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Recommended Citation
Michelle V. Francis States Escape Liability for Copyright Infringement?, 16 Pepp. L. Rev. 3 (1989)
Available at: http://digitalcommons.pepperdine.edu/plr/vol16/iss3/5

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States Escape Liability for Copyright Infringement?

I. INTRODUCTION

The United States Supreme Court has yet to review the interaction between the eleventh amendment and copyright legislation. Furthermore, until recently, the controversy over whether a copyright proprietor could sue a state, its instrumentality, or agency for copyright infringement had led to split decisions in the federal district and circuit courts.

The copyright and patent clause of the United States Constitution grants Congress the enumerated power to promote the creativity of authors and inventors by protecting and rewarding their creativity. Pursuant to this power, Congress has enacted legislation, which today is embodied in the Copyright Act of 1976 (the 1976 Act). This legislation grants copyright proprietors exclusive rights in their works and provides them a cause of action against "anyone" who infringes their copyright.

Section 301 of the 1976 Act provides that all rights concerning copyright must be adjudicated thereunder. Any rights that existed under the common law or statutes of any state equivalent to those governed by the 1976 Act are therefore preempted. To create uniformity in copyright law, Congress enacted section 1338(a) of Title 28 of the United States Code, which grants federal courts exclusive subject matter jurisdiction over any action arising under the 1976 Act. Federal courts are, therefore, the sole forum in which a copyright proprietor may bring a cause of action for copyright infringement.

4. 17 U.S.C. § 501(a) (1982) (defining copyright infringer as "[a]nyone who violates any of the exclusive rights of the copyright owner"); contrast the 1909 Act, which defines a copyright infringer as "any person" violating the exclusive rights of the copyright owner.
The eleventh amendment,\(^8\) however, denies suit against any state by citizens of another state or a foreign state. The Supreme Court has interpreted this amendment broadly, thus barring suits by citizens against their own state.\(^9\) As these legal principles interact, a copyright proprietor has been not only granted an exclusive right, but has also been denied any remedy against a state infringing upon the copyright. To date, all federal district and circuit courts previously holding the eleventh amendment subordinate to the 1976 Act have since ruled against such abrogation.\(^10\) There no longer exists a split in the federal courts: states are immune from suit for copyright infringement.

This judicial interpretation is significant. States, their institutions, and agencies—such as public schools and universities, hospitals, law enforcement and correctional facilities, and other entities owned or operated by states—are major users of copyrighted material. Thus, the adverse impact of allowing state misappropriation and/or unlicensed reproduction of textbooks, sound recordings, photographs, literature, videos, motion pictures, computer software, and sheet music, to name a few, is overwhelming. State sovereign immunity from copyright infringement liability has significant adverse effects upon the system of copyright: copyright proprietors are without protection from state infringement; copyright proprietors have diminished economic incentives for continued creative productivity; and finally, the availability of copyrighted works may decrease as a result.

Parts II and III of this comment trace the development, purpose, and scope of the eleventh amendment and copyright law, respectively. Part IV analyzes the impact of judicial interpretation of the eleventh amendment on the copyright system. Finally, Part V proposes solutions to what has become a severe injustice in a system initially developed not only to protect copyright proprietors, but also to encourage creativity for the general public benefit.

\(^8\) U.S. CONST. amend. XI. "The Judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State or by Citizens or Subjects of any Foreign State." Id.

\(^9\) Hans v. Louisiana, 134 U.S. 1 (1890); see infra notes 16-18 and accompanying text.

\(^10\) BV Eng'g v. University of California, 858 F.2d 1394 (9th Cir. 1988), cert. denied, 57 U.S.L.W. 3621 (1989) (overruling Mills Music, Inc. v. Arizona, 591 F.2d 1278 (9th Cir. 1979)). Mills held that states may be subjected to suit for copyright infringement. Under BV Engineering, states are immune from suit for copyright infringement. Furthermore, the United States District Court for the Western District of Virginia subjected states to copyright infringement suits in Johnson v. University of Virginia, 606 F. Supp. 321 (W.D. Va. 1985). One year later, the same court reached the opposite result in Richard Anderson Photography v. Radford University, 653 F. Supp. 1154 (W.D. Va. 1986), aff'd in part, rev'd in part sub nom., Richard Anderson Photography v. Brown, 852 F.2d 114 (4th Cir. 1988); see infra notes 93-148 and accompanying text.
II. DEVELOPMENT OF THE ELEVENTH AMENDMENT

In 1793, the Supreme Court, in Chisholm v. Georgia,11 held that a state was amenable to suit in federal court by citizens of another state. The Court asserted original jurisdiction over the suit, deciding the jurisdictional issue under article III, section 2 of the Constitution.12 This article extends federal judicial power to suits between states and citizens of another state.13 In response to this ruling, considerable national concern arose over the vulnerability of state treasuries to eager plaintiffs.14 The adoption of the eleventh amendment soon followed, and remains unchanged.15

A. The Scope of the Eleventh Amendment

1. Early Case Law Development

The eleventh amendment itself bars suit in law and equity against a state only by a citizen of another state or by foreigners. The Supreme Court has broadly interpreted this doctrine of sovereign immunity by carving out extensions and limitations. In Hans v. Louisiana,16 the Court held that immunity extends to actions in federal court by citizens suing their own state.17 The decision was based on the fact that the eleventh amendment did not contain a clear statement preventing a citizen's suit.18

In Ex Parte Young,19 the Court created an exception to the elev-

11. 2 U.S. (2 Dall.) 419 (1793) (where two South Carolina citizens sued in diversity the State of Georgia to enforce a debt owed to a deceased South Carolina resident).
12. U.S. CONST. art. III, § 2, cl. 1. "The judicial Power shall extend to all Cases, in Law and Equity, arising under this Constitution, the Laws of the United States .... to Controversies between two or more States;—between a State and Citizens of another State; [and] between Citizens of different States." Id.
13. Chisholm, 2 U.S. (2 Dall.) at 420.
15. U.S. CONST. amend. XI (ratified February 7, 1795). The amendment provides: "The judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by Citizens of another State, or by Citizens or Subjects of any Foreign State." Id.
16. 134 U.S. 1 (1890) (suit against state by Louisiana citizen to recover damages for interest coupons annexed to bonds of the state).
17. Id.
18. Id. at 15.
enth amendment's jurisdictional bar. The Court held that the amendment did not bar a federal court action seeking to enjoin a state official from enforcing a statute which violated the fourteenth amendment. The state official was not viewed as representing the state during such a violation, and therefore was susceptible to suit as an individual. However, the non-consenting state remained immune from suit.

In *Petty v. Tennessee-Missouri Bridge Commission*, the Court ruled that federal law alone should govern sovereign immunity questions. This decision left the state legislature with no power to abrogate the eleventh amendment. In so deciding, the Court recognized Congress's power to place a condition upon states that wished to participate in federally-regulated activities. This condition constituted a waiver of eleventh amendment immunity.

2. The *Parden-Employees-Edelman* Trilogy

*Parden v. Terminal Railway Co.* was brought by an individual "upon a cause of action expressly created by Congress." For the first time, the Supreme Court was faced with the question of whether, through the enactment of a federal statute (the Federal Employee Liability Act (FELA)), Congress intended to subject a state to suit in federal court, and if so, whether Congress had constitutional power to unilaterally abrogate the eleventh amendment, thus removing the state consent-to-suit requirement.

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20. Id. at 159-60.
21. Id. The relief granted in *Ex Parte Young* was not monetary, but prospective in nature: an injunction to conform future behavior of the state official in accordance with the fourteenth amendment. See id. at 164-65.
22. Id. at 159-60.
24. Id. at 279-80.
25. Id. at 280.
26. 377 U.S. 184 (1964). *Parden* involved an action brought for damages under the Federal Employers Liability Act [hereinafter FELA] by employees of a state-owned interstate railroad for personal injuries sustained while employed by the railroad. FELA states:

> Every common carrier by railroad while engaging in commerce between any of the several States . . . shall be liable in damages to any person suffering injury while he is employed by such carrier in such commerce . . . [and that] [u]nder this chapter an action may be brought in a district court of the United States.

28. Id. See supra note 26 for pertinent text of the FELA statute.
30. Abrogation of the eleventh amendment negates the need for the consent-to-suit requirement.
The Court concluded that the legislative intent and the language of FELA revealed Congress's desire to include states in the class of possible defendants under a FELA cause of action. Due to the "broad and all-embracing" use of "every common carrier" in its definition of possible defendants, the Court recognized that application of sovereign immunity would result in granting a plaintiff a right without a remedy. The Court was "unwilling to conclude that Congress intended so pointless and frustrating a result." Thus, if sufficient congressional intent is found through both legislative history and statutory language, a court should recognize congressional power to subject non-consenting states to suit—regardless of eleventh amendment immunity.

Further, each state has surrendered a portion of its sovereign immunity through ratification of the Constitution, thereby granting Congress the power to regulate interstate commerce. In Parden, the state-owned railroad, which engaged in interstate commerce after enactment of FELA, had entered into activities subject to congressional regulation; thus, the state impliedly subjected itself to suit in federal court. Parden made states amenable to suit in federal court whenever they undertook an activity for which a private person could be held liable under federal law.

In Employees of Department of Public Health & Welfare v. Department of Public Health & Welfare, the Court affirmed Parden. Power exists to subject non-consenting states to suit in federal court when Congress so intends. The Court focused on the Fair Labor Standards Act's (FLSA) use of the language "any employer," together with its mandate that suit could only be brought in competent


32. Id. at 189.

33. See supra note 26 and accompanying text.

34. Parden, 377 U.S. at 190 (emphasis added).

35. Such power is derived from the commerce clause of the Constitution: "Congress shall have Power to... regulate Commerce with foreign Nations, and among the several States, and with Indian Tribes." U.S. CONST. art. I, § 8, cl. 3.


37. Employees, 411 U.S. at 286-87.
jurisdictions. Although finding that “any employer” includes states and their agencies, the Court held that the absence of congressional intent to subject states to suit was sufficient to prevent state liability. Furthermore, although FLSA allows federal court actions, the eleventh amendment renders federal courts incompetent to hear suits by employees against a state.

Employees was justified by the Court’s distinction of Parden in three significant ways: (1) FLSA suits could be brought in state courts; FELA suits could not; (2) FLSA imposes a financially overburdensome scheme of regulation on states; Parden involved an isolated activity with no such burden; and (3) the Court did not find congressional intent to subject states to suit under FLSA, whereas such intent was present under FELA.

In Edelman v. Jordan, the Court addressed the issue of whether state operation of a federally-assisted program was a clear indication of its consent to suit in federal court. The Court found it was not. Further, the Court determined that the Aid to Aged, Blind, and Disabled statute created no cause of action against states by beneficiaries. Congressional intent to subject states to suit—thereby abrogating the eleventh amendment—was determined “wholly absent.”

Through Edelman, the Court refined its interpretation of the eleventh amendment. An express cause of action is not stated within a statute absent congressional intent to subject states to suit and absent implied state waiver. Moreover, state participation in a federally-assisted program does not imply state consent to suit. To allow amenability to suit under Employees and Edelman, intent must be specifically addressed within the applicable federal law.

38. Id. at 284.
39. Id. at 284-85.
40. Id. at 287.
41. Id. at 284-86. The Court also justified its holding by distinguishing Parden on the basis that the state did not waive immunity by operating a non-profit health center.
42. 415 U.S. 651 (1974) (class action against state officials administering federal-state programs of Aid to the Aged, Blind and Disabled).
43. Id. at 671-74.
44. Id. at 673-74.
46. Edelman, 415 U.S. at 674-77.
47. Id. at 672.
48. Id. at 671. The Court specifically disapproved the holding in Shapiro v. Thompson, 394 U.S. 618 (1969). Also disapproved were three district court decisions which had been summarily affirmed by the Supreme Court. See Edelman, 415 U.S. at 670 n.13. The Supreme Court, relying on Ex Parte Young, pointed out that although the eleventh amendment prohibits retrospective monetary relief, it allows an award of prospective injunctive relief to bar any future unconstitutional conduct. Id. at 677.
49. See supra notes 43-44 and accompanying text.
3. The Beginnings of Congressional Abrogation of the Eleventh Amendment

The Court discarded the requirement of state waiver or consent to suit in *Fitzpatrick v. Bitzer,* thus giving Congress the unilateral power to abrogate the eleventh amendment. By treating the Equal Opportunity Act of 1972 as an exercise of congressional authority under section 5 of the fourteenth amendment, the Court found clear evidence of intent to abrogate the eleventh amendment. The Court concluded that Congress has sufficient plenary power to abrogate the eleventh amendment. The enabling clause of the fourteenth amendment permits Congress to pass "appropriate legislation" necessary to enforce equal protection and due process against the states. *Fitzpatrick* was expanded in *Hutto v. Finney,* where the Court found clear evidence of the inclusion of states in the defendant class by looking solely at congressional intent, rather

50. 427 U.S. 445 (1976). *Fitzpatrick* brought an action against the State of Connecticut to have a state retirement plan declared unconstitutional based on sex discrimination. He relied on certain 1972 amendments to Title VII of the Civil Rights Act of 1964, in which Congress had authorized the federal courts to award monetary damages against states for sex discrimination to private individuals. *Id.* at 448-49; see 42 U.S.C. §§ 2000e(a)-2(a) (1982). The court of appeals held that *Edelman* controlled and money damages could not be awarded. *Fitzpatrick,* 427 U.S. at 450-51. The Supreme Court reversed.


52. U.S. CONST. amend. XIV, § 5. "The Congress shall have the power to enforce, by appropriate legislation, the provisions of this article." *Id.*

53. *Fitzpatrick,* 427 U.S. at 452.

54. *Id.* at 456. Treating the 1972 Equal Opportunity Act as an exercise of congressional authority under section 5 of the fourteenth amendment, the Supreme Court held Congress could require the state to provide back pay to victims of state discrimination. *Id.; see also Quern v. Jordan,* 440 U.S. 322 (1979). *Quern,* a sequel to *Edelman,* involved the issue of whether the federal court could order the state to send an explanatory notice to advise members of the plaintiff class about state administrative procedures available which determined entitlement to past welfare benefits. *Id.* at 334.


57. 437 U.S. 678 (1978) (prison inmates' suit against state officials demanding correction of unconstitutional conditions in Arkansas prison system). *Hutto* involved the Civil Rights Attorney's Fees Awards Act of 1976 (Pub. L. No. 94-559, 90 Stat. 2641 (1976) (codified at 42 U.S.C. § 1988 (1982)), which grants payment of attorney's fees in "any" action to enforce particular civil rights laws. *Id.* at 694. The Supreme Court, relying upon the congressional intent of the statute in question, allowed the prison inmates to recover attorney's fees, even though the statute did not expressly include states as possible defendants. *Id.* at 699-700.

58. *Hutto,* 437 U.S. at 693-96. The holding in *Hutto,* however, may be limited to its specific facts because of *Atascadero State Hospital v. Scanlon,* 473 U.S. 234 (1985) (statutory language must evidence unmistakable intent to support a finding of abrogation of the eleventh amendment). Justice Powell partially dissented in *Hutto* claiming that
than relying on statutory language.

4. The Supreme Court's Most Recent Interpretation of Congressional Abrogation of the Eleventh Amendment

Abrogation resulting from a federally-created cause of action was not addressed again until Atascadero State Hospital v. Scanlon. The statute at issue was the Rehabilitation Act, which grants remedies to any individual harmed by an act or omission by "any recipient of Federal assistance." The Court developed a stringent test to determine state waiver of immunity from federal court jurisdiction. A federally-created cause of action, as developed within a statute, "must specify the State's intention to subject itself to suit in federal court." The Court asserted:

In the absence of an unequivocal waiver specifically applicable to federal-court jurisdiction, we decline to find that California has waived its constitutional immunity. Congress may abrogate the States' constitutionally secured immunity from suit in federal court only by making its intention unmistakably clear in the language of the statute.

Clarifying its position on eleventh amendment immunity, the Court determined that recovery from a state was barred absent definitive statutory language, despite the Rehabilitation Act's remedial provisions.

the statutory language was not specific enough to override eleventh amendment immunity and that the awarding of attorney's fees would impose too substantial a burden upon the state treasury. Hutto, 437 U.S. at 704, 708 (Powell, J., concurring in part, dissenting in part). Justice Powell also wrote the majority opinions in both Atascadero and Welch v. Texas Department of Highways & Public Transportation, 107 S. Ct. 2941 (1987) (suit under Jones Act not allowed unless state expressly waives immunity). Hutto, Atascadero, and Welch are significant in terms of analysis because other cases in this time frame did not involve federally-created causes of action. See Pennhurst State School & Hosp. v. Halderman, 451 U.S. 1 (1981) (Developmentally Disabled Assistance and Bill of Rights Act, as a federal-state funding statute, does not create rights to abrogate the eleventh amendment); see also Pennhurst State School & Hosp. v. Halderman, 465 U.S. 89 (1984) (eleventh amendment barred pendent state law claim).


61. Id. The Rehabilitation Act, as amended, uses the language “[n]o otherwise qualified handicapped individual.” Id.


63. Id. (emphasis in original). CAL. CONST. art. III, § 5. Section 5, upon which plaintiff Atascadero relied, did not specifically indicate a state's willingness to be sued in federal court and provided that suits may be brought against the state in such a manner and in such courts as shall be directed by law. This was insufficient to constitute a waiver of California's eleventh amendment sovereign immunity.

64. Atascadero, 473 U.S. at 241-42 (emphasis added).

65. See id. at 246. The Court appears to reject its holding in Parden v. Terminal Railway Co., 377 U.S. 184 (1964), however it does not explicitly do so; see supra notes 26-35 and accompanying text.
Consequently, *Atascadero* limited *Fitzpatrick* in two ways. First, the Court held that Congress's power to unilaterally abrogate the eleventh amendment, absent state consent, was limited to laws passed pursuant to section 5 of the fourteenth amendment. Second, Congress could not limit eleventh amendment protection by *generally* authorizing a federal cause of action; specific inclusion of states as defendants was required.

The Court's most recent ruling on implied waiver is found in *Welch v. Texas Department of Highways & Public Transportation*. *Welch* involved an action brought under the Jones Act, which provides that "any seaman" injured during the scope of employment may sue for damages in federal district court. The Court held that Congress had not expressed in "unmistakable statutory language" any intent to abrogate the eleventh amendment; "any seaman . . . is not the kind of unequivocal statutory language sufficient to abrogate the Eleventh Amendment." Congress can create an exception to the eleventh amendment only through an unmistakably clear intent evidenced in the statutory language.

*Welch* reveals that the Court has reserved judgment on whether Congress may abrogate the eleventh amendment pursuant to its article I power: "assum[ing], without deciding or intimating a view of the question, that the authority of Congress to subject non-consenting States to suit in federal court is not confined to section 5 of the Fourteenth Amendment." Notably, the Court has never permitted

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68. See supra notes 59-65 and accompanying text.
69. Id.
70. 107 S. Ct. 2941 (1987). Plaintiff, an employee of the Texas Highways Department, filed suit against the department and the state under section 33 of the Jones Act (46 U.S.C. § 688 (1978) (amended 1982)) after being injured while working on a ferry dock operated by the department.
72. Id.
74. Id. (quoting *Atascadero*, 473 U.S. at 246) (italics omitted); see Comment, More Plenary Than Thou: A Post-Welch Compromise Theory of Congressional Power to Abrogate Sovereign Immunity, 88 COLUM. L. REV. 1022 (1988).
75. *Welch*, 107 S. Ct. at 2946. To the extent that *Parden* is inconsistent with the Supreme Court's holdings in *Atascadero* and *Welch*, it is overruled. Thus, the *Parden* discussion of congressional intent as sufficient to abrogate the eleventh amendment is no longer good law. *Welch*, 107 S. Ct. at 2948.
states to raise the eleventh amendment as a bar to suit when federal jurisdiction is exclusive.77 Such is the case with the 1976 Act.

III. DEVELOPMENT, PURPOSE, AND SCOPE OF COPYRIGHT LAW

A. Origins and Development of Copyright Law

The copyright and patent clause grants Congress the power “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings and Discoveries.”78 The clause encourages a free flow of ideas and promotes creativity by granting a monopoly, limited in time, excluding others from using works without authority.79 Pursuant to this clause, Congress has the power to enact any legislation consistent with the intent of the Constitution. Further, state ratification of the copyright and patent clause constitutes the relinquishment of each state’s sovereign power over copyrights and patents whenever Congress exercises its power concurrently. Consequently, strict limitations or actual abrogation of eleventh amendment immunity seems inherent in the clause.

Pursuant to this grant of power, Congress enacted the first federal patent and copyright legislation in 1790,80 in order to develop a national system of enforcement for the right created in authors and inventors. Since 1790, Congress has “fixed the conditions upon which patents and copyrights shall be granted,”81 revising the legislation four times—1831,82 1870,83 1909,84 and 1976.85 These revisions were made to protect new forms or expression from exploitation as they


78. U.S. CONST. art I, § 8, cl. 8. The copyright and patent clause was founded in the English system, specifically in the Statute of Anne (8 Anne ch. 19 (1710)), which provided authors with a 14 year exclusive right to print their new works and with a renewal right spanning an additional 14 years. This shifted the emphasis within English copyright law from serving the interests of publishers to serving the interest of the producer of the creative work. See Comment, The Applicability of Eleventh Amendment Immunity Under the Copyright Acts of 1909 and 1976, 36 AM. U.L. REV. 163, 173-74 (1986).


became commercially significant.\textsuperscript{86}

\textbf{B. The Copyright Act of 1976}

Section 501 of the 1976 Act establishes a right of action for copyright infringement:

(a) \textit{Anyone} who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118, or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright. (b) The legal or beneficial owner of an exclusive right under a copyright is entitled, subject to the requirements of sections 205 (d) and 411, to institute an action for any infringement of that particular right committed while he or she is the owner of it.\textsuperscript{87}

Owners of copyrighted material may, consequently, bring a federally-created cause of action against an infringer of their copyright. An infringer is defined as “\textit{anyone}” who violates the owner’s exclusive rights.\textsuperscript{88} Unfortunately, the legislative history of the 1976 Act does not define the term “\textit{anyone},” nor does it define the class of possible defendants subject to suit for copyright infringement.\textsuperscript{89} The resulting question is whether states are considered possible defendants, and therefore included within the term “\textit{anyone}.”

A copyright owner may vindicate violations of his property rights. Pursuant to section 301 of the 1976 Act and section 1338(a) of Title 28 of the United States Code, a copyright infringement suit can only be brought in federal court; state courts are not available forums.\textsuperscript{90} As the following discussion demonstrates, this jurisdictional limitation, when coupled with the eleventh amendment, \textit{completely} destroys a copyright owner’s right to sue for copyright infringement. Such a result is inconsistent with the federally-created property right in copyrighted material. Indeed, it denies exercise of that property right, leaving proprietors with no remedy for infringement. Authors are

\textsuperscript{86} As new forms of expression became commercially important, and with the advance of technology, the copyright law was revised. In addition, the 1976 revision altered the time at which a work could give rise to a copyright. Initially, copyright protection attached upon the publication of the work. The 1976 revision made the event no longer publication, but instead, fixation of the work in a tangible form of expression. The 1976 revision allowed Congress to exercise more fully its power under the copyright and patent clause.

\textsuperscript{87} 17 U.S.C. §§ 501(a), (b) (1982) (emphasis added).

\textsuperscript{88} However, the 1909 Act reads: “If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable.” Pub. L. No. 60-349, ch. 320, 35 Stat. 1075, 1081 (1909) (superseded by 17 U.S.C. § 501(a) (1982)) (emphasis added).

\textsuperscript{89} The legislative history of the 1909 Act also fails to clarify the definition of “any person.” See, e.g., 43 \textit{Cong. Rec.} 3701-05, 3744-47, 3761-69, 3831-32 (1909).

\textsuperscript{90} \textit{See supra} notes 5-7 and accompanying text.
consequently denied compensation and encouragement to produce additional creative works, consistent with the original intent of the 1976 Act. Moreover, states are, in essence, encouraged to infringe, as they are free from liability for acts of infringement.

C. Copyright Law and the Eleventh Amendment: Federal Court Interpretation

1. Copyright Law Pre-Atascadero/Welch

Despite the finding in *Wihtol v. Crow*\(^9\) that the defendant had infringed copyrighted material, the Eighth Circuit barred the plaintiff from suing a state instrumentality for damages payable from state funds.\(^9\) Seventeen years later, the Ninth Circuit, in *Mills Music, Inc. v. Arizona,*\(^9\) refused to follow *Wihtol.* The Ninth Circuit held that the eleventh amendment does not bar suits against states infringing copyrights.\(^9\) Thus, a music publisher prevailed against a state for infringement of a copyrighted musical composition.\(^9\) The court found the state was immune from suit absent waiver or consent to federal jurisdiction.\(^9\) Relying on the "Parden-Employees-Edelman trilogy,"\(^9\) the court concluded that waiver occurs when: (a) Congress has created a cause of action against a class of defendants which includes states; and (b) the state enters into the federally-regulated activity.\(^9\)

The *Mills* court concluded that Congress authorized suit against a broad class by its use of the words "any person"\(^9\) in defining a copyright infringer. The court determined that the language "any person" was "sweeping and without apparent limitation," thus suggesting Congress's intent to include states as defendants.\(^9\) The

\(^9\)1. 309 F.2d 777 (8th Cir. 1962). Without authorization, Crow, head of the vocal department at an Iowa junior college, copied Wihtol's copyrighted song, rearranged it, and printed it, making no reference to its copyright owner. *Id.* at 778-79.
\(^9\)2. *Id.* at 781-82. Defendants were a state school district and state agent constituting part of a state educational system which performed a "state governmental function under state law and at state expense." *Id.* at 782.
\(^9\)3. 591 F.2d 1278 (9th Cir. 1979). Mills Music sued the State of Arizona for infringement of a musical composition by the coliseum board, an agency of the State of Arizona, to promote a state fair. *Id.* at 1280.
\(^9\)4. *Id.* at 1288. *Mills* was decided under the 1909 Act. See *id.* at 1278 n.1.
\(^9\)5. *Id.* at 1280, 1286-87.
\(^9\)6. *Id.* at 1282.
\(^9\)7. *Id.* at 1283; see supra notes 26-49 and accompanying text.
\(^9\)8. *Id.* at 1283. It is important to realize that *Mills* is pre-Atascadero; therefore, the language "any person" within the 1909 Act was not subjected to Atascadero's stringent standard that statutory language be unmistakably clear in providing a federal cause of action applicable to states.
\(^10\)0. *Mills*, 591 F.2d at 1284-85. The term "any person" is common in other federal statutes. See *id.* at 1284 n.7.
eleventh amendment was considered subordinate to the copyright and patent clause, which empowered Congress "to regulate the commercial disposition of a certain property right." Further, the financial burden upon the state treasury, which might result from such a suit, was viewed as minimal. The Ninth Circuit concluded that the eleventh amendment holds no weight against a cause of action created in a federal statute pursuant to the copyright and patent clause.

Johnson v. University of Virginia was the first eleventh amendment and copyright infringement case decided under the 1976 Act. Without a discussion of state consent, the Johnson court focused on Mills' reading of Edelman—waiver of sovereign immunity must be explicit or overwhelmingly apparent in the applicable statute. The 1976 Act replaced the 1909 Act's "any person" with the word "anyone." Johnson perceived this revision to be "at least as sweeping, and probably more sweeping" than the language "any person" in the definition of the class of infringers. The court also held that the eleventh amendment provides no state sovereign immunity in this context because immunity was waived by Congress's enactment of the 1976 Act.

In Mihalek Corp. v. Michigan, the district court explicitly ruled that states were not immune from copyright infringement suits. The

101. Id. at 1285.
102. Id. The court's conclusion that states liable for copyright infringement shall not suffer financial hardship is based upon the fact that states infrequently participate in infringement of copyright. See id.
103. 606 F. Supp. 321 (W.D. Va. 1985) (allegation that University of Virginia and two employees infringed plaintiff's copyright of two photographs).
104. Id. at 323; see Mills Music, Inc. v. Arizona, 591 F.2d 1278, 1283 (9th Cir. 1979).
106. See supra notes 87-89 and accompanying text.
108. Id.
109. Id. at 322.
110. 595 F. Supp. 903 (E.D. Mich. 1984), qff'd, 814 F.2d 290 (6th Cir. 1987). Plaintiff, requesting damages and injunctive relief, brought suit in federal district court against the state and state officials alleging copyright infringement as a result of the misappropriation of his copyrighted designs. Id. at 904-05. The district court entered summary judgment for the state on the copyright and trademark infringement action. Id. at 906. On appeal, the Sixth Circuit did not reach the eleventh amendment issue. Instead, the court held:

The fact that [the copyright holder] envisioned a promotional campaign featuring the use of tee-shirts, hats, slogans, pictures, and promotional events, and that the campaigns utilized by the State of Michigan incorporated these generally universal ideas . . . in a public relations program to spotlight affirmative things about the State of Michigan is not any indication of similarity
court determined that infringement “is deserving of no more protection” than was allowed for benefits to the aged, blind, and disabled in Edelman—which was none.\textsuperscript{111} The state and its agencies were, thus, totally immune from suit.\textsuperscript{112} Consequently, a split developed in the federal circuit and district courts.

2. Copyright Law Post-Atascadero/Welch

Decided two months after the Court’s ruling in Atascadero, Woelffer v. Happy States of America\textsuperscript{113} reveals the first effects of Atascadero\textsuperscript{114} on the 1976 Act’s interaction with judicial interpretation of the eleventh amendment. The Woelffer court reaffirmed the proposition that a state may waive its immunity and consent to suit in federal court.\textsuperscript{115} A federally-created cause of action, however, may cause such a waiver only if Congress made its intent to include states as defendants “unmistakably clear in the language of the statute.”\textsuperscript{116} Although Johnson and Mills held that “any person” and the current version of the 1976 Act arguably included states in the defendant class, Atascadero demands specific unequivocal language.\textsuperscript{117} The Woelffer court, therefore, concluded that the inferences drawn from the 1976 Act’s use of “anyone” are insufficient to constitute waiver.\textsuperscript{118} In addition, the court refused to extend Fitzpatrick\textsuperscript{119} beyond a situation where a statute is passed pursuant to section 5 of the fourteenth amendment.\textsuperscript{120}

where the individual clothing items, slogans, pictures and events were substantially different.

\textit{Mihalek Corp.}, 814 F.2d at 294-95.
\textsuperscript{111} \textit{Mihalek Corp.}, 595 F. Supp. at 906; see also Edelman v. Jordan, 415 U.S. 651 (1974) (eleventh amendment barred retroactive relief against state because it constituted an award of damages against the state in violation of federal law).
\textsuperscript{112} \textit{Mihalek Corp.}, 595 F. Supp. at 906 (citing Pennhurst State School & Hosp. v. Halderman, 465 U.S. 89 (1984) (eleventh amendment not only prohibits suit against state but also prohibits federal court from awarding injunctive relief against state officials for claims predicated on state law). Injunctive relief was awarded against the individual defendants enjoining future violations because the eleventh amendment offers no protection to non-state codefendants in a suit involving a state. \textit{Id.} (citing \textit{Ex Parte Young}, 209 U.S. 123 (1908)).
\textsuperscript{113} 626 F. Supp. 499 (N.D. Ill. 1985). A state agency sought declaratory judgment that the eleventh amendment barred defendant corporation’s copyright claim because of the state’s use of a slogan in its tourism campaign. Plaintiffs included the Illinois Department of Commerce and Community Affairs, its directors, and an independent advertising agency who had submitted work to the Department. \textit{Id.} at 501.
\textsuperscript{114} Atascadero State Hosp. v. Scanlon, 473 U.S. 234 (1985); see supra notes 59-69 and accompanying text.
\textsuperscript{115} Woelffer, 626 F. Supp. at 504-05.
\textsuperscript{116} \textit{Id.} at 504 (citing Atascadero, 473 U.S. at 242).
\textsuperscript{117} Atascadero, 473 U.S. at 243.
\textsuperscript{118} Woelffer, 626 F. Supp. at 504-05.
\textsuperscript{119} Fitzpatrick v. Bitzer, 427 U.S. 445 (1976); see supra notes 50-56 and accompanying text.
\textsuperscript{120} Woelffer, 626 F. Supp. at 505 n.9. The court stated: “The Supreme Court has
In *Richard Anderson Photography v. Radford University*, the federal district court, which one year earlier presided over *Johnson*, ruled differently. The court now found both eleventh amendment and state law immunity, dismissing all claims against the defendant state university. The Fourth Circuit affirmed, stating that Congress' use of "anyone" is not, "in itself, a sufficiently clear and unequivocal indication of congressional intent to subject non-consenting states to suits." After a detailed review, the court still concluded that the total language of the 1976 Act does not clearly and unequivocally abrogate the eleventh amendment.

The Fourth Circuit also addressed whether state use of copyrighted material constitutes participation in a federally-regulated activity and whether such participation constitutes constructive consent. The court concluded that abrogation of eleventh amendment immunity by participation in a federally-regulated activity exists where "a congressional expression of intent to condition participation upon consent [is] as clear and unequivocal as that required to abrogate directly the immunity of non-consenting states."

3. Recent Effects of *Atascadero* and *Welch* Upon Copyright Law

The Ninth Circuit overruled its 1979 *Mills* decision in *BV Engineering v. University of California*. Consequently, no federal courts currently hold in favor of the 1976 Act's abrogation of the

held that 'Congress may, in determining what is 'appropriate legislation' for the purpose of enforcing the provisions of the Fourteenth Amendment, provide for private suits against States or state officials which are constitutionally impermissible in other contexts.' *Id.* (quoting *Fitzpatrick*, 427 U.S. at 456).


122. *Id.* at 1159.


124. *Id.* at 118 (emphasis in original) (citing *Welch*, 107 S. Ct. 2941, 2949 (1987); *Atascadero*, 433 U.S 234, 246 (1985)).


126. *Id.* at 120.

127. *Id.* at 120-22.

128. *Id.* at 121 (citing *Atascadero*, 473 U.S. at 247).

129. See *BV Eng'g v. University of California*, 858 F.2d 1394, 1398 n.1 (9th Cir. 1988), cert. denied, 57 U.S.L.W. 3621 (1989).

130. 858 F.2d 1394 (9th Cir. 1988), cert. denied, 57 U.S.L.W. 3621 (1989). The University of California bought one copy of seven different copyrighted software programs with their accompanying manuals from BV Engineering and made three copies of each program and ten copies of the manual. *Id.* at 1395.
eleventh amendment. The Ninth Circuit outlined two ways in which sovereign immunity may be abrogated, thus allowing a damages action.

First, a state may waive its immunity and consent to suit in federal court. Waiver, however, exists only "where (1) the state expressly consents; (2) a state statute or constitution so provides; or (3) Congress clearly intended to condition the state's participation in a program or activity on the state's waiver of immunity." Applying this waiver analysis, the Ninth Circuit concluded that California's use of copyrighted materials and its obligation to pay royalties for such use do not constitute express consent to federal suit. The court also found an absence of statutory or constitutional waiver: "[F]or a state statute or constitutional provision to constitute a waiver of eleventh amendment immunity, it must specify the State's intention to subject itself to suit in federal court." The court plainly stated there was no indication in the 1976 Act that Congress intended to condition state use of copyrighted material upon waiver of eleventh amendment immunity.

Second, the eleventh amendment does not bar an action for damages against a state's infringement when Congress creates, pursuant to certain constitutional powers, a damages action against a non-consenting state. However, such power is found in section 5 of the fourteenth amendment and not in the copyright and patent clause.

The Ninth Circuit clearly recognized that the Supreme Court reserved comment on Congress's ability to abrogate the eleventh amendment pursuant to any other constitutional grant of power, such as those enumerated in article I. The copyright and patent

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131. In 1962, the Eighth Circuit Court of Appeals was the first to address this controversy. The court, in Wihtol v. Crow, 309 F.2d 777 (8th Cir. 1962), held states to be immune from suit for copyright infringement. In 1976, the Ninth Circuit's decision in Mills Music, Inc. v. Arizona, 591 F.2d 1278 (9th Cir. 1979), held that states were not immune from such suit, thus creating a circuit court split. See supra notes 91-101 and accompanying text.

132. BV Eng'g, 858 F.2d at 1395-96.

133. Id. (citing Welch v. Texas Dept. of Highways & Pub. Transp., 107 S. Ct. 2941, 2945 (1987)).

134. BV Eng'g, 858 F.2d at 1396 (quoting Collins v. Alaska, 823 F.2d 329, 331-32 (9th Cir. 1987) (emphasis added)).

135. BV Eng'g, 858 F.2d at 1396.


137. BV Eng'g, 858 F.2d at 1396.


139. BV Eng'g, 858 F.2d at 1396 (citing Welch, 107 S. Ct. 2941, 2946 (1987) ("as-sum[ing] without deciding or intimating a view of the question, that the authority of Congress to subject unconsenting States to suit in federal court is not confined to section 5 of the Fourteenth Amendment"); County of Oneida, New York v. Oneida Indian
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clause is one such enumerated power. The court, however, did not discount the possibility that Congress has the authority to subject non-consenting states to suit in federal court for infringement. Instead, it drew specific attention to circuit courts which have found such power under article I.

The court pointed to the Supreme Court's recent grant of certiorari in United States v. Union Gas Co. to decide this issue regarding the commerce clause. Although the Ninth Circuit reserved deciding the article I issue in BV Engineering, it hypothetically "assume[d], without deciding, that Congress may abrogate the states' eleventh amendment immunity when acting under an Article I power."

Relying on Atascadero's stringent test, the court inferred that the 1976 Act's definition of an infringer as "anyone" implied "a general authorization." Despite specific references in the 1976 Act to state exemptions from liability, states remain immune from suit in federal court for infringement. Congress failed to abrogate the eleventh amendment in the 1976 Act. The court recognized, in a footnote, that Atascadero mandated the overruling of Mills, and thus concluded the 1976 Act does not abrogate the eleventh amendment.

IV. ANALYSIS

The question remains, however, whether states should escape liability for copyright infringement. Although the Ninth Circuit, in BV Engineering, decided in favor of immunity, it found plaintiff's argu-

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140. U.S. Const. art. I, § 8, cl. 3.
141. BV Eng'g, 858 F.2d at 1397 (citing United States v. Union Gas Co., 832 F.2d 1343, 1356-57 (3d Cir. 1987), cert. granted sub nom., Pennsylvania v. Union Gas Co., 108 S. Ct. 1219 (1988) (pursuant to commerce clause, U.S. Const. art. I, § 8, cl. 3); In re McVey Trucking, Inc., 812 F.2d 311, 314-23 (7th Cir.), cert. denied, 108 S. Ct. 227 (1987) (pursuant to bankruptcy clause, U.S. Const. art. I, § 8, cl. 4); Peel v. Florida Dept. of Transp., 600 F.2d 1070, 1080-81 (5th Cir. 1979) (pursuant to war power clause, U.S. Const. art. I, § 8, cl. 11)).
143. BV Eng'g, 858 F.2d at 1397.
145. BV Eng'g, 858 F.2d at 1397-98.
146. Id. at 1398-99; see infra notes 173-74 and accompanying text.
147. BV Eng'g, 858 F.2d at 1400.
148. BV Eng'g, 858 F.2d at 1398 n.1; see Mills Music, Inc. v. Arizona, 591 F.2d 1278 (9th Cir. 1979); supra notes 93-102 and accompanying text.
ments for abrogation "compelling."" Furthermore, the court recognized its holding allows state violation of copyright law with "impunity." Despite insistence that Atascadero prohibits subordination of the eleventh amendment by the 1976 Act, the reasoning in BV Engineering is distorted. Four pertinent issues indicate that the federally-created cause of action in the 1976 Act enables a copyright proprietor to sue an infringing state.

A. Congressional Power to Abrogate Common Law Sovereign Immunity

The copyright and patent clause gives Congress constitutional power to uniformly regulate copyright and patent use nationally. Through ratification of the Constitution, the states surrendered their sovereignty as to the regulation of copyrights and patents. The Supreme Court confirmed this idea in Goldstein v. California: "When Congress grants an exclusive right or monopoly, its effects are pervasive; no citizens or States may escape its reach." Thus, the federally-created action within the 1976 Act falls under Congress's power to regulate copyright use and protection; such authorization of power abrogates common law sovereign immunity.

The eleventh amendment, however, limits such congressional power. An examination of congressional intent behind the 1976 Act will reveal whether it implies state consent to be sued.

B. Congressional Intent Behind the Copyright Act

Prior to Atascadero, courts had inconsistently construed the use of language such as "any person," "every," "politic and governmental

149. BV Eng'g, 858 F.2d at 1400 (emphasis added); see supra notes 139-43 and accompanying text.
150. BV Eng'g, 858 F.2d at 1400. "We recognize that our holding will allow states to violate the federal copyright laws with virtual impunity." Id. It has been recognized that by denying certiorari, the Supreme Court has "expos[ed] a loophole in federal copyright law . . . [which could not only] mean a loss of millions of dollars in fees for companies whose copyrighted products are used illegally by governmental agencies . . . [but could also be] financially devastating to authors of copyrighted works . . . threaten[ing] the future of emerging intellectual property industries." Savage, High Court Allows Immunity for State in Copyright Suits, L.A. Times, Mar. 21, 1989, at I3, col. 1.
151. Id.
152. Parden v. Terminal Ry. Co., 377 U.S. 184, 191-92 (1964) ("By empowering Congress to regulate commerce . . . the States necessarily surrendered any portion of their sovereignty that would stand in the way of such regulation.").
154. Id. at 560 (concerning federal preemption of state copyright protection).
155. Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1, 196 (1824) (The power vested in Congress through article I of the Constitution recognizes no limitation "other than [those] prescribed in the Constitution.").
bodies," and "anyone" to include states. Parden held that the language "every common carrier" in FELA was a broad description of its defendant class; absent language to the contrary, congressional intent to include states should be presumed. Employees effectively reversed the Parden presumption, concluding that Congress would have specifically included states if it so intended; therefore, such intent must be evident in the statutory language. Mills and Johnson rejected the Court's reasoning in Employees, and embraced Parden. In Mills, the Ninth Circuit noted cases which considered "any person," as used in the 1909 Act, to include states. Atascadero presumably clarified the confusion by affirming the rationale of Employees. The Supreme Court announced the requirement of an express statutory inclusion of states as possible defendants. With this, the eleventh amendment dominated the statute and protected states from suit.

An overview of court rulings indicates the eleventh amendment bars suit in federal court—if the applicable legislation was enacted under a broad constitutional grant of power. The copyright and patent clause, however, is not broad; rather, its purpose is explicit and narrow. The clause recognizes the importance of encouragement and protection of copyright and patent by specifically authorizing Congress to enact legislation to accomplish its goal.

To suggest that states are not included in this national scheme of copyright and patent protection denies the explicit constitutional power of the clause to establish such protection. Furthermore, it de-

157. Id. at 187; see supra notes 26-35 and accompanying text.
158. Parden, 377 U.S. at 189-90.
161. Mills, 591 F.2d at 1284 n.7 (citing Hutto v. Finney, 437 U.S. 678 (1978) ("any person" was intended by Congress to include states); Forman v. Community Serv., Inc., 500 F.2d 1246 (2d Cir. 1974), rev'd on other grounds, United Hous. Found., Inc. v. Forman, 421 U.S. 837 (1975) ("any person" used in the Securities Exchange Act of 1934 to include states)).
162. Atascadero, 473 U.S. 234, 241-42 (1985); see supra notes 59-64 and accompanying text.
163. See supra notes 78-90 and accompanying text.
164. U.S. CONST. art. I, § 8, cl. 18. This clause, commonly referred to as the "necessary and proper clause" provides: "Congress shall have Power... To make all Laws which shall be necessary and proper for carrying into Execution the foregoing Powers." Id.
stroys the value of a national copyright system.\textsuperscript{165} The clause is explicit in its purpose and grant of power; the 1976 Act embodies Congress's effort to effect that article I power.

Pursuant to section 301 of the 1976 Act, state courts are preempted from enforcing copyright; actions may only be brought in federal court. Consequently, Congress implemented section 1338(a) of Title 28 of the United States Code: "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to . . . copyrights. . . . Such jurisdiction shall be exclusive of the courts of the states in . . . copyright cases."\textsuperscript{166}

Courts have consistently ruled in favor of sovereign immunity in situations where there exists a state forum to bring the cause of action.\textsuperscript{167} \textit{Atascadero} is no exception.\textsuperscript{168} The Supreme Court, however, has not allowed an eleventh amendment jurisdictional bar when federal court is the only forum in which to sue—as is the case with copyright infringement. Consequently, \textit{Atascadero} is distinguishable from \textit{BV Engineering} and should not be relied upon. The Rehabilitation Act, as discussed in \textit{Atascadero}, allows an action to be brought in state court.\textsuperscript{169} Suits for copyright infringement, however, do not have the luxury of concurrent jurisdiction. It seems improbable that Congress would grant a copyright proprietor a federal cause of action and then prevent its exercise by denying him suit against an infringing state; such a result leaves the copyright proprietor with no remedy whatsoever.

\textit{Atascadero} mandates the unequivocal inclusion of states as defendants in copyright infringement suits only if specifically provided within the statutory language. Without such inclusion, a suit may not be brought against an infringing state.\textsuperscript{170} Arguably, the 1976 Act meets the \textit{Atascadero} standard. There is no explicit definition of the term "anyone" in the 1976 Act's legislative history.\textsuperscript{171} However, revision of the 1909 Act's "any person" language to "anyone" in the 1976 Act reveals a direct congressional intent that the reaches of copyright protection be all encompassing, therefore including states.\textsuperscript{172} This revision should not be viewed as limiting the class of defendants.

Additionally, \textit{Atascadero} does not require that the analysis of the

\textsuperscript{165} \textit{BV Eng'}g., 858 F.2d at 1400.
\textsuperscript{166} 28 U.S.C. § 1338(a) (1982).
\textsuperscript{167} \textit{See supra} note 77 and accompanying text.
\textsuperscript{169} \textit{See supra} notes 60-61 and accompanying text.
\textsuperscript{170} \textit{See supra} notes 59-69 and accompanying text.
\textsuperscript{171} \textit{See supra} note 89 and accompanying text.
\textsuperscript{172} \textit{See supra} notes 103-09 and accompanying text; \textit{see also} Comment, Copyright Infringement and the Eleventh Amendment: A Doctrine of Unfair Use?, 40 VAND. L. REV. 225, 247-49 (1987).
statutory language be limited to a single section. An analysis of the entire statute is permissible in attempting to define the parameters of the defendant class.173 Governmental bodies, including states, are exempt from liability for infringement under various sections in the 1976 Act. This may imply that, unless explicitly exempted, a state is included in the class of possible copyright infringers. States are excluded from suit only when a provision of explicit exemption for certain activities exists.174 If Congress had written the 1976 Act to define infringer as "anyone, including states," the additional language would be redundant. Arguably then, states should be immune only when the Act specifies they may benefit from sovereign immunity protection.

Ironically, even the United States itself can be sued for copyright infringement, unless exempted under the 1976 Act itself.175 Thus, the Ninth Circuit in Mills correctly pointed out that "to hold Congress did not intend to include states within the class of defendants would lead to an anomalous construction of the statute at best."176

Therefore, pursuant to the specific grant of power in the copyright and patent clause, the 1976 Act creates a cause of action for copyright infringement which may be brought in a federal forum only. Additionally, the language of the statute provides specific sections which explicitly exclude states from liability. Finally, the United States itself may be sued for infringement. Taken together, these facets of the 1976 Act evidence a congressional intent to include states within the defendant class of infringers.

173. Atascadero requires that Congress make its intention to abrogate the eleventh amendment "unmistakably clear" in the statutory language. 473 U.S. at 241-42. The Court's analysis of congressional intent extends to the entire statute and not merely one section. Id.

174. See 18 U.S.C. §§ 110(2) (exemptions for certain governmental performances of non-dramatic literary or musical copyrighted work, or for display of copyrighted work), 110(6) (exemptions for performance of non-dramatic musical work by a governmental body), 112(b) (exemption for ephemeral recording of governmental performance or display of work under section 110(2)), 601(b)(3) (exemption for governmental use of non-dramatic literary material), 602(a)(1) (exemption for governmental use of copies or phonorecords) (1982).

175. See 28 U.S.C. § 1498(b) (1982) This section states, in pertinent part:

Whenever the copyright in any work protected under the copyright laws of the United States shall be infringed by the United States . . . the exclusive remedy of the owner of such copyright shall be by action against the United States in the Claims Court for the recovery of his reasonable and entire compensation as damages for such infringement.

Id.

176. Mills Music, Inc. v. Arizona, 591 F.2d 1278, 1285 (9th Cir. 1979) (emphasis added).
C. State Use of Copyrights as an Implied Waiver of Sovereign Immunity

Under Richard Anderson Photography v. Radford University, a state use of copyrighted material does not constitute an "unequivocal indication" that a state has consented to suit. Use of copyrighted material is essential to the basic functioning of a state. A state, therefore, has no choice whether to use such material. Absent this choice, states make no decision to consent to suit; consequently, no implied waiver exists.

In Atascadero, the Court stated: "A State may effectuate a waiver of its constitutional immunity by a state statute or constitutional provision, or by otherwise waiving its immunity to suit in the context of a particular federal program." Although Mills and Johnson held that a state impliedly waives its immunity from infringement actions in exchange for the benefit of using copyrighted material, use is not considered participation in a federal program. No choice of participation is involved. Therefore, a state does not impliedly waive immunity, nor does it consent to suit by merely using copyrighted material.

D. Unilateral Congressional Abrogation of Eleventh Amendment Sovereign Immunity

Fitzpatrick v. Bitzer found the eleventh amendment subordinate to any statute passed pursuant to section 5 of the fourteenth amendment. Consequently, the eleventh amendment does not operate in an absolute manner; it does not preclude Congress from acting under its plenary powers in subjecting non-consenting states to federal court jurisdiction pursuant to a federally-created cause of action. Section 5's exception to sovereign immunity creates an open door, suggesting that since the eleventh amendment is not absolute, other sections of the Constitution may provide congressional power sufficient to allow unilateral abrogation of sovereign immunity.

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178. Id. at 1159 (citing Atascadero State Hosp. v. Scanlon, 473 U.S. 234, 238 n.1 (1985)).
182. 427 U.S. 445 (1976); see supra notes 50-56 and accompanying text.
183. 427 U.S. at 456.
184. See infra note 186 and accompanying text.
Supreme Court has never addressed this issue. The Court has either chosen to "assume without deciding" that congressional power to abrogate is not confined to section 5, or has reserved judgment entirely.\textsuperscript{185}

Several circuit courts, however, have addressed this issue, finding that Congress "does have the power to abrogate eleventh amendment immunity when it acts pursuant to Article I."\textsuperscript{186} Article I provides a list of enumerated powers which the framers of the Constitution envisioned as requiring federal attention, protection, and enforcement. Section 8, clause 18 of article I allows Congress to enact "the necessary and proper" legislation to ensure enforcement of these powers.\textsuperscript{187} Consequently, the eleventh amendment's intervention with laws enacted pursuant to article I prevents Congress from fully utilizing its power. Many agree that:

Article I envisions that the national government will have exclusive power to regulate certain subjects when, in the clearly expressed opinion of Congress, such regulation would serve the nation's interests. To the extent that sovereign immunity would free a state from such national controls, that immunity is inconsistent with the constitutional plan.\textsuperscript{188}

The enactment of the eleventh amendment reveals constitutional intent to permit Congress only limited authority to abrogate sovereign immunity and to eliminate judicial power to abrogate such immunity entirely.

It seems reasonable that national plenary powers, such as those under article I, would override a state's claim of sovereign immunity. Consequently, extending the eleventh amendment to prohibit congressional abrogation of sovereign immunity, save legislation passed under section 5 of the fourteenth amendment, would result in limiting congressional power beyond reason. States are provided, therefore, with an avenue to violate laws enacted pursuant to article I powers and to improperly remain shielded from liability.

\textsuperscript{185} See supra notes 139-43 and accompanying text.

\textsuperscript{186} BV Eng'g v. University of California, 858 F.2d 1394, 1397 (9th Cir. 1988), cert. denied, 57 U.S.L.W. 3621 (1989); see, e.g., United States v. Union Gas Co., 832 F.2d 1343 (3d Cir. 1987), cert. granted sub nom., Pennsylvania v. Union Gas Co., 108 S. Ct. 1219 (1988) (whether Congress has power to unilaterally abrogate eleventh amendment under commerce clause of article I); see also 42 U.S.C. § 9607 (1982 & Supp. IV 1986); supra note 142 and accompanying text.

\textsuperscript{187} U.S. CONST. art. I, § 8, cl. 18.

V. SOLUTIONS TO STATE SOVEREIGN IMMUNITY FROM SUIT IN FEDERAL COURT FOR COPYRIGHT INFRINGEMENT

With the courts' unwillingness to find that the 1976 Act in fact meets Atascadero's stringent test,\textsuperscript{189} other solutions must be sought to override the judicial rulings which foreclose the recovery of damages for copyright infringement, as prescribed by statute, against non-consenting state. Otherwise, the destruction of a national system of copyright protection, a constitutionally-guaranteed monopoly established by Congress, will result. As the Supreme Court emphasizes in Parden, such a result is "pointless and frustrating."\textsuperscript{190}

Legislative and judicial solutions are available, which would provide copyright proprietors the expected protection against state infringers.\textsuperscript{191} The rewriting of the 1976 Act is one such solution. A revision could make congressional intent to abrogate eleventh amendment immunity unequivocally clear.\textsuperscript{192} There would no longer be any doubt that a state's infringement of copyright would render it susceptible to possible legal and/or equitable action. The drawback to this solution is the implication that Congress has the power to abrogate a non-consenting state's eleventh amendment immunity. However, it is this very result which the Supreme Court has proclaimed in Atascadero.\textsuperscript{193} If a statute meets the Atascadero standard, sovereign immunity falls subordinate to the statute. Congress has been given the authority to subject an non-consenting state to suit, thus abrogating the eleventh amendment. If the 1976 Act were revised, states could no longer escape liability for copyright infringement.

A second legislative solution is to amend section 1338(a) of Title 28 of the United States Code.\textsuperscript{194} Common law sovereign immunity has been nullified by the 1909 Act and the 1976 Act. However, the eleventh amendment precludes complete vindication of rights by a copyright owner since infringement suits may be brought only in federal courts.\textsuperscript{195} An amendment to section 1338(a) could create concurrent jurisdiction for copyright actions. A copyright proprietor could then sue in state court and avoid the reaches of the eleventh amendment.

Finally, considerable weight must be given to the proposal that

\textsuperscript{189} See supra notes 113-48 and accompanying text.
\textsuperscript{192} Id. at 267-68.
\textsuperscript{193} Atascadero indicates that, when a statute clearly and unequivocally includes states in a defendant class, the statute then abrogates a non-consenting state's sovereign immunity. 473 U.S. at 241-42.
\textsuperscript{194} 28 U.S.C. § 1338(a) (1982); see Comment, supra note 191, at 269.
Congress can unilaterally abrogate the eleventh amendment pursuant to its article I powers.\textsuperscript{196} It is useless to have given Congress power to enact legislation to protect certain federally-recognized rights, and then, as with the 1976 Act, provide only one forum in which to vindicate violations of those rights. States are thus free to act illegally, simply because they are states. The extent of Congress's power to impose its will on states can be no greater under one plenary power, such as section 5 of the fourteenth amendment, than under another, such as article I powers.\textsuperscript{197} Ultimately, any act that is plenary is a limitation upon state authority.\textsuperscript{198}

VI. CONCLUSION

Federal district and circuit courts have agreed that the eleventh amendment dominates the 1976 Act. Should this status quo be maintained, states will continue to infringe copyrights—and states will infringe more frequently. Copyright proprietors will remain completely unprotected from states' misappropriation of their works. Furthermore, copyright proprietors will go uncompensated for their works, in violation of the fifth amendment;\textsuperscript{199} this lack of just compensation may slow actual production of works. This will certainly impact the availability of copyrighted works to the states and the general public.

Congress intended authors to have an exclusive monopoly so as to provide authors an incentive to create works.\textsuperscript{200} The expansion of the eleventh amendment, as recently seen in the Ninth Circuit's reliance on Atascadero and Welch, has granted states complete sovereign immunity and creates significant detrimental inroads into an author's monopoly power. Such unlimited immunity offends creativity. States must not be allowed the freedom to escape liability for copyright infringement.

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\textsuperscript{196} See supra notes 182-88 and accompanying text.
\textsuperscript{197} In re McVey Trucking, 812 F.2d 311, 321 (7th Cir.), cert. denied, 108 S. Ct. 227 (1987).
\textsuperscript{198} Id. (quoting Fitzpatrick v. Bitzer, 427 U.S. 445, 456 (1976)).
\textsuperscript{199} U.S. CONST. amend. V.