984) (O'Conner, J., concurring) (stating that only when remedies of state law are inadequate, can deprivation of property without due process occur); Parratt v. Taylor, 451 U.S. 527, 539-51 (1981) (noting that states can satisfy Due Process Clause by providing compensation for takings).

[197] *See* Brief of the Regents of the University of California at 2, *Florida Prepaid* (No. 98-531) (arguing that Congress had no reason to believe that states threatened legal rights of patent holders).

[198] *See* Chew v. California, 893 F.2d 331, 332-35 (Fed. Cir. 1990) (exemplifying how state remedies are ineffective in patent infringement cases).

[199] *See* H.R. REP. NO. 101-960, pt. 1, at 14-38 (1990) (demonstrating how state remedies would be inadequate to compensate inventors for patent infringement).

[200] *See* H.R. REP. NO. 101-960, pt. 1, at 15 (detailing how state court remedies would be insufficient to compensate patent holders for infringement).

[201] *See Florida Prepaid*, 527 U.S. at 656-59 (Stevens, J., dissenting) (describing Acting Commissioner of Patents testimony that state laws vary dramatically in protecting patent holders from infringement).

[202] *See id.* at 649-51 (Stevens, J., dissenting) (noting federal interest in uniformity of patent laws and in closing loopholes which would undermine efficacy of federal law).

[203] *See id.* at 639-40 (commenting that Congress designed Patent Remedy Act to ensure that states would not deny patent holders remedies for damages resulting from infringement by states or state actors).

[204] *See* Brief for the United States at 10, *Florida Prepaid* (No. 98-531) (noting that Congress created Patent Remedy act so that there would be certain and predictable

Such a forum is crucial to protect patent holders' Fourteenth Amendment Due Process rights.[205]

2. Precise Congruence Exists Under the Patent Remedy Act in Protecting Patent Holders and Abrogating State Sovereign Immunity

In *Florida Prepaid*, the Court noted that it could not sustain the Patent Remedy Act because of its indiscriminate scope.[206] However, Congress clearly confined the coverage of the Act to cases involving constitutional violations.[207] Congress carefully tailored the Patent Remedy Act so that it was not over inclusive and barred no constitutional state action.[208] Congress followed *Boerne's* mandate that it may only enact legislation under the Enforcement Clause when a congruence between the means used and the ends to be achieved exists.[209] The Patent Remedy Act achieves a precise congruence between the means used of abrogating sovereign immunity and the goal of preventing further patent infringement by the states.[210] The congruence is equally precise whether state actors infringe on patents infrequently or often.[211] If patent infringement occurs infrequently, then the statute will operate only in those rare cases.[212] If, as state commercial activities increase, patent infringements become common, the impact of the statute will expand in proportion with the growth of the problem.[213] Thus, contrary to the

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statutory remedies for all patent holders).

[205] *See Florida Prepaid*, 527 U.S. at 655-56 (Stevens, J., dissenting) (arguing that relief under state laws would not be adequate avenue of recovery for patent infringement).

[206] *See id.* at 645-47 (claiming that Congress designed Patent Remedy Act to prevent both constitutional and unconstitutional state activity).

[207] *See id.* at 662 (Stevens, J., dissenting) (noting that Patent Remedy Act will only eliminate defense of sovereign immunity where state would deprive patent holders of their property without due process of law).

[208] *See* Brief for the United States at 13-14, *Florida Prepaid* (No. 98-531) (emphasizing that Patent Remedy Act does not prevent states from engaging in legitimate activity, but only prevents unlawful conduct by states).

[209] *See Florida Prepaid*, 527 U.S. at 662-63 (Stevens, J., dissenting) (stating that Patent Remedy Act does not impact any substantive rules of state law, but instead enforces well grounded federal policy to confine patent infringement cases to federal courts).

[210] *See* City of Boerne v. Flores, 521 U.S. 507, 520 (1997) (looking at means Congress used to achieve its legislative goal).

[211] *See Florida Prepaid*, 527 U.S. 627-662 (Stevens, J., dissenting).

[212] *See id.* at 663 (noting Patent Remedy Act's precision in putting states in same position as all private individuals who enjoy benefits of federal patent law).

[213] *See id.* at 662-63 (stating that Patent Remedy Act will expand in proportion to problem of patent infringement by states).

Court's assertion in *Florida Prepaid*, Congress designed the Patent Remedy Act in exact accordance with the *Boerne* requirements.[214]

B. Congress's Commerce Clause Power Supports Abrogation of State Sovereign Immunity

In *Florida Prepaid*, the Court continued to limit congressional authority by failing to recognize Congress's power, under the implied waiver doctrine, to abrogate state sovereign immunity.[215] The Supreme Court incorrectly rejected the implied waiver doctrine.[216] Under the implied waiver doctrine, Congress can use its Commerce Clause power to require a state to waive its immunity from suit in federal court.[217] States would have to waive their immunity when they engage in activity from which they might readily withdraw, such as federally regulated commercial activity.[218] The implied waiver doctrine allows a state to engage in business only if the state will avail itself to suit in federal court for litigation arising out of such business.[219]

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[214] *See id.* at 663 (noting that Patent Remedy Act does not implicate Court's concerns in *Boerne*).

[215] *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 680 (1999) (overruling *Parden*'s implied waiver doctrine).

[216] *See id.* at 698 (Breyer, J., dissenting) (arguing that Court should not abandon precedent of implied waiver doctrine as explained in *Parden*); *see also* United States v. California, 507 U.S. 746, 757-58 (1993) (noting that even federal government's rights and remedies may be different when it acts not in its sovereign capacity but as contractor similar to private enterprises); Kit Kinports, *Implied Waiver After* Seminole Tribe, 82 MINN. L. REV. 793, 793-98 (1998) (predicting that Congress's power to subject states to private suit in federal court through doctrine of implied waiver would survive *Seminole Tribe*, mitigating its impact). *But see* ROGER C. CRAMTON ET AL., CONFLICT OF LAWS 390 (5th ed. 1993) (questioning construct of fictional consent underlying implied waiver doctrine). *See generally* Matter of McVey Trucking, 812 F.2d 311, 313-18 (7th Cir. 1987) (discussing, in bankruptcy context, how Congress's inability to abrogate states' Eleventh Amendment immunity under Commerce Clause severely impairs its plenary power to regulate bankruptcies).

[217] *See College Savings*, 527 U.S. at 694-95 (Breyer, J., dissenting) (noting that both reason and precedent support principle of Congress using commerce power to require states to waive immunity from suit).

[218] *See* Parden v. Terminal Ry. of Ala. Docks Dep't, 377 U.S. 184, 191-93 (1964) (holding that state entity may engage in business traditionally carried on by private enterprise, but Congress may burden state entity with same regulations, remedies, and restrictions imposed on private individuals); *see also* RICHARD H. FALLON ET AL., HART AND WECHSLER'S THE FEDERAL COURTS AND THE FEDERAL SYSTEM 95-98 (4th ed. 1996) (noting that states may waive their Eleventh Amendment immunity by participating in federal litigation or by participating in federally regulated programs).

[219] *See Parden*, 377 U.S. at 198 (holding Congress can determine that state operating railroad must either stop activity or consent to legal responsibility for any injuries caused by operation of railroad).

When a state engages in ordinary commercial ventures, it acts as a private person.[220] The state is outside the area of its core responsibilities, no longer fulfilling any basic governmental obligations.[221] When a state acts as a private entity competing against other private firms in the marketplace, the state no longer deserves the protection of sovereign immunity.[222] The state is simply competing to supply what private firms already provide.[223] Therefore, if Congress grants states the protection of sovereign immunity, regulated private competitors will be at a distinct disadvantage.[224]

The implied waiver doctrine is extremely important in protecting competition in the economic arena.[225] Congress must be able to successfully enact economic legislation that will protect both commerce and the technology upon which it rests.[226] States have become involved in commercial patents in a manner that extends far beyond any notion of core governmental services.[227] For example, universities of the State of Florida received property rights in over 200 patents.[228] Florida's patents

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[220] *See id.* at 196 (holding that when state engages in kinds of activity, which would subject private persons to federal regulation, courts are to treat state exactly same as private person; *cf.* State of New York v. United States, 326 U.S. 572, 590 (1946) (holding federal government can tax states' income and treat state vendors and private vendors in same manner); State of South Carolina v. United States, 199 U.S. 437, 463 (1905) (holding that Congress has authority to tax state that engages in business of private nature).

[221] *See College Savings*, 527 U.S. at 694-95 (Breyer, J., dissenting) (noting that when state leaves sphere that is exclusively its own, state subjects itself to governmental regulation in same way as private person or corporation).

[222] *See id.* at 695-96 (noting that need for sovereign immunity is weak where state is providing what private entities already provide, thus state should not receive special treatment).

[223] *See Parden*, 377 U.S. at 197 (commenting that states have entered many forms of activity in which private persons and corporations engage).

[224] *See College Savings*, 527 U.S. at 704 (Breyer, J., dissenting) (commenting that Court is placing states beyond reach of law, and this will damage business); *see also* Currie, *supra* note 18, at 548 (arguing that sovereign immunity is terrible idea because courts should hold states accountable for their wrongs).

[225] *See College Savings*, 527 U.S. at 701-05 (Breyer, J., dissenting) (stating that Court's rejection of implied waiver doctrine threatens country's ability to enact economic legislation in same manner that Lochner v. New York, 198 U.S. 45 (1905), threatened nation's ability to enact social legislation).

[226] *See id.* at 703-04 (Breyer, J., dissenting) (arguing that commerce and technology need government protection in order to compete in increasingly global economy).

[227] *See* Eisenberg, *supra* note 176, at 1663 (describing increasing state involvement with patents).

[228] *See* Brief of New York Intellectual Property Law Association at 2, Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627 (1999) (No. 98-531) (stating that United States patent office issued 200 patents between January 1995 and

range from insect repellants and reinforced plastic concrete, to needles, semiconductor circuits, lasers, computer software, nuclear imaging, air conditioning, food processing, and methods of making various chemicals.[229]

The Florida Board of Regents and the Florida Department of Citrus also own patents.[230] These state entities elected to use the patent system in the same way as individuals and private companies.[231] For example, Florida is co-owner of many patents with private companies.[232] Florida owns nineteen patents, issued from 1995 to 1999, in conjunction with the private company International Flavors and Fragrances.[233] Further, the Florida legislature has expressly enabled its state entities to market their

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August 1997 to Florida State entities).

[229] *See* U.S. Patent Nos. 5,635,174, Insect Repellant and Attractant Compositions and Methods for Using Same; 5,599,599, Fiber Reinforced Plastic Concrete Composite Structural Members; 5,484,442 Intraosseous Needle; 5,659,362 VLSI Circuit Structure for Implementing JPEG Image Compression Standard; 5,652,763, Mode Locked Laser Diode in a High Power Solid State Regenerative Amplifier and Mount Mechanism; 5,642,502, Method and System for Searching for Relevant Documents From a Text Database Collection, Using Statistical Ranking, Relevancy Feedback and Small Pieces of Text; 6,625,489, Projection Screen for Large Screen Pictorial Display; 5,547,017, Air Distribution Fan Recycling Control.

[230] *See* U.S. Patent Nos. 5,532,363, Heteroaryl Substituted Oxazinone Compounds for the Preparation of Taxol; 5,514,389, System and Method for Pasteurizing Citrus Juice Using Microwave Energy.

[231] *See* Brief of New York Intellectual Property Law Association at 2, *Florida Prepaid* (No. 98-531) (arguing that states invoke benefits of patent system just as private individuals do).

[232] *See id.* at 2 (noting that Florida is joint assignee with private corporations in several patents).

[233] *See* U.S. Patent Nos. 5,458,882, Method for Repelling Aedes Aegyptae Using 3, 7-Dimethyl-6-Octenenitrile and/or 2 (3, 3-Dimethyl-2-Norbornylidene) Ethanol-1; 5,441,988, Housefly, Hornfly, and Mosquito Repellents and Apparatus Useful in Testing Efficacy of Same; 5,635,174, Insect Repellant and Attractant Compositions and Methods for Using Same; 5,635,173, Insect Repellant and Attractant Compositions and Methods for Using Same; 5,633,236, Insect Repellant Compositions and Methods for Using Same; 5,576,011, Method for Repelling Insects Using Cyclic Organic Alcohol or Carbonates and Device Useful in Carrying Out Such Method; 5,576,010, Use of Dimethyl Substituted Oxymethyle Cyclohexane Derivatives for Their Insect Repellant Properties; 5,521,165, Insect Repellant Compositions and Methods for Using Same; 5,472,701, Use of Dimethyl Substituted Oxymethyl Cyclohexane Derivatives for Their Repellancy Properties; 5,464,626, Dimethyl Substituted Oxymethyl Cyclohexane Derivatives and Uses Thereof for Their Insect Attractancy Properties; 5,449,695, Method for Repelling Aedes Aegyptae Using Carbocyclic Ketones, Aldehydes and Esters; 5,447,714, Method for Repelling Aedes Aegyptae Using Carbocyclic Ketones, Aldehydes and Esters; 5,439,941, Use of Alkyl Cyclopentanone and Phenyl Alkanol Derivative; 5,417,009, House Fly, Horn Fly, and Mosquito Repellants and Apparatus Useful in Testing Efficacy of Same; 5,409,958, Use of Alkyl Cyclopentanone and Phenyl Alkanol Derivative; 5,401,500, Insect Attractant Compositions and Methods for Using Same; 5,387,418, Method for Repelling Aedes Aegyptae Using Oxy-Substituted Carbocyclic Compounds.

patented technologies commercially.[234]

Florida's commercial involvement suggests that the Court should still respect *Parden*'s implied waiver limitation to state sovereign immunity.[235] Basic notions of fairness support the implied waiver doctrine.[236] Truly free markets demand that government regulations apply equally to all participants, public or private.[237] Congress needs the power to regulate states' patent activities because treating a state differently from identically situated private persons threatens Congress's objective of protecting patents from infringement.[238] Congress is avoiding an enforcement gap which, when combined with the pressures of a competitive marketplace, could place the state's regulated private competitors at a significant disadvantage.[239] This disadvantage could destroy much of the incentive of inventors to create beneficial products.[240]

The Court's extension of sovereign immunity thwarts the goals of the Constitution to promote scientific innovation.[241] First, the extension

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[234] *See* FLA. STAT. ch. 240.299 (1997) (authorizing every Florida State University to take any necessary action, including legal action, to protect against patent infringement).

[235] *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 704 (Breyer, J., dissenting) (recognizing that Congress has no satisfactory alternative methods to protect individuals' liberty from violation by state entities). *But see* Currie, *supra* note 18, at 548 (arguing that if Constitution is defective, Congress should amend rather than ignore it).

[236] *See College Savings*, 527 U.S. at 695 (Breyer, J., dissenting) (stating that implied waiver doctrine avoids enforcement gap between private actors and state entities); *see also* Parden v. Terminal Ry. of Ala. Docks Dep't, 377 U.S. 184, 191-92 (1964) (holding that Congress can require states to waive their immunity to suit if they engage in federally regulated activity from which they can readily withdraw).

[237] *See College Savings*, 527 U.S. at 694-95 (noting that because of competition between states and private actors in marketplace, Congress must be able to regulate states and remove any competitive advantages); *see also* California v. Taylor, 353 U.S. 553, 568 (1957) (holding that Congress's power to waive state sovereign immunity is necessary and proper exercise of its commerce power).

[238] *See* Brief for New York Intellectual Property Law Association at 7, Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627 (1999) (No. 98-531) (noting that states would have no incentive to develop their own patents and would simply infringe upon existing patented technologies).

[239] *See id.* (arguing that if government allowed states to work with technology free of patent laws, then their private partners in that work would receive unfair advantage over regulated competitors).

[240] *See id.* (noting that exempting states from patent laws would create disincentive to perform research and development in inventions likely to be used by states).

[241] *See* U.S. CONST. art. I, § 8, cl. 8 (promoting progress of science and art); *see also* Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 146 (1989) (noting that Constitution reflects need to encourage innovation); Diamon v. Chakrabarty, 447 U.S. 303, 307 (1980) (holding that patent laws promote progress of useful arts by offering inventors exclusive

creates a disincentive to perform research and development in technologies perceived as vulnerable to infringement by the states.[242] Second, the states would have no incentive to design around existing patented technologies.[243] Finally, if states could work with technology, free of the patent laws, their private partners may receive unfair advantages unavailable to those who do not work for the states.[244] Thus, many private actors would never take the financial risk of developing patents that states could freely infringe upon.[245]

The Court's exemption of states from patent law will lead to abuse.[246] This exemption will tempt states to infringe on private patents at the expense of the patent holder.[247] For example, state immunity places private universities and research institutions at a serious disadvantage in patent and copyright disputes with their state funded counterparts.[248] One realistic scenario is that a private university will sue a public university for patent infringement, only to have its claim dismissed after the public university invokes sovereign immunity.[249] Private universities will have no incentive to design their own patents because the patent

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rights for limited period of time as incentive for inventiveness and research efforts); John F. Nowak, *The Scope of Congressional Power to Create Cases of Action Against State Governments and the History of the Eleventh and Fourteenth Amendments*, 75 COLUM. L. REV. 1413, 1443 (1975) (noting serious concern of states' ability to thwart impact of federal regulations by creating procedural impediments to claims in state court).

[242] *See* Brief for New York Intellectual Property Law Association at 7, *Florida Prepaid* (No. 98-531) (arguing inventors would not develop patents that states could take without compensation).

[243] *See id.* (arguing that states would take patents instead of developing their own innovations).

[244] *See id.* (noting competitive edge that states would have over private competitors).

[245] *See, e.g.*, Chew v. California, 893 F.2d 331 (Fed. Cir. 1990) (demonstrating that inventor's patent could be worthless if Court does not allow Congress to abrogate state sovereign immunity in patent infringement cases).

[246] *See* Seminole Tribe of Fla. v. Florida, 517 U.S. 44, 77 (1996) (Stevens, J., dissenting) (cautioning that Court's preventing Congress from using Commerce Clause powers will preclude actions against states for broad range of federal law, including bankruptcy, environmental, copyright, and patent law); *see also* Brief of New York Intellectual Property Law Association at 7, Fla. Prepaid Postsecondary Education Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627 (No. 98-531) (arguing that sovereign immunity creates opportunity for states to inflict serious damage upon patent system).

[247] *See* France, *supra* note 3, at 74 (noting that as profits in patents continue to increase, universities and companies will clash over patents).

[248] *See* Williamson, *supra* note 1, at 1751 (noting that state sovereign immunity could prevent private universities from fighting back against infringement by state entities, such as public universities).

[249] *See id.* (describing concern that state universities will be able to make unauthorized copies of copyrighted works without having to compensate authors).

laws will not protect them from state infringement.[250] In turn, private corporations will choose to deal exclusively with state universities because state universities will be able to protect their own patents and also freely infringe on others.[251] Thus, in direct contradiction to the Constitution, an infringing public university reaps benefits from its theft of another's ingenuity.[252]

C. *State Courts are not an Appropriate Forum for Patent-Infringement Cases*

Congress reasonably concluded that, even if they were available, state remedies are inappropriate to guarantee patentees' due process rights in infringement actions against state defendants.[253] Most state judges do not have the exposure to patent litigation that federal judges have experienced.[254] Congress realized that complex patent litigation in ill equipped state courts would lead to inconsistent judgments.[255] Courts in

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[250] *See* Brief of New York Intellectual Property Law Association at 7, *Florida Prepaid* (No. 98-531) (arguing that sovereign immunity creates opportunities for companies working with states to erode patent system and inflict serious harm on nation's commerce).

[251] *See* France, *supra* note 3, at 74 (discussing valuable research that state universities produce and their ability to disregard federal patent law).

[252] *See* Brief of New York Intellectual Property Law Association at 7, *Florida Prepaid* (No. 98-351) (arguing that exempting state entities that are heavily involved in technology and patents would greatly harm Constitution's purpose of promoting useful arts).

[253] *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 659 (1999) (Stevens, J., dissenting) (noting that Congress passed Patent Remedy Act based on realistic fear that state court remedies would be insufficient to protect patent holders from infringement by states); *see also* Felder v. Casey, 487 U.S. 131, 138 (1988) (noting that state courts have duty to make reasonable accommodations for federal rights of action); Testa v. Katt, 330 U.S. 386, 394 (1947) (suggesting that state courts cannot invoke sovereign immunity as bar to federal rights of action). *See generally* Nicole A. Gordon & Douglas Gross, *Justiciability of Federal Claims in State Court*, 59 NOTRE DAME L. REV. 1145, 1156-77 (1984) (noting that state courts must allow federal claims in their courts without regard to state sovereign immunity); Louis E. Wolcher, *Sovereign Immunity and the Supremacy Clause: Damages Against States in Their Own Courts for Constitutional Violations*, 69 CAL. L. REV. 189, 303-04 (1981) (arguing that states have to entertain federal claims in their courts).

[254] *See Florida Prepaid*, 527 U.S. at 659 (Stevens, J., dissenting) (noting that state judges do not have experience that federal judges have in patent matters); *cf.* 30 COUNCIL OF STATE GOVERNMENTS, THE BOOK OF THE STATES 190-92 (1994) (indicating that 24 states have elected judges and 16 states have appointed judges who stand for retention elections); Martha A. Field, *The Meaning of Federalism*, 23 OHIO N.U. L. REV. 1365, 1376 (1997) (noting that state court judges face great political pressures because they often have to run for reelection); Pfander, *supra* note 62, at 201 (positing that Congress feared ability of state courts to provide dispassionate forum for enforcement of federal rights). *See generally* Stephen P. Bright, *Political Attacks on the Judiciary: Can Justice Be Done Amid Efforts to Intimidate and Remove Judges from Office for Unpopular Decisions?*, 72 N.Y.U. L. REV. 308, 311-25 (1997) (questioning independence of judiciary in states with popularly elected judges).

[255] *See* H.R. REP. NO. 101-960, pt. 1, at 34 (1990) (discussing testimony that plaintiffs in

each state could differ about whether a state entity had infringed an inventor's patent.[256] State adjudication of patent cases would lead to an incredible lack of uniformity because the Federal Court of Appeals has no jurisdiction to review the decisions of state courts.[257] Thus, only the Supreme Court could review state court decisions that arguably misapplied patent law, and the Court could never undertake such an immense task.[258]

Patent law requires an incredible degree of uniformity and consistency.[259] The need for uniform enforcement motivated Congress to lodge exclusive jurisdiction of actions arising under the patent laws in the federal courts.[260] Requiring state courts to hear patent infringement cases would seriously undermine the federal interest in the accurate and uniform resolution of patent law.[261] Inventors would face conflicting

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patent infringement cases would have to determine validity of their claims in every state).

[256] *See id.* (noting that 50 different state courts could reach 50 different conclusions regarding patent law issue).

[257] *See Florida Prepaid*, 527 U.S. at 659 (Stevens, J., dissenting) (noting that only Court of Appeals for Federal Circuit can review infringement actions brought in federal court). *See generally* Pfander, *supra* note 62, at 194-229 (proposing access to intermediate federal courts of appeal in matters adjudicated by state courts). *But see* THE FEDERALIST NO. 82, at 410-24 (Alexander Hamilton) (Clinton Rossiter ed., 1961) (finding that there is no constitutional bar to Congress authorizing lower federal courts to hear appeals from state courts); Amar, *supra* note 46, at 857, 869 (arguing Congress has authority to give federal courts power to review state court decisions).

[258] *See* McKeeson Corp. v. Division of Alcoholic Beverages & Tobacco, 496 U.S. 18, 26-27 (1990) (holding that Eleventh Amendment does not apply to Court's own exercise of jurisdiction in matters brought to it on appeal from state courts); Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 22-35 (1966) (noting strong federal interest in interpretation of patent laws that is uniform and faithful to constitutional goals of stimulating invention and rewarding novel and useful advances in technology); Jackson, *supra* note 60, at 6 (noting that Court will hear proceedings on appeal from states that are beyond authority of lower federal courts to hear as original matter); Daniel J. Meador, *A Challenge to Judicial Architecture: Modifying the Regional Design of the U.S. Courts of Appeals*, 56 U. CHI. L. REV. 603, 632 (1989) (noting that Court received 1201 petitions for review of state court decisions during 1987 term); Pfander, *supra* note 61, at 198 (noting that in 1995 and 1996 Court issued full opinions in 79 and 86 cases respectively; of those, just one-tenth came to Court from state courts); Gordon G. Young, Comment, Seminole Tribe v. Florida, 56 MD. L. REV. 1411, 1434 (1997) (noting that there is possibility of Supreme Court reviewing state court decisions, but prospect of such review is remote in modern times).

[259] *See Florida Prepaid*, 527 U.S. at 650 (Stevens, J., dissenting) (discussing basis of congressional authority over patents and Congress's decision to vest jurisdiction over infringement cases with federal courts); *see also* H.R. REP. NO. 97-312, pt. 1, at 22 (1981) (noting that Supreme Court's infrequent review of patent cases led to unevenness in adjudication of patent laws).

[260] *See Florida Prepaid*, 527 U.S. at 651-52 (Stevens, J., dissenting) (commenting that divergence of federal courts in patent law interpretation led Congress to consolidate appellate jurisdiction of patent appeals in Court of Appeals for Federal Circuit).

[261] *See id.* (Stevens, J., dissenting) (noting that same justifications of consistency and

decisions from the various state courts regarding the validity of their patent and infringement by state entities.[262] Inventors would risk losing the value of their patents because they would not have the financial capabilities to successfully litigate in so many different state courts.[263]

D. Congress's Other Options to Abrogate State Sovereign Immunity in Patent Infringement Actions are Ineffective

Congress has two other options to abrogate state sovereign immunity.[264] First, under the *Ex parte Young* doctrine, patent holders could sue state officials for patent infringement.[265] However, money damages are unavailable under an *Ex parte Young* action.[266] Second, Congress can condition states' receiving federal money on their waiver of sovereign immunity.[267] But it is unclear whether states would waive their immunity, if such a waiver would entail the loss of substantial revenues that patent infringement would generate.[268]

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uniformity for consolidating patent appeals apply to requirement that patent infringement claims be brought in federal court); Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 162 (1989) (commenting on federal interest in uniform body of patent law); *see also* Rohr Aircraft Corp. v. County of San Diego, 51 Cal. 2d 759, 764, 336 P.2d 521, 524 (Cal. 1959) (noting that state courts only have to follow precedent of Supreme Court, not those of lower federal courts).

[262] *See Florida Prepaid*, 527 U.S. at 658-59 (Stevens, J., dissenting) (discussing how every state could have different result in patent infringement actions).

[263] *See* Brief for the United States at 11, *Florida Prepaid* (No. 98-531) (arguing that state court adjudication of patent law would lead to protracted and costly litigation).

[264] *See* South Dakota v. Dole, 483 U.S. 203, 206 (1987) (holding that Congress may attach conditions to states receiving federal funds); *Ex parte* Young, 209 U.S. 123, 159-60 (1908) (holding that federal court can enjoin state official from ongoing or future violations of federal law).

[265] *See* Puerto Rico Aqueduct & Sewer Auth. v. Metcalf & Eddy, Inc., 506 U.S. 139, 146 (1993) (noting that *Ex parte Young* doctrine prevents state officers from continuing violations of federal law).

[266] *See* Hafer v. Melo, 502 U.S. 21, 30 (1991) (holding that courts cannot award money damages in actions against state officers sued in their official capacity).

[267] *See* Lawrence County v. Lead-Deadwood Sch. Dist., 469 U.S. 256, 269-70 (1985) (holding that Congress may impose conditions on states receiving federal funds).

[268] *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Bd., 527 U.S. 666, 697 (1999) (Breyer, J., dissenting) (noting that it would be harder for states to refuse highway funds than to refrain from entering investment services business).

1. The *Ex parte Young* Doctrine

Under the *Ex parte Young* doctrine, sovereign immunity is unavailable to state officials who act unconstitutionally, even though the state may have authorized their actions.[269] The only form of relief available under the *Ex parte Young* doctrine is injunctive relief.[270] Injunctive relief is only useful where money damages are not important.[271] To circumvent this limitation, a patent owner could sue in federal court for an injunction under *Ex parte Young*, while also suing the state entity in state court for compensation for infringement.[272] However, such an approach would create serious inefficiencies.[273] It would require a patent owner to pursue two separate litigation remedies and risk inconsistent judgments.[274] Thus, use of the *Ex parte Young* doctrine will not promote the congressional mandate of uniformity in patent law.[275]

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[269] *See* Williamson, *supra* note 1, at 1740-46 (stating that *Ex parte Young* doctrine permits suits against state officials to enjoin ongoing violation of federal law); *see also Puerto Rico Aqueduct*, 506 U.S. at 146 (noting that *Ex parte Young* doctrine does not allow judgments against state officials for past violations of federal law); Sterling v. Constantin, 287 U.S. 378, 393 (1932) (upholding injunction against Governor of Texas who imposed martial law and introduced production controls on oil drilling); Home Tel. & Tel. Co. v. City of Los Angeles, 227 U.S. 278, 287-88 (1913) (finding that Fourteenth Amendment also applies to officials who possess and abuse state power).

[270] *See Hafer*, 502 U.S. at 30.

[271] *See id.* at 30 (noting that *Ex parte Young* is not applicable where plaintiff seeks money damages from public treasury); Kentucky v. Graham, 473 U.S. 159, 169 (1985) (holding that Eleventh Amendment precludes award of damages in *Ex parte Young* action); Henry Paul Monaghan, *The Sovereign Immunity "Exception"*, 110 HARV. L. REV. 102, 132-33 (1996) (noting that *Seminole Tribe* is unlikely to have any substantial impact on enforceability of constitutional rights in suits for injunctive relief); *see also* Currie, *supra* note 18, at 547 (arguing that *Ex parte Young* doctrine is still intact after *Seminole Tribe* decision).

[272] *See College Savings*, 527 U.S. at 704 (Breyer, J., dissenting) (recognizing that Congress may achieve objective through *Ex parte Young* doctrine, but that this is only effective where money damages are not important).

[273] *Cf.* Larry Kramer & Alan O. Sykes, *Municipal Liability Under § 1983: A Legal and Economic Analysis*, 1987 SUP. CT. REV. 249, 277-80 (describing inefficiencies of judicial system where state officials are liable in tort).

[274] *See* Shaw v. Delta Air Lines, Inc., 463 U.S. 85, 95 (noting federal courts have jurisdiction to enjoin state officials from violating federal law, but plaintiffs can only obtain monetary damages in state courts).

[275] *See* Brief for the United States at 10, Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. at 686 (1999) (No. 98-531) (noting uncertainty of outcome when courts force plaintiff to commence suit in both federal and state court).

2. Discretionary Waivers

Congress could also condition states' receiving federal funding on their waiver of sovereign immunity.[276] This condition would essentially blackmail states into complying with Congress.[277] Congress would be in the difficult position of having to punish states by withdrawing funding if states choose not to waive their sovereign immunity in patent infringement actions.[278] However, even such drastic action by Congress might not convince a state to waive its sovereign immunity.[279] Given the amount of money at stake, a state may decide to continue infringing on patents and refuse to accept federal assistance, such as highway funding.[280] For Congress to compel states to waive their immunity, it would have to withhold funds that the states are reliant upon to function.[281] One fund that Congress has contemplated withholding is educational funding for children.[282] Only such oppressive congressional acts would convince a state to waive its immunity.[283] This would put the

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[276] *See College Savings*, 527 U.S. at 686 (Breyer, J., dissenting) (holding that Congress may condition grant of funds to states upon states' agreement to perform certain actions); South Dakota v. Dole, 483 U.S. 203, 206 (1987) (noting that Congress can embody necessary state waivers in federal funding programs). There has been a very intriguing recent development in California. In *New Star Lasers, Incorporated v. Regents of the University of California*, the Federal District Court denied the University of California's motion to dismiss a declaratory suit by a private party claiming patent infringement. *See* New Star Lasers, Inc. v. Regents of the Univ. of Cal., 63 F. Supp. 2d 1240, 1245 (E.D. Cal. 1999) (denying Regents' motion to dismiss for lack of jurisdiction). The Court cited to *College Savings*, concluding that a patent constitutes a gift given to inventors by the federal government. *See id.* at 1244 (noting that government bestows patents as gift or gratuity). Therefore, if Congress expressly conditioned the receipt of a patent on a waiver of Eleventh Amendment immunity to a declaratory suit, then Congress acted permissibly. *See id.* (holding that Congress has authority to grant patent to state on condition that state waive its Eleventh Amendment immunity).

[277] *See College Savings*, 527 U.S. at 697 (Breyer, J., dissenting) (noting that Congress's withholding of funds to states would be extremely oppressive and compelling).

[278] *See id.* (Breyer, J., dissenting) (commenting that only by Congress drastically taking away funds could Congress achieve its regulatory objectives).

[279] *See id.* (Breyer, J., dissenting) (noting that states might earn more money by competing in commercial markets than they would receive from government funding).

[280] *See* U.S. Dept. of Commerce, Bureau of Census, Federal Aid to States for Fiscal Year 1998, p. 17 (April. 1999) (noting that federal government provided over $20 billion to states for highways in 1998 and $21 billion for education).

[281] *See College Savings*, 527 U.S. at 697 (Breyer, J., dissenting) (noting that Congress would have to withhold funding from areas such as highways and education).

[282] *See* U.S. Dept. of Commerce, Bureau of Census, Federal Aid to States for Fiscal Year 1998, p. 5 (stating that federal government provided over $21 billion to states for education in 1998).

[283] There is also the problem that conditions on federal spending have to be reasonably related to the purpose of the expenditure. *See* Meltzer, *supra* note 53, at 55 (describing

federal government in the troubling position of having to harm its own citizens to obtain its objective of uniformity in patent law.[284] Such harsh legislation would irreparably damage the relations between the federal government and its citizens.[285] Therefore, instead of forcing Congress to take such drastic action, the Court should permit Congress to abrogate state sovereign immunity in patent infringement cases.[286]

CONCLUSION

In *Florida Prepaid* the Supreme Court improperly invalidated Congress's power to abrogate state sovereign immunity in patent infringement cases.[287] The Court erroneously failed to recognize Congress's Fourteenth Amendment Enforcement Clause power to protect inventors' property interests in their patents.[288] Also, the Court incorrectly abandoned the sound policy of the implied waiver doctrine.[289] Congress is now left with two options, both ineffective, to protect inventors from patent infringement by the states.[290]

This decision should strike fear into every patent holder and potential innovator. The states are now free to choose what patents they will use to generate profits for their own state-run programs.[291] This could prove

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necessary connection between funding and Congress's objective). It would be difficult to relate waivers in patent infringement cases to federal spending in areas such as highway funds. *See id.* (noting that although Congress could condition receipt of federal funds on waiver of Eleventh Amendment immunity, Congress would have difficulty in associating federal statutes with federal spending programs). *But see* Kinports, *supra* note 216, at 808 (arguing that requiring states to waive their Eleventh Amendment protection to suits challenging way in which they spend federal funds allocated by statute would satisfy definition of relatedness).

[284] *See College Savings*, 527 U.S. at 695-96 (Breyer, J., dissenting) (noting that only oppressive conduct by Congress would force states to abide by federal patent law).

[285] *See id.* (Breyer, J., dissenting) (describing rift that would develop between populace and government if government withheld important funding).

[286] *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627 (1999) (Stevens, J., dissenting) (arguing that Court's expansion of sovereign immunity is so unpredictable that it can only be harmful to American people).

[287] *See id.* at 2202 (holding Patent Remedy act unconstitutional).

[288] *See id.* at 2205-11 (holding that Congress could not justify Patent Remedy Act under its Enforcement Clause powers).

[289] *See id.* at 2203 (reaffirming that implied waiver doctrine is no longer viable).

[290] *See College Savings*, 527 U.S. at 704 (Breyer, J., dissenting) (noting that Congress can condition federal funding to states upon agreement that state will perform certain actions); *Ex parte* Young, 209 U.S. 123, 159-60 (1908) (permitting plaintiffs to sue state officials in federal court).

[291] *See* France, *supra* note 3, at 74 (arguing that state bureaucrats may begin infringing on patents).

devastating to our country's economic system, which is founded upon technological innovation.[292] Few inventors will expend the effort and resources to develop inventions for which they might not be compensated.[293] Thus, the Court in *Florida Prepaid* has discouraged innovation in direct contradiction to the mandates of the Constitution, and has placed private competitors at a distinct disadvantage to the states.[294] *Florida Prepaid* lays the foundation of a marketplace where stealing an invention is easier and more profitable than creating one.[295]

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[292] *See* U.S. CONST. art. I, § 8, cl. 8 (stating that Congress has power to promote invention and discovery).

[293] *See* France, *supra* note 3, at 74 (discussing possibility that Court has damaged property rights of corporations and hindered further growth of patent invention).

[294] *See College Savings*, 527 U.S. at 703-04 (Breyer, J., dissenting) (noting that Court's expansion of state sovereign immunity will harm individual citizens' ability to enforce their rights against states).

[295] *See* France, *supra* note 3, at 74 (warning companies that states may choose to infringe on profitable patents due to lack of legal repercussions).

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