

5-1991

# Copyrights and State Liability

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## Recommended Citation

76 Iowa L. Rev. 701 (1990-1991)

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# Copyrights and State Liability<sup>†</sup>

*Beryl R. Jones\**

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## I. INTRODUCTION

States have always used copyrightable material: school children have been taught with textbooks, national guard bands have played musical compositions, and attorneys general have read law treatises. As the role of state governments has increased, so has state use of copyrighted materials.<sup>1</sup> As one might expect, the growing use of copyrighted works by states has resulted in a corresponding increase in unauthorized state use of copyrighted material. Until 1985, most states and authors<sup>2</sup> assumed that this unauthorized use ran afoul of federal copyright law, as did most of the

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I would like to thank those who assisted in preparing this article, including my research assistants, the secretaries at Brooklyn Law School, and my colleagues. I would also like to thank Brooklyn Law School for the research fellowship which supported this article.

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1. M. Danielson, A. Hershey & J. Bayne, *One Nation, So Many Governments* 1-17 (1977) (discussing the expansion of state governments); D. Lufkin, *Many Sovereign States* 17-34 (1975) (same).

2. This article uses the term "author" as it is used in federal copyright law—to refer to the originator of a copyrightable work whether the work is a painting, computer program, musical composition, or book. It will also refer, unless otherwise indicated, to the copyright owner, who in some circumstances may be different from the author. *See* 17 U.S.C. § 201 (1988) (permitting the transfer of copyrights). By combining authors and copyright owners in the single reference, I do not mean to suggest that the interests of copyright owners and authors are at all times identical. Indeed, in some circumstances they may be quite different.

federal courts that had considered the issue.<sup>3</sup> The issue of state liability for copyright violations, however, took on a substantially different light in 1985 after the Supreme Court issued one of its decisions interpreting the eleventh amendment of the United States Constitution.<sup>4</sup> That decision, *Atascadero State Hospital v. Scanlon*, held that Congress had to indicate with "unmistakably clear language" its intent to hold a state liable under federal law before a private citizen could bring a suit for a violation of that law.<sup>5</sup> Following the lead of *Atascadero*, a number of courts held that authors could not sue states for copyright violations either because the eleventh amendment to the United States Constitution prevented Congress from creating such a remedy<sup>6</sup> or because the Copyright Revision Act of 1976<sup>7</sup> did not provide a remedy against state governments.<sup>8</sup>

Although these decisions did not wholly exempt states from compliance with federal copyright law,<sup>9</sup> they generated considerable concern in the copyright community. Many viewed the decisions as inconsistent with Congressional intent and felt the result conflicted with the basic premises of copyright law. In response, Congress passed the Copyright Remedy Clarification amendment (Clarification amendment) in 1990.<sup>10</sup> The 1990 Act amended the 1976 Act to provide that states can be held liable for copyright violations, as could any nongovernmental entity.<sup>11</sup>

This Article will discuss the issue of state liability for copyright violations and the Clarification amendment, arguing that the amendment is not prohibited by the eleventh amendment of the Constitution and that federal copyright law can and should protect authors from the unauthorized use of their works by states. First, this Article will review the background of federal copyright law, the nature of state use of copyrighted works, and the eleventh amendment to the United States Constitution.<sup>12</sup> Specific attention will be given to the question of whether the eleventh amendment, which prevents federal courts from considering certain combination citizen and state suits, also prevents Congress from enacting a

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3. See, e.g., *Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979); *Johnson v. University of Virginia*, 606 F. Supp. 321 (W.D. Va. 1985). But see *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962).

4. U.S. Const. amend. XI. See *infra* text accompanying note 79 for the text of the amendment.

5. 473 U.S. 234, 242 (1985).

6. U.S. Const. amend. XI. See *Mihalek v. Michigan*, 595 F. Supp. 903, 905-06 (E.D. Mich. 1984), *aff'd on other grounds*, 814 F.2d 290 (6th Cir. 1987).

7. The Copyright Revision Act of 1976, as amended, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-914 (1987)) [hereinafter the 1976 Act].

8. E.g., *BV Eng'g v. University of Calif., Los Angeles*, 858 F.2d 1394, 1395, 1400 (9th Cir. 1988) (Congress did not create a copyright cause of action against states), cert. denied, 489 U.S. 1090 (1989); *Richard Anderson Photography v. Radford Univ.*, 852 F.2d 114, 117 (4th Cir. 1988) (same), cert. denied, 489 U.S. 1033, (1989); *Lane v. First Nat'l Bank of Boston*, 871 F.2d 166, 169 (1st Cir. 1989) (same). See *infra* notes 32-35 and accompanying text.

9. See *infra* notes 38-41 and accompanying text.

10. Pub. L. No. 101-553, 104 Stat. 2749 (1990) (codified at 17 U.S.C. §§ 501, 511).

11. See S. Rep. No. 305, 101st Cong., 2d Sess. 4 (1990); H. Rep. No. 282, 101st Cong., 2d Sess. 2 (1989).

12. See *infra* notes 19-178 and accompanying text.

combination citizen and state copyright remedy for monetary damages which may be enforced in federal courts. The Supreme Court's 1989 decision in *Pennsylvania v. Union Gas*<sup>13</sup> significantly alters the controversy which has developed over the years with respect to the scope of congressional power to enact such legislation. Prior to that decision, commentators generally had viewed the issue to be simply whether Congress could provide combination citizen and state remedies pursuant to any of its Article I powers.<sup>14</sup> These commentators had assumed that when the Court finally decided the issue with respect to one of the Article I powers, it would decide the issue with respect to all of them, including the copyright clause.<sup>15</sup> Accordingly, the scope of Congress' power with respect to the copyright clause was not specifically addressed. In *Union Gas*, however, the Supreme Court limited the scope of its decision to only one of Congress' Article I powers, holding that the commerce clause provides Congress with authority to create combination citizen and state remedies.<sup>16</sup> The question of Congress' power to create such remedies pursuant to any of its other Article I powers, including the copyright clause, was not clearly addressed by the Court. The first section of this Article demonstrates, through an application of the Court's reasoning in *Union Gas*, that there is no constitutional bar to the Clarification amendment which creates a remedy permitting authors to sue states for unauthorized use of their works.<sup>17</sup>

Second, this Article will examine some of the doctrinal problems that are raised by unauthorized state use of copyrighted material.<sup>18</sup> This Article concludes that the Clarification amendment is a necessary addition to the 1976 Act.

## II. BACKGROUND

### A. *Copyright Background*

The United States Constitution's copyright clause empowers Congress "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>19</sup> By its terms, the copyright clause

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13. 491 U.S. 1 (1989) (plurality opinion).

14. U.S. Const. art. I, § 8 (containing several clauses pursuant to which Congress can "make laws") [hereinafter Article I powers].

15. U.S. Const. art. I, § 8, cl. 8 (empowering Congress to enact copyright legislation) [hereinafter the copyright clause]. The copyright clause reads: "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." *Id.*

16. 491 U.S. at 22.

17. See *infra* notes 125-78 and accompanying text.

18. See *infra* notes 181-205 and accompanying text.

19. U.S. Const. art. I, § 8, cl. 8. The same constitutional clause provides authority to enact patent legislation. The issue of state liability for copyright violations is closely related to the issue of their liability for patent violations. For a discussion of that issue, see *Chew v. State of Calif.*, 893 F.2d 331 (Fed. Cir.), cert. denied, 111 S. Ct. 44 (1990); *Lemelson v. Ampex Corp.*, 372 F. Supp. 708, 710-13 (N.D. Ill. 1974) (eleventh amendment does not prevent suits against states for patent violations); *Chisum, The Allocation of Jurisdiction Between State and Federal*

grants Congress the power to protect the "Writings" of "Authors" in order to promote the arts and sciences. Courts have construed these words to enable Congress to provide protection for a broad range of works. The term "author" has been construed to refer not only to the creator of a literary work but also to the "[person] to whom anything owes its origin; originator; maker . . ."<sup>20</sup> In a similarly broad manner, the term "writings" has been "interpreted to include any physical rendering of the fruits of creative[,] intellectual[,] or aesthetic labor,"<sup>21</sup> including paintings, musical compositions, charts, and books.<sup>22</sup>

In 1790, the first Congress of the United States adopted the first statute passed pursuant to the copyright clause.<sup>23</sup> Since that time, there have always been federal copyright statutes.<sup>24</sup> The statute currently in force is the 1976 Act.<sup>25</sup> The 1976 Act vests copyrights, for a limited time,<sup>26</sup> in authors<sup>27</sup> of a series of enumerated works.<sup>28</sup> With copyrights, authors obtain a series of exclusive rights, such as the rights of reproduction and performance.<sup>29</sup> Anyone who exercises these rights without authorization by the author violates federal copyright law.<sup>30</sup> The 1976 Act imposes liability for the unauthorized use of a copyright work under section 501 which provides: "Anyone who violates any of the exclusive rights . . . is an infringer. . . . The . . . owner of an exclusive right . . . is entitled . . . to institute an action for any infringement of that particular right . . ."<sup>31</sup>

Prior to 1985 and the *Atascadero* decision, most, although not all, of

Courts in Patent Litigation, 46 Wash. L. Rev. 633 (1971) (arguing against state court jurisdiction over patent infringement cases); Note, Constitutional Law: Sovereign Immunity—Right of Patentee to Bring Suit in Federal Court Against a State Agency for Patent Infringement, 19 Wayne L. Rev. 1595 (1973) (arguing that state may not be held liable for patent violations).

20. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884). This Article uses the term "authors" in a similar manner.

21. *Goldstein v. California*, 412 U.S. 546, 561 (1973). This Article uses the term "writings" in a similar manner.

22. 17 U.S.C. § 102(5) (1988) (pictures are copyrightable); 17 U.S.C. § 102(2) (1988) (musical compositions are copyrightable); 17 U.S.C. §§ 101, 102(5) (1988) (charts are copyrightable); 17 U.S.C. § 102(1) (1988) (books are copyrightable).

23. Copyright Act of May 31, 1790, ch.15, 1 Stat. 124.

24. Congress amended the 1790 statute 25 times between 1789 and 1904. *Mazer v. Stein*, 347 U.S. 201, 209 n.12 (1954). Congress revised the statute extensively in 1909. *See* Act of Mar. 4, 1909, ch. §20, 35 stat. 1075 [hereinafter the 1909 Act]. Congress adopted a major revision of the 1909 Act in 1976. The coverage provided by the 1976 Act has also been extended by amendments. *See, e.g.*, Pub. L. No. 96-517, § 10(b), 94 Stat. 3015, 3028 (1980) (codified at 17 U.S.C. § 117 (1988)) (extending coverage to computer programs); Pub. L. No. 98-620, 98 Stat. 3347-3355 (codified at 17 U.S.C. §§ 901-14 (1984)) (providing for coverage of semiconductor chip products).

25. Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-914 (1987)).

26. 17 U.S.C. §§ 301-305 (1976) (setting forth the duration of copyrights).

27. *Id.* § 201 (1976) (vesting copyrights in authors).

28. *Id.* § 102 (1976) (enumerating protected works).

29. *Id.* § 106 (1976) (enumerating exclusive rights in copyrights).

30. *Id.* § 501 (1976) (providing a remedy for infringements).

31. *Id.*

those courts that had considered the question of liability of states had held that states were covered by the federal copyright law.<sup>32</sup> After *Atascadero*, the courts uniformly held that no remedy was available. Some of these post-*Atascadero* decisions held that states were not among the class of potential defendants defined by the 1976 Act.<sup>33</sup> Others concluded that regardless of whether the statute was intended to include such a remedy, the eleventh amendment prevented Congress from providing it.<sup>34</sup> The clear consensus was, however, that states could not be sued for monetary damages under the 1976 Act. These post-*Atascadero* decisions were wrong; the 1976 Act did provide a remedy. All the evidence shows that Congress intended to impose liability on the states under the 1976 Act.<sup>35</sup> Not only does the 1976 Act contain exemptions for state liability that would have been meaningless if there had been no interest on Congress' part to impose initial liability on states,<sup>36</sup> but also the legislative history of the 1976 Act is replete with references which assume states can be held liable under the

32. The two best known pre-*Atascadero* cases, *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962), and *Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979), reached opposite results under the 1909 Act. In *Wihtol*, the Eighth Circuit dismissed the suit against a public high school, with only a very short discussion of the problem. The plaintiff, Austris A. Wihtol, was the author of a hymn. One of the defendants, Nelson E. Crow, was the head of the Vocal Department of the Junior College and High School of the Clarinda, Iowa School District. Crow had made an arrangement of the hymn and distributed copies of it to members of the high school choir and to members of a church choir he directed. Wihtol brought suit in federal court against Crow, the school district, and the church, charging them with using his hymn in violation of federal copyright law. The court held that a "suit against the State of Iowa for the infringement of a copyright, clearly could not be maintained, because of the Eleventh Amendment to the Constitution of the United States . . ." *Wihtol*, 309 F.2d at 781.

In *Mills Music, Inc. v. Arizona*, the Ninth Circuit permitted the plaintiff to proceed with his claim. The plaintiffs in *Mills* charged the state of Arizona and the Arizona Coliseum and Exposition Center Board with using without permission the composition "Happiness Is" as the theme for promotion of an Arizona state fair. Relying on a trilogy of eleventh amendment cases, *Parden v. Terminal Ry. of Ala. State Docks Dept.*, 377 U.S. 184, 192 (1964), *Employees v. Department of Pub. Health & Welfare of Mo.*, 411 U.S. 279, 284-85 (1973), and *Edelman v. Jordan*, 415 U.S. 651, 672-73 (1974), the Ninth Circuit held that a state's eleventh amendment immunity was waived when Congress chose to regulate in an area and a state entered that regulated area. 591 F.2d at 1283. The *Mills* court reasoned that Congress intended for states to be included among the class of defendants who could be sued under the 1909 Act, that Arizona's immunity lawfully had been abrogated by the passage of the federal copyright statute and that Arizona, having voluntarily entered into a federally regulated area, could be held liable under federal law. *Id.* at 1284-85.

33. See *BV Eng'g v. University of Calif., Los Angeles*, 858 F.2d 1394, 1395 (9th Cir. 1988), cert. denied, 489 U.S. 1090 (1989); *Richard Anderson Photography v. Radford Univ.*, 852 F.2d 114, 116-22 (4th Cir. 1988), cert. denied, 489 U.S. 1033 (1989); *Lane v. First Nat'l Bank of Boston*, 687 F. Supp. 11, 14 (D. Mass. 1988); *Cardinal Indus. Inc. v. Anderson Parrish Assoc.*, No. 83-1038-Civ.-T-13, slip op. (N.D. Fla. March 12, 1985), aff'd mem., 811 F.2d 609, cert. denied sub nom., *Cardinal Indus. Inc. v. King*, 484 U.S. 824 (11th Cir. 1988).

34. *Lane*, 871 F.2d at 172; *BV Eng'g*, 858 F.2d at 1397; *Richard Anderson Photography*, 852 F.2d at 122; *Mihalek v. Michigan*, 595 F. Supp. 903, 903 (E.D. Mich. 1984).

35. See H. Rep. 282, 101st Cong., 1st Sess. 5-6; S. Rep. 305, 101st Cong., 1st Sess. 5.

36. See, e.g., 17 U.S.C. § 602(a) (1) (1976) (exempting goods imported under the authority of any state or political subdivision of a state); § 106(a) (1976) (exempting governmental bodies for liability for certain performances of musical compositions).

Act.<sup>37</sup> Furthermore, as the discussion below indicates, the eleventh amendment does not bar combination citizen and state copyright suits. Many in the copyright community had argued that the decisions denying liability had left them remediless against states who have violated the federal copyright laws. This was simply not the case. Using a variety of theories that had been employed extensively in other areas of the law and to a lesser extent in copyright cases, authors could have compelled future recognition of their copyrights, recovered monies for past violations, or both. The options available to authors were the following: First, suits for injunctive relief brought against state officers in their official capacity,<sup>38</sup> second, suits against state officers in their personal capacity,<sup>39</sup> third, suits brought

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37. See, e.g., Copyright Law Revision: Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties and Administration of Justice of the House Judiciary Comm., 94th Cong., 1st Sess. 882-83 (1975); Copyright Law Revision: Hearings on H.R. 2223 Before the Subcomm. on Courts, Civil Liberties, and Administration of Justice of the House Comm. on the Judiciary. 94th Cong., 1st Sess. 648-49 (1975).

38. One of the earlier cases in which the Court sustained the federal court's authority to issue injunctions against state officials is *Ex Parte Young*, 209 U.S. 1123 (1908). Although recently the Court seems to have abandoned the *Young* rationale, it has not abandoned the result. In *Pennhurst State Sch. and Hosp. v. Halderman*, 465 U.S. 89, 104-06 (1984), the Court invoked concerns of federalism to explain the *Young* rule, namely that the rule provides the federal government with power to ensure state compliance with federal law. This need for supremacy of federal authority was, in the Court's view, sufficient to justify construing the eleventh amendment as not preventing certain injunctive suits against state officers.

On the basis of *Young*, federal courts have issued innumerable injunctions directing state officials to comply with a variety of federal laws. E.g., *Pennoyer v. McConnaughty*, 140 U.S. 1, 24 (1891); *Florida Dep't of State v. Treasure Salvors, Inc.*, 458 U.S. 670, 696-97 (1982). The *Young* doctrine is, however, a tool of only limited use because it applies only to certain types of equitable relief and does not permit a federal court to use its full panoply of remedies. In general, only prospective injunctive relief is permissible, and equitable relief that would have the effect of imposing monetary damages is barred. *Quern v. Jordan*, 440 U.S. 332, 337 (1979); *Milliken v. Bradley*, 433 U.S. 267, 289-90 (1977).

39. Suits against state officers in their personal capacities seek recovery from the individual officers for actions taken under color of state law. In suits against state officers in their official capacities, the real party in interest is the state entity, and an award of damages would be paid from the state's treasury. *Kentucky v. Graham*, 473 U.S. 159, 166 (1985). In contrast, any damages awarded in a personal capacity suit are paid from the personal resources of the state officer and, thus, are not barred by the eleventh amendment. See *Haffer v. Melo*, 912 F.2d 628 (3d Cir. 1990), cert. granted, 59 U.S.L.W. 3581 (Feb. 25, 1991) (eleventh amendment does not bar claim for damages against state official in suit against her in her personal capacity).

The issue of personal liability of state officers for copyright claims has received only limited attention in the reported decisions. Only three decisions even mention the issue. In each case the court refused to dismiss the action on the ground that personal liability suits were not permitted and each case found it necessary to consider the merits of the author's claims. *Wihtol v. Crow*, 309 F.2d 777, 782 (8th Cir. 1962); *Lane v. First Nat'l Bank of Boston*, 637 F. Supp. 11, 16-17 (D. Mass. 1988); *Richard Anderson Photography v. Radford Univ.*, 633 F. Supp. 1154, 1161 (1986), aff'd in part, rev'd in part, 852 F.2d 114 (4th Cir. 1988), cert. denied 489 U.S. 1023 (1989).

In a very limited number of circumstances, authors may be able to bring suit under the 1976 Act because a state has waived its eleventh amendment immunity. The waiver may be made either by state legislation or in the state constitution, or by way of a state's decision to bring an affirmative action in federal court.

The circumstances in which it can be argued that a state constitution or statute waives eleventh amendment protection, however, are quite limited. See *Atascadero State Hosp. v.*

against state agencies that were not protected by the eleventh amendment,<sup>40</sup> and fourth, suits where states had waived their eleventh amendment immunity. While these alternatives provided some benefit to copyright holders, they were not adequate to resolve the problems with state copyright use. The post-*Atascadero* decisions were received with great concern by the copyright community, which vigorously lobbied for congressional action. After receiving a report from the Copyright Office urging modification of the 1976 Act, Congress amended the 1976 Act to indicate clearly that states are included in the class of potential defendants described by the term "anyone" in section 501.<sup>41</sup>

### B. *The Nature of State Use of Copyrightable Works*

Although precise figures on the extent to which states use copyrighted material are unavailable, there is little doubt that states make extensive use

Scanlon, 473 U.S. 234, 238 n.1 (1985); Florida Dep't. of Health and Rehabilitative Serv. v. Florida Nursing Home Ass'n., 450 U.S. 147, 150 (1981) (per curiam); Great N. Life Ins. Co. v. Read, 322 U.S. 47, 54 (1944). *But see* Port Auth. Trans-Hudson Corp. v. Feeney, 110 S. Ct. 1868 (1990) (state agency has waived eleventh amendment immunity). In two reported decisions, copyright holders have made this waiver argument, with limited success. Regents of Univ. of Minn. v. Applied Innovations, Inc., 685 F. Supp. 698, 700 (D. Minn. 1987); Woelffer v. Happy States of Am. Inc., 626 F. Supp. 499, 503 (N.D. Ill. 1985).

40. Local governments and independent state agencies are state governmental entities because they exist pursuant to state authorization. They do not, however, enjoy the immunity of the eleventh amendment. *See* Mt. Healthy City School Dist. Bd. of Educ. v. Doyle, 429 U.S. 274, 280 (1977).

41. 17 U.S.C. § 501 (1976), as amended in 1990, provides in pertinent part:

(a) . . . As used in this subsection, the term "anyone" includes any State, any instrumentality of a State, and any officer or employee of a state or instrumentality of a state acting in his or her official capacity. Any state, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any non-governmental entity.

17 U.S.C. § 511 (1990), which was added to the 1976 Act by the Clarification amendments, § 2(a), provides in full:

(a) In General. -Any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the Eleventh Amendment of the Constitution of the United States or under any doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or non-governmental entity, for a violation of any of the exclusive rights of a copyright owner provided by sections 106 through 119, for importing copies of phonorecords in violation of section 602, or any other violation under this title.

(b) Remedies. -In a suit described in subsection (a) for a violation described in that subsection, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for the violation to the same extent any public or private entity other than a State, instrumentality of a State, or officer or employee of a State acting in his or her official capacity. Such remedies include impounding and disposition of infringing articles under section 503, actual damages and profits and statutory damages under section 504, costs and attorney's fees under Section 505, and the remedies provided in section 510.

States similarly were made liable for infringing the exclusive rights of the owners of semi-conductor chip products. *See* Clarification amendments section 2, codified at 17 U.S.C. §§ 910, 911 (1991).



of these materials.<sup>42</sup> The range of materials used by states is as broad as the 1976 Act's coverage. For example, state universities and public school systems use textbooks,<sup>43</sup> give standardized tests,<sup>44</sup> show movies to students,<sup>45</sup> and use copyrighted music for classes, high school bands, glee clubs, college radio stations, and college dances.<sup>46</sup> State prisons maintain libraries,<sup>47</sup> show movies, and play music for prisoners.<sup>48</sup> State agencies maintain libraries, use computer programs,<sup>49</sup> and train employees with audiovisual aids.<sup>50</sup> States show movies at state hospitals,<sup>51</sup> sponsor fairs at which copyrighted music is performed,<sup>52</sup> and own public radio and television stations over which copyrighted music and literary works are performed.<sup>53</sup>

Although many of these copyrighted works are not created with the needs of state users in mind,<sup>54</sup> much of the material is created specifically for use by states. For example, many textbooks and standardized tests used by public schools and universities have been developed for use by particular states.<sup>55</sup>

While the precise extent of state use of copyrighted material is unclear, it is undoubtedly considerable. For example, annual textbook sales to state

42. See generally Comment Letters of the Copyright Office, Library of Congress, RM 87-5, 52 Fed. Reg. 42,045 (1987) (materials sent in response to a solicitation of the Copyright Office on the eleventh amendment and copyright) [hereinafter Comment Letters]; Copyright Liability of States and the Eleventh Amendment 7-12 (1988) (Library of Congress, Office of Copyrights) (same) [hereinafter Register of Copyrights Report].

43. See Comment Letters, supra note 42, Letter No. 12 at 3; Letter No. 17 at 1; Register of Copyrights Report, supra note 42, at 10.

44. See Comment Letters, supra note 42, Letter No. 17 at 4.

45. Id.; see id., Letter No. 16 at 4.

46. Id.; see id., Letter No. 21, Exhibit A at 4; Letter No. 23 at 6; Register of Copyrights Report, supra note 42, at 8.

47. See generally Murray v. Giarratano, 492 U.S. 1, 4-5 (1989) (describing a prison library).

48. See Brief for Amici Curiae, Columbia Pictures et al., at 3, BV Engineering v. Univ. of Cal., L.A., 858 F.2d 1394 (9th Cir. 1988) (No. 87-5920) [hereinafter Brief for Columbia]; Comment Letters, supra note 42, Letter No. 23 at 6; Letter No. 16 at 6; Register of Copyrights Report, supra note 42, at 7.

49. See Comment Letters, supra note 42, Letter No. 24 at 1; Letter No. 28 at 1.

50. See Comment Letters, supra note 42, Letter No. 17 at Enclosures; Register of Copyrights Report, supra note 42, at 7.

51. See Brief for Columbia, supra note 48, at 3.

52. Copyright Law Revision: Hearings Before the Subcomm. on Patents, Trademarks, and Copyrights of the Sen. Comm. on the Judiciary, 90th Cong., 1st Sess. 1219, 1338 (1967); Copyright Law Revision: Hearings Before the Subcomm. on Patents, Trademarks, and Copyrights of the Sen. Comm. on the Judiciary, 90th Cong., 1st Sess. 780 (1967).

53. See Comment Letters, supra note 42, Letter No. 21, Exhibit C at 4; Letter No. 23 at 6.

54. For example, movies, law books, word processing programs, and popular songs were created without envisioning state use.

55. See Comment Letters, supra note 42, Letter No. 17 at 4. Other works are also designed specifically for states. For example, computer programs may be developed for use by specific state agencies, see Comment Letters, supra note 42, Letter No. 6, and photographs may be taken for use by a state university. See Richard Anderson Photography, Inc. v. Brown, 852 F.2d 114 (4th Cir. 1988) (photographs used in student prospectus by state university subject of copyright suit), cert. denied, 489 U.S. 1033 (1989).

colleges and universities have been estimated at \$1.1 billion,<sup>56</sup> and textbooks sales to public schools and school districts have been estimated at another \$1.35 billion.<sup>57</sup> State-supported institutions provided for over eighty percent of the test publishing industry's revenues.<sup>58</sup> Use of copyrighted materials by state-owned public radio and television stations appears to be substantial as well.<sup>59</sup> In addition, the film industry obtains substantial revenues from the "second distributions," which are made principally to state entities, of major motion pictures.<sup>60</sup>

The extent to which states currently use copyrighted materials without authorization is extremely difficult to ascertain. There are no figures available<sup>61</sup> and there are less than two dozen reported cases on point.<sup>62</sup>

56. See Comment Letters, *supra* note 42, Letter No. 12 at 3; Register of Copyrights Report, *supra* note 42, at 12; The Copyright Remedy Clarification Act: Hearings on H.R. 1131 Before the Subcomm. on Courts, Intellectual Property and the Admin. of Justice of the House Comm. on the Judiciary, 101st Cong., 1st Sess. 4 (July 11, 1989) (statement of Ralph Oman, Register of Copyright).

57. See Comment Letters, *supra* note 42, Letter No. 17 at Enclosures. See also Comment Letters, *supra* note 42, Letter No. 11 at 2; Letter No. 17 at 1.

58. See Comment Letters, *supra* note 42, Letter No. 17 at Enclosures.

59. In 1986 the Federal Communications Commission gave licenses to state entities for 181 noncommercial educational television stations which used copyrightable materials. See 1985-86 Public Broadcasting Directory for the Corporation for Public Broadcasting, cited in Comment Letters, *supra* note 42, Letter No. 23 at 6 (noting the existence of these stations and that many, if not all, of these stations have performing rights licenses). The American Society of Composers and Performers (ASCAP) and Broadcast Music, Inc. (BMI), the major performing rights societies, give copyright licenses to numerous state entities. The purpose of ASCAP and BMI is to enforce the musical composition copyright for the copyright owner. As the court in *Columbia Broadcasting System, Inc. v. American Society of Composers* noted:

Prior to ASCAP's formation . . . there was no effective method by which . . . [musical composition copyright owners] could secure payment for the performance for profit of their copyrighted works. The users of music, such as theaters, dance halls and bars, were so numerous and widespread, and each performance so fleeting an occurrence, that no individual copyright owner could negotiate licenses with users of his music, or detect unauthorized uses. On the other side of the coin, those who wished to perform compositions without infringing the copyright were, as a practical matter, unable to obtain licenses from the owners of the works they wished to perform. ASCAP was organized as a 'clearinghouse' for copyright owners and users to solve these problems.

400 F. Supp. 737, 741 (S.D.N.Y. 1975).

Usually composers enforce their copyrights by becoming a member of an organization like ASCAP or BMI. Membership requires that the copyright owner grant the organization a non-exclusive right to license performances of the composer's musical compositions. *Ocasek v. Heggland*, 116 F.R.D. 154, 156 (D. Wyo. 1987).

ASCAP's and BMI's licensing of state entities, not including licensing of public broadcasting entities, generates approximately \$750,000 annually. See Comment Letters, *supra* note 42, Letter No. 23 at 6-7.

60. In the film industry, motion pictures are usually first released for performance at local movie theaters. A second distribution is then made to the "non-theatrical" markets. That market is dominated by state entities, such as universities, colleges, schools, hospitals, and correctional facilities. See Brief for Columbia, *supra* note 48, at 3.

61. See generally The Copyright Remedy Clarification amendment: Hearings on H.R. 1131 Before the Subcomm on Courts, Intellectual Property and the Admin. of Justice of the House Comm. on the Judiciary, 101st Cong., 1st Sess. 3 (July 11, 1987) (statement of General Counsel, National School Board Association and Chairman, Educators' Ad Hoc Committee on Copyright Law) ("[C]omments on actual losses are either speculative or isolated and anecdotal

These cases do, however, provide some useful information about the scope of the problem. First, they suggest that unauthorized state use of copyrighted works is on the increase. The first case on point was reported in

in nature."); *id.* at 3-4 (statement of University Counsel, University of California).

62. The entire list of reported decisions on point are: *BV Eng'g v. University of Calif., Los Angeles*, 858 F.2d 1394, 1395-96 (9th Cir. 1988) (in suit seeking damages for copying of computer software and user manuals, court assumes, without deciding, that Congress may abrogate the states' eleventh amendment immunity pursuant to the copyright Act); nevertheless, court holds Congress did not exercise this power in the 1976 Act), cert. denied, 489 U.S. 1090 (1989); *Richard Anderson Photography v. Radford Univ.*, 852 F.2d 114, 116-22 (4th Cir. 1988) (suit challenging use of photographs in student prospectus; state official may be sued in her individual capacity; court did not reach issue of whether Congress has power to abrogate states' eleventh amendment immunity; court holds Congress did not create a cause of action against the states; state does not waive its immunity by participating in conduct regulated by the 1976 Act), cert. denied, 489 U.S. 1033, (1989); *Mills Music, Inc. v. State of Ariz.*, 591 F.2d 1278, 1281-87 (9th Cir. 1979) (eleventh amendment does not bar action for monetary damages, attorney's fees, and costs arising out of alleged infringement of song used in state fair promotion; states were intended to be defendants under 1909 Act; Congress intended to abrogate state's immunity); *Wihtol v. Crow*, 309 F.2d 777, 781-82 (8th Cir. 1962) (eleventh amendment bars action for monetary damages arising out of school choirs' use of a hymn); *Howell v. Miller*, 91 F. 129, 136 (6th Cir. 1898) (since state employee violated federal copyright law, he could not be acting as agent of the state; injunction prohibiting printing of annotated laws of Michigan was not barred by eleventh amendment); *Lane v. First Nat'l Bank of Boston*, 687 F. Supp. 11, 13-18 (D. Mass. 1988) (does not decide that Congress has power to abrogate the states' eleventh amendment immunity; no remedy exists under 1976 Act because Congress did not unequivocally express its intention to abrogate that immunity; state official can be personally liable), *aff'd*, 871 F.2d 166, 167-75 (1st Cir. 1989) (not reaching issue of personal liability); *Regents of Univ. of Minn. v. Applied Innovations, Inc.*, 685 F. Supp. 698 (D. Minn. 1987) (denying defendants' claims on other grounds), *aff'd* on other grounds, 876 F.2d 626 (8th Cir. 1989); *Woelffer v. Happy States of Am., Inc.*, 626 F. Supp. 499, 504, 505 (N.D. Ill. 1985) (1976 Act does not contain language pursuant to which states can be held liable for monetary damages and attorney's fees; injunctive relief barring use of slogan in state tourism campaign available); *Johnson v. University of Va.*, 606 F. Supp. 321, 322-24 (D. Va. 1985) (eleventh amendment does not bar awards of money damages for alleged misuse of photographs; 1976 Act creates a remedy against states); *Cardinal Indus. Inc. v. Anderson Parrish Assoc., No. 83-1038-Civ-T-13*, slip op. (N.D. Fla. Mar. 12, 1985) (state has not waived its eleventh amendment immunity for copyright suits; state agency is not liable in indemnification action arising out of copyright claim because of the eleventh amendment), slip op. (Sept. 6, 1985), (eleventh amendment prevents state officials from suit charging infringing use of architectural plans; state's immunity has been neither waived nor abrogated by Congress under 1976 Act), slip. op. (May 7, 1986) (remaining actions against private individuals dismissed because no infringement found), *aff'd* mem., 811 F.2d 609 (11th Cir. 1987), cert. denied sub nom., *Cardinal Indus., Inc. v. King*, 484 U.S. 824 (1987); *Mihalek v. Michigan*, 595 F. Supp. 903, 905-06 (E.D. Mich. 1984) (eleventh amendment bars action for monetary damages in action arising out of use of designs in state promotional campaign; injunctive relief is not barred), *aff'd* on other grounds, 814 F.2d 290, 297 (6th Cir. 1987); *Association of Am. Medical Colleges v. Carey*, 482 F. Supp. 1358, 1361-62 (N.D.N.Y. 1980) (injunctive suit seeking to prevent disclosure of MCAT test not barred by eleventh amendment). *Cf. Sioux Falls Cable Television v. South Dakota*, 838 F.2d 249, 251-52 (8th Cir. 1988) (state did not raise eleventh amendment defense, although plaintiff sought injunctive relief which would issue against state as well as state officers).

This list does not include the numerous cases which were settled or whose decisions were not reported. *E.g.*, *Columbia Pictures Indus., Inc. v. Wisconsin Dep't of Health and Social Servs.*, No. 83-C-1496-R, slip op. (E.D. Wis. Jan. 21, 1985) (final order settling citizen-state copyright action pursuant to which state is enjoined from showing movies to prison inmates without authorization of plaintiffs).

1898.<sup>63</sup> From 1898 until 1980 only four other decisions were reported.<sup>64</sup> Twelve cases have been reported since 1980.<sup>65</sup> The nature and extent of state use of copyrighted materials was explored during the congressional hearings on the Clarification amendment. The evidence received, although limited, also supports the conclusion that unauthorized use is on the increase.<sup>66</sup> Second, these cases suggest that unauthorized state use arises principally in circumstances involving individual copyrighted works and involving limited use or reproduction of these works.<sup>67</sup> None of the reported cases involve widespread or wholesale copying of a number of works. No state school board, for example, has yet been charged with purchasing and making copies of each of the books it needs for its libraries or for teaching its students.<sup>68</sup> Nevertheless, the unauthorized use has not been insignificant. In several of the cases authors have charged states with incorporating copyrighted works into state materials. Although only single works were allegedly misused, the state materials were widely distributed. For example, in *Woelfer v. Happy State of America*,<sup>69</sup> and *Mihalek v. Michigan*,<sup>70</sup> the states were charged with unauthorized use of copyrighted material in state tourism campaigns. Some of the alleged misuse involved reproducing copies of the works in lieu of purchasing the number of copies needed by the state entities. In *BV Engineering v. University of California, Los Angeles*,<sup>71</sup> a state entity was charged with purchasing a single copy of a computer software program and making the copies it needed. Similarly, in *Mills Music v. State of Arizona*,<sup>72</sup> a school choir director was charged with making extra copies of a hymn for the school choir. The copying which occurred in each of these cases was not substantial, but the cumulative effect of such practices could have a serious effect on copyright holders. Third, the limited number of cases, even if growing, suggests there has not yet been any widespread consensus among state governments that they can ignore the rights of copyright holders. This state of affairs may not have held firm. There was testimony at the hearings on the Clarification amendment to the effect that the post-*Atascadero* decisions which limited state liability had made some state agencies unwilling to pay for copyrighted works.<sup>73</sup>

Even though there is no evidence of extensive unauthorized use, the increase in unauthorized use is of concern to copyright holders and should

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63. *Howell v. Miller*, 91 F. 129, 136 (6th Cir. 1898).

64. See supra note 62.

65. Id.

66. See H. Rep. No. 282, supra note 11, at 8.

67. See Comment Letters, supra note 42, Letter No. 12 at 2-3 (reviewing the characteristics of prevailing defendants in recent eleventh amendment and copyright litigation).

68. But see Comment Letters, supra note 42, Letter No. 11 at 2 (suggesting copying of that sort could occur); Register of Copyrights Report, supra note 42, at 12 (same).

69. 626 F. Supp. 499 (N.D. Ill. 1985).

70. 595 F. Supp. 903 (E.D. Mich. 1984), aff'd, 814 F.2d 290 (6th Cir. 1987).

71. 858 F.2d 1394 (9th Cir. 1988), cert. denied, 489 U.S. 1090 (1989).

72. 591 F.2d 1278 (9th Cir. 1979).

73. S. Rep. No. 305, supra note 11, at 10-11.

not be dismissed as insignificant.<sup>74</sup> As discussed below in section III, their perception is probably correct.<sup>75</sup>

### C. *The Eleventh Amendment*

As noted above, a number of authors have attempted to sue for monetary damages states which have made unauthorized use of their works.<sup>76</sup> In all of the cases decided after 1985, the authors were unsuccessful because the courts held either that the eleventh amendment to the U.S. Constitution prevented Congress from creating a combination citizen and state copyright remedy,<sup>77</sup> or that Congress had not indicated an intention to create such a remedy in accord with the requirements of the eleventh amendment.<sup>78</sup>

The eleventh amendment to the Constitution 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."<sup>79</sup> Although relatively obscure, the amendment has had considerable impact on the balance of the relationship between federal and state governments in the judicial arena.<sup>80</sup> It finds its origin in the efforts of many Southern states

74. It seems to have created a virtual call to arms in the copyright community. For example, in the case of *Richard Anderson Photography v. Radford Univ.*, 852 F.2d 114 (4th Cir. 1988), cert. denied, 489 U.S. 1033 (1989), a large number of organizations representing copyright owners such as ASCAP, BMI, the Association of American Publishers, Information Industry Association, the Songwriters Guild of America and Volunteer Lawyers for the Arts, Inc. filed amicus curiae briefs. This call resulted in the adoption of the Clarification Act.

75. See *infra* notes 196-98 and accompanying text.

76. Because of a series of judicially created doctrines which limit the scope of the eleventh amendment, federal courts have always had a limited ability to compel states to comply with federal law. See *supra* notes 38-40 and accompanying text. The most important of these doctrines permitted copyright owners to obtain injunctions which prohibit future violations of a copyright. Thus, as a practical matter, the eleventh amendment at most merely prevented authors from suing for monetary damages.

77. See, e.g., *Mihalek v. Michigan*, 595 F. Supp. 903, 905 (E.D. Mich. 1984) (eleventh amendment bars awards of money damages against states), *aff'd* on other grounds, 814 F.2d 290 (6th Cir. 1987).

78. All of the cases were decided prior to the enactment of the Clarification amendment. See, e.g., *Lane v. First Nat'l Bank of Boston*, 871 F.2d 166, 169 (1st Cir. 1989) (without deciding issue of whether the eleventh amendment prevents Congress from fashioning a remedy, holding that even if such authority exists, Congress did not exercise it); *BV Eng'g v. University of Calif., Los Angeles*, 858 F.2d 1394, 1400 (9th Cir. 1988) (same), cert. denied, 489 U.S. 1090, (1989); *Richard Anderson Photography*, 852 F.2d at 117 (same).

79. U.S. Const. amend. XI.

80. A complete discussion of the eleventh amendment is far beyond the scope of this article. For further materials, see C. Jacobs, *The Eleventh Amendment and Sovereign Immunity* (1972); J. Orth, *The Judicial Power of the United States* (1987); I. C. Warren, *The Supreme Court in United States History* 91-123 (1926); Field, *The Eleventh Amendment and Other Sovereign Immunity Doctrines: Part One*, 126 U. Pa. L. Rev. 515 (1977) [hereinafter *Field, Part One*]; Field, *The Eleventh Amendment and Other Sovereign Immunity Doctrines: Congressional Imposition of Suits Upon the States Part Two*, 126 U. Pa. L. Rev. 1203 (1978); Gibbons, *The Eleventh Amendment and State Sovereign Immunity: A Reinterpretation*, 83 Colum. L. Rev. 1889 (1983); Marshall, *The Diversity Theory of the Eleventh Amendment: A Critical Evaluation*, 102 Harv. L. Rev. 1372 (1989); Nowak, *The Scope of Congressional Power*

to avoid the debts they incurred during the Revolutionary War,<sup>81</sup> and it played a similar role following the Civil War.<sup>82</sup> Recently, the eleventh amendment has restrained the power of private citizens to obtain monetary redress for state violations of federal law.<sup>83</sup> As with much of the Constitution, arguments about the meaning of the eleventh amendment often involve broader questions about the appropriate scope of authority of a national government in a federalist scheme. Some view the amendment as an important weapon against federal intrusion into state affairs, arguing the amendment severely restricts the power of federal courts to consider combination citizen and state suits. The proponents of this view see the amendment's ability to prevent these awards of monetary damages as an effective and important barrier to federal intrusion into state treasuries, an intrusion that otherwise would harm the independence of state governments.<sup>84</sup> They also see the bar against combination citizen and state suits arising under state law as an important mechanism by which states retain the capacity to interpret their own laws<sup>85</sup> and define the parameters of sovereign immunity.

Those who advocate a more limited view of the amendment's reach tend to focus on the need of the federal government to retain its superior status in the federal scheme, arguing that the amendment is anachronistic and of limited value. This view is supported somewhat by the numerous Supreme Court doctrines that limit the eleventh amendment's reach,<sup>86</sup> especially those that permit combination citizen and state suits seeking injunctive relief. This view is also supported by the substantial intrusion into state treasuries resulting from the vast array of federal programs funding state activities. By its terms, the eleventh amendment could be interpreted as preventing federal courts from considering any combination citizen and state suit, including copyright suits. Over the years, however, the Supreme Court has eschewed such an interpretation, permitting some

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to Create Causes of Action Against State Governments and the History of the Eleventh and Fourteenth Amendments, 75 Colum. L. Rev. 1413 (1975).

81. See *Petty v. Tennessee-Missouri Bridge Comm'n*, 359 U.S. 275, 276 n.1 (1959) (when eleventh amendment was passed, states used it to keep from paying their debts to individual creditors); *Missouri v. Fiske*, 290 U.S. 18, 27 (1933) (motive behind passage of eleventh amendment was to keep prosecution of state debts out of federal courts); see also C. Jacobs, supra note 80, at 68 (acknowledging that scholars explain that the amendment won easy approval as a result of the states' fear of being compelled to pay debts); J. Orth, supra note 80, at 12-26 (discussing the states' concerns as to their ability to pay their war debts following the Supreme Court's decision in *Chisolm v. Georgia*, 2 U.S. (2 Dall.) 419 (1973)).

82. See J. Orth, supra note 80, at 58.

83. *Id.* at 147.

84. See *Edelman v. Jordan*, 415 U.S. 651, 663 (1974).

85. See *Pennhurst State School and Hosp. v. Halderman*, 465 U.S. 89, 106-07 (1984).

86. For example, the amendment does not prohibit citizen-state injunctive actions, *Ex Parte Young*, 209 U.S. 123, 161-62 (1908); suits initiated by the United States, *United States v. Mississippi*, 380 U.S. 128, 140-41 (1965); or suits initiated by other states, *North Dakota v. Minnesota*, 263 U.S. 365, 372-73 (1923). It also does not prevent citizen-state suits involving federal law from being considered by the U.S. Supreme Court, if the claims arose in state court. *Cohens v. Virginia*, 19 U.S. (6 Wheat.) 264, 394 (1821).

types of combination citizen and state suits to proceed, but barring others.<sup>87</sup> The issue of whether the eleventh amendment prevents Congress from creating a remedy for state copyright infringement has never been presented to the Supreme Court, and the Court's eleventh amendment decisions relating to other federal statutes do not clearly resolve the question. Nevertheless, as the analysis below demonstrates, the Court's reasoning in recent decisions indicates that the Clarification amendment is a lawful exercise of Congress' power to enact combination citizen and state remedies.

### 1. *Historical Background of the Eleventh Amendment*

As with many constitutional questions, the scope of the immunity provided to states by the eleventh amendment cannot be determined by reference to historical materials alone.<sup>88</sup> Although these materials do make it clear that the amendment was intended to limit the jurisdiction of the federal courts, they fail to clearly indicate the intended scope of that restriction.<sup>89</sup> The fundamental issue left unresolved by these materials is the extent to which Congress, acting pursuant to its Article I powers, can enact combination citizen and state remedies that can be pursued in federal courts. Furthermore, the historical materials do not resolve the question of whether the amendment restricts the method by which those remedies can be established, assuming that Congress has authority to do so. About all that is irrefutably clear about the history of the eleventh amendment is that the amendment was adopted in response to the Supreme Court's decision in *Chisholm v. Georgia*.<sup>90</sup> *Chisholm* was initiated by Alexander Chisholm, the executor of the estate of a South Carolina citizen who had supplied war materials to Georgia during the Revolutionary War. Unsuccessful in his attempts to secure payment by appeal to the state of Georgia and through a suit in the local federal court, Chisholm attempted to bring an assumpsit action directly in the Supreme Court of the United States under its original jurisdiction.<sup>91</sup> Georgia did not respond to Chisholm's complaint, claiming the Supreme Court did not have jurisdiction to consider claims against it.<sup>92</sup> The Court, in a four to one decision,<sup>93</sup> held it had jurisdiction.<sup>94</sup> Reaction

87. See *infra* notes 88-124 and accompanying text.

88. *But see* Brest, *The Misconceived Quest for the Original Understanding*, 60 B.U.L. Rev. 204 (1980) (the original intent of the framers of the Constitution should not resolve issues about its meaning); *cf.* R. Berger, *Government by Judiciary* (1977) (scope of Constitution is limited by drafters' intent).

89. A complete discussion of the historical materials is beyond the scope of this article. For further information, see, *inter alia*, C. Jacobs, *supra* note 80, at 3-74; J. Orth, *supra* note 80, at 12-29; C. Warren, *supra* note 80, at 101 & n.2; Gibbons, *supra* note 80, at 1899-1914.

90. 2 U.S. (2 Dall.) 419 (1793).

91. The Constitution provides: "In all Cases . . . in which a State shall be Party . . . the Supreme Court shall have original Jurisdiction." U.S. Const. art. III, § 2.

92. J. Orth, *supra* note 80, at 13.

93. At that time there were six positions on the Court. Judiciary Act of 1789, ch. 20, § 1, 1 Stat. 73. The sixth seat was vacant because of the recent resignation of Justice Thomas Johnson. J. Orth, *supra* note 80, at 12.

to the *Chisholm* decision was immediate.<sup>95</sup> Within two days of the *Chisholm* judgment's entry, a measure was introduced in Congress proposing an amendment to the Constitution. Within one year of its introduction, the requisite number of states ratified the eleventh amendment.<sup>96</sup>

Although there is agreement about the impetus for the amendment, there is little agreement about the intent of those who were involved in its passage. This historical dispute arises because there was only limited discussion of the issue of state immunity during the framing and ratification of the Constitution, and even less discussion concerning the intended scope of the eleventh amendment during the process of its adoption.<sup>97</sup> Moreover, to the extent the issue was discussed during the constitutional debates, contradictory statements were made both by those who urged the Constitution's adoption and by those who urged it be rejected. No clarifying statements that are supported by the majority of those discussing the document exist. Similarly, contradictory statements and motivations surfaced during the ratification of the eleventh amendment.<sup>98</sup> Thus, it is unclear whether the Constitution's framers intended that federal courts have jurisdiction over combination citizen and state cases, and it is unclear

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94. The members of the *Chisholm* majority, Justices Blair, Wilson, Cushing, and Jay, reasoned that under the constitutional scheme, states were susceptible to suit in federal court without further authorization from Congress. 2 U.S. (2 Dall.) at 449-79. Justice Iredell, the lone dissenter, did not reach the constitutional question. He argued that the Judiciary Act of 1789, ch. 20, § 14, 1 Stat. 73, 81-82, which had established the Supreme Court, did not provide for assumpsit actions against the states. In his view, the Court could not consider assumpsit actions against a state unless authorized by Congress. He reasoned that assumpsit actions were not traditionally ones that could be brought against a sovereign and thus explicit congressional authorization was necessary. 2 U.S. (2 Dall.) at 446. Although he did not reach the constitutional question, he intimated that even with congressional authorization, an assumpsit action could not be brought against a state. *Id.* at 448-49. It is this dicta, not Justice Iredell's holding, which is referred to in the debate about the Framers' intent. *See infra* text accompanying note 99.

95. There is some dispute about the extent of the reaction to the decision. The Supreme Court wrote that the decision "created such a shock of surprise that the Eleventh Amendment was at once proposed and adopted," *Monaco v. Mississippi*, 292 U.S. 313, 325 (1934), and that the decision created "a shock of surprise throughout the country." *Hans v. Louisiana*, 134 U.S. 1, 11 (1890). On the other hand, Judge John Gibbons writes, "Congress's initial reaction to the *Chisholm* decision hardly demonstrates the sort of outrage so central to the profound shock thesis." Gibbons, *supra* note 80, at 1926.

Perhaps the most hostile reaction to *Chisholm* came from the state of Georgia, where a bill which mandated "death, without the benefit of clergy, by being hanged" for anyone attempting to enforce the *Chisholm* judgment was passed by the Georgia House of Representatives, although not by its Senate. *See* J. Orth, *supra* note 80, at 17-18 (also explaining that the phrase "without benefit of clergy" meant that the normal exemption from capital punishment for first offenders would not be applicable).

96. At that time, the union was composed of fifteen states. J. Orth, *supra* note 80, at 20. By February 1795, 12 states had approved the proposed amendment. The proposed amendment did not become part of the Constitution until January 1798, however, because of a delay in the presidential proclamation of ratification. *See* C. Jacobs, *supra* note 80, at 67; U.S. Const. art. V (approval of two-thirds of the states necessary for ratification).

97. J. Orth, *supra* note 80, at 27-28 (of the hundreds attending state ratification conventions, few delegates addressed the issue as it applied to ratifying the Constitution).

98. *See* C. Jacobs, *supra* note 80, at 71-72 (discussing various factions and their reasons for supporting or not supporting ratification).



to what extent, if any, the eleventh amendment altered that vision. In general, three historical versions have emerged. These versions may be loosely called the absolutist view, the minimalist view, and the moderate view.

Until recently, the most commonly held view was the absolutist view. Under this interpretation, the *Chisholm* majority was wrong and the lone dissenter, Justice Iredell, was correct: Article III did not include a grant of jurisdiction to federal courts over suits by private citizens against states. Most of those who support this view argue that the eleventh amendment was adopted to "restore the original understanding [of the Framers]."<sup>99</sup> Thus, the eleventh amendment bars combination citizen and state suits arising under both diversity jurisdiction and federal question jurisdiction. This position is advanced in many of the Supreme Court's opinions and approved in many scholarly writings.<sup>100</sup>

Under the minimalist view, *Chisholm* was correct: the Constitution gave the federal courts jurisdiction to consider both diversity claims and federal question claims brought by private citizens against states. Most, although not all, who advance this view argue that the eleventh amendment had a limited goal—it was intended to prevent federal courts from hearing diversity cases such as the assumpsit action in *Chisholm*.<sup>101</sup> Under the minimalist view, cases presenting issues of federal law were not intended to be barred by the eleventh amendment. They can be heard in federal courts.<sup>102</sup> Under the moderate view, which is also supported by language in

99. *Employees v. Missouri Dep't of Pub. Health and Welfare*, 411 U.S. 279, 291-92 (1973) (Marshall, J., concurring). Justice Marshall apparently has since rejected this view and agrees with Justice Brennan that the eleventh amendment applies only to diversity cases. See *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 301-02 (1985) (Marshall, J., joining Brennan, J., dissenting).

100. *E.g.* *Monaco v. Mississippi*, 292 U.S. 313, 330 (1934) (stating that absent consent, the Constitution does not allow for suits brought by foreign states against states); *Hans v. Louisiana*, 134 U.S. 1, 11 (1890) ("the Constitution should not be construed to import any power to authorize the bringing of . . . suits [by individuals against states]"); I C. Warren, *supra* note 80, at 96 ("the vesting of any . . . jurisdiction over sovereign States had to be expressly disclaimed and even resented by the great defenders of the Constitution"); Cullison, *Interpretation of the Eleventh Amendment (A Case of the White Knight's Green Whiskers)*, 5 *Hous. L. Rev.* 1, 7, 9 (1967) (explaining that the majority of the framers wanted sovereign immunity to "survive" the Constitution); Mathis, *The Eleventh Amendment: Adoption and Interpretation*, 2 *Ga. L. Rev.* 207, 224-26 (1968) (arguing that the eleventh amendment was intended to bar all suits against states by individuals). Justices Rehnquist, Kennedy, Scalia, and O'Connor currently hold this position. See *Pennsylvania v. Union Gas*, 491 U.S. 1, 30-42 (1989) (Scalia, J., dissenting, joined by Rehnquist, J., Kennedy, J., and O'Connor, J.) (arguing that the eleventh amendment applies to both federal question and diversity cases).

101. *Field*, Part One, *supra* note 80, at 515-18, 522 (purpose of eleventh amendment is to prevent suits against states by citizens of other states); Mathis, *supra* note 100, at 224-30 (same). *But c.f.* *Nowak*, *supra* note 80, at 1414-15 (discussing examples of cases to which eleventh amendment applies and does not apply).

102. Justice Brennan was the most vocal member of the Supreme Court to espouse this position recently. From 1964 until his departure from the Court, he asserted in majority and dissenting opinions that the historical evidence indicates the eleventh amendment applies only to diversity cases. *Employees*, 411 U.S. at 309-24 (Brennan, J., dissenting) (discussing at length his interpretation of the historical evidence); *Parden v. Terminal Ry. of the Ala. State Docks Dep't*, 377 U.S. 184, 187 (1964) (Brennan, J.) (first raising, although not clearly stating his

some of the Court's decisions,<sup>103</sup> the Constitution gave federal courts the power to hear all combination citizen and state suits. The eleventh amendment, under the moderate view, was intended to create a total bar to federal court jurisdiction in combination citizen and state diversity cases, but only a limited bar in federal question cases. In federal question cases, the amendment merely prevents federal courts from assuming jurisdiction without congressional authorization. It does not prevent Congress from creating a combination citizen and state cause of action.<sup>104</sup>

Although the historical evidence is inconclusive, as Judge Gibbons has pointed out, it tends to show that the framers of the Constitution intended federal court jurisdiction for both diversity claims and federal question cases and that the eleventh amendment was intended merely to apply to diversity cases.<sup>105</sup> Because the Supreme Court has not yet adopted a settled view of the historical debates, the debate about the drafters' intent is likely to continue. Perhaps Professor Orth stated it best when he observed, "[T]he search for the original understanding on state sovereign immunity bears this much resemblance to the quest for the Holy Grail: there is enough to be found so that the faithful of whatever persuasion can find their heart's

view); see also *Welch v. Texas Dep't of Highways and Pub. Transp.*, 483 U.S. 468, 497 (1987) (Brennan, J., dissenting) (reviewing historical materials); *Atascadero*, 473 U.S. at 258-90 (Brennan, J., dissenting) (same); *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 125-26 (1984) (Brennan, J., dissenting) (same).

Justices Stevens, Marshall, and Blackmun joined Justice Brennan in espousing this view. See *Atascadero*, 473 U.S. at 304 (Stevens, J., dissenting) (indicating that a "fresh examination of the Court's Eleventh Amendment jurisprudence" is called for); id. at 247 (Marshall, J., Blackmun, J., and Stevens, J., joining Justice Brennan's dissent which argued that state-citizen federal question cases are not barred by the eleventh amendment); id. at 303 (Blackmun, J., dissenting) (stating that the *Atascadero* Court "compound[ed] a longstanding constitutional mistake" and agreeing with Justice Brennan that "the case rests on misconceived history and misguided logic").

Some earlier members of the Court also seem to have held this view. See, e.g., *Hans v. Louisiana*, 134 U.S. 1, 21 (1890) (Harlan, J., concurring) (stating that *Chisholm* was a "sound interpretation of the Constitution"); *New Hampshire v. Louisiana*, 108 U.S. 76, 91 (1883) (Waite, C. J.) (suggesting that *Chisholm* was decided correctly).

Many scholars have also expressed this opinion. See, e.g., C. Jacobs, *supra* note 80, at 27-40; Baker, *Federalism and the Eleventh Amendment*, 48 U. Colo. L. Rev. 139, 153-55 (1977); Fletcher, *A Historical Interpretation of the Eleventh Amendment: A Narrow Construction of an Affirmative Grant of Jurisdiction Rather than a Prohibition Against Jurisdiction*, 35 Stan. L. Rev. 1033, 1045-63 (1983); Gibbons, *supra* note 80, at 1913-14; Nowak, *supra* note 80, at 1425-30.

103. See *Port Authority Trans-Hudson Corp. v. Feeney*, 110 S. Ct. 1868, 1872, 1873 (1990) (Supreme "Court has adopted a particularly strict standard to evaluate claims that Congress has abrogated the States' sovereign immunity"); *Atascadero*, 473 U.S. at 242 ("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."); *Hutto v. Finney*, 437 U.S. 678, 698 n.3 (1978) (statutes enacted pursuant to fourteenth amendment limit the principle of sovereign immunity embodied in eleventh amendment); *Ex Parte State of New York, No. 1*, 256 U.S. 490, 497 (1921) (eleventh amendment forbids suits against a state by citizens of another state); *Monaco*, 292 U.S. at 329 (in absence of state's consent, eleventh amendment is absolute bar to suits against a state by citizens of another state).

104. See Nowak, *supra* note 80, at 1442 (arguing the eleventh amendment does not limit congressional power).

105. See J. Orth, *supra* note 80; Gibbons, *supra* note 80.

desire."<sup>106</sup>

## 2. *The Supreme Court's Eleventh Amendment Doctrine*

An analysis of Supreme Court case law interpreting the amendment leaves numerous issues unresolved as well. Nevertheless, the current view of a majority of the Court is that first, Congress has the power to adopt citizen-state remedies pursuant to at least one, and perhaps all, of its Article I powers.<sup>107</sup> Second, when it exercises that power, Congress must make its intent to create a combination citizen and state remedy clear in the statute's language.<sup>108</sup>

Both of the issues were settled in *Pennsylvania v. Union Gas Co.*,<sup>109</sup> decided in 1989. In *Union Gas*, the Supreme Court held that federal courts have jurisdiction over combination citizen and state suits brought pursuant to statutes adopted under the authority of the commerce clause.<sup>110</sup> In so doing, the Court made it clear that the eleventh amendment does not present an absolute barrier for all causes of action created pursuant to Congress's Article I powers.<sup>111</sup> Although the court rejected the absolutist view, clearly stating that the eleventh amendment did not bar consideration of commerce clause cases,<sup>112</sup> it did not explain whether it was adopting the minimalist view that the eleventh amendment has no applicability to any federal question case, or the moderate view. The Court also did not clearly answer the narrower question of whether federal courts have the power to consider claims brought pursuant to statutes adopted under any of Congress's other Article I powers. An examination of the Court's rationale in *Union Gas*, however, demonstrates the eleventh amendment presents no barrier to Congress' creation of combination citizen and state copyright remedies that can be litigated in federal court.

In *Pennsylvania v. Union Gas Co.*, the Union Gas Company, a private company, filed a third-party complaint seeking to hold the Commonwealth of Pennsylvania partially liable for coal tar clean-up costs for which the United States had sued Union Gas under the Comprehensive Environmental Response, Compensation and Liability Act of 1980 (CERCLA).<sup>113</sup> Pennsylvania sought to avoid liability on the theory, *inter alia*, that the

106. J. Orth, *supra* note 80, at 28.

107. In *Fitzpatrick v. Bitzer*, 427 U.S. 445, 456 (1976), the Court held that Congress could adopt the remedy in Title VII of the Civil Rights Act of 1964, 42 U.S.C. §§ 2000e-2000e-17 (1964), pursuant to which states could be liable. Congress' power granted in section five of the fourteenth amendment authorized the creation of such a remedy. *See* U.S. Const. amend. XIV, § 5.

108. *See Pennsylvania v. Union Gas Co.*, 491 U.S. 1, 7 (1989); *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 243 (1984).

109. 491 U.S. 1 (1989).

110. U.S. Const. art. 1, § 8, cl. 3 (authorizing Congress to "regulate Commerce") [hereinafter commerce clause].

111. *Union Gas*, 491 U.S. at 18.

112. *See* *supra* notes 99-100 and accompanying text. The absolutist view argues that federal courts do not have the power to consider any citizen-state claim which was brought pursuant to a statute adopted under any of Congress' Article I powers.

113. 42 U.S.C. §§ 9601-26, 9651-52, 9654-62, 9671-75 (1982) [hereinafter CERCLA].

eleventh amendment prevented Congress from enacting a law providing a cause of action which could be employed by a private party, such as Union Gas, to sue a state.<sup>114</sup> The Supreme Court held that the eleventh amendment did not prevent Union Gas' suit.<sup>115</sup>

The plurality opinion, written by Justice Brennan, gives only limited guidance with respect to its theoretical underpinnings and thus leaves a number of important issues unresolved. Justice Brennan reasoned that Congress's power to adopt combination citizen and state remedies under the commerce clause was not barred by the eleventh amendment because "to the extent that the States gave Congress the authority to regulate commerce [under the original constitutional plan], they also relinquished their immunity where Congress found it necessary, in exercising this authority, to render them liable."<sup>116</sup> He reasoned further that the language of the eleventh amendment could not be interpreted "to wipe out original understanding of congressional power."<sup>117</sup>

Although this language suggests that the eleventh amendment presents no barrier in any federal question case,<sup>118</sup> Justice Brennan inexplicably stated his decision was not overruling *Hans v. Louisiana*.<sup>119</sup> *Hans* is an 1890 decision in which the Supreme Court discussed the eleventh amendment in the course of denying federal court jurisdiction over a contract clause case.<sup>120</sup> In leaving *Hans* undisturbed, Justice Brennan left unre-

114. *Union Gas*, 491 U.S. at 2.

115. *Id.* at 23.

116. *Id.* at 19-20.

117. *Id.* at 18.

118. This rationale is consistent with Justice Brennan's view, articulated in earlier decisions, that the original constitutional plan gave the federal courts jurisdiction over all citizen-state suits and that the eleventh amendment was intended only to remove jurisdiction over cases arising under state law. *See supra* note 102.

119. 134 U.S. 1 (1890).

120. *Id.* at 11-18. In *Hans*, a citizen of Louisiana sought to sue the State of Louisiana for failing to honor its Civil War bonds. The plaintiff argued that the state had impaired the validity of his contract in violation of the contract clause of the U.S. Constitution. 134 U.S. at 1-3 (relying on U.S. Const. art. I, § 10, cl. 1, which states: "No State shall . . . pass any . . . Law impairing the Obligation of Contracts . . . ." [hereinafter the contract clause]). The plaintiff claimed the Court had jurisdiction to consider his case under article III of the Constitution, U.S. Const. art. III, § 2, cl. 1 (providing that "[t]he judicial power [of the United States] shall extend to all Cases, in Law and Equity, arising under this Constitution"), and the Judiciary Act of March 3, 1875, Ch. 137, § 1, 18 Stat. 470 (providing that "the circuit courts of the United States shall have original cognizance . . . of all suits . . . at common law or in equity . . . arising under the Constitution . . . of the United States"). 134 U.S. at 9. The Court dismissed the claim with language which left the basis of its decision unclear. 134 U.S. at 20-21.

Some have argued that the *Hans* Court held the eleventh amendment prevented consideration of any citizen-state claim, including *Hans*' claim, which arose under federal constitutional law. *See, e.g., Union Gas*, 491 U.S. at 30-42 (Scalia, J., concurring and dissenting); Marshall, *The Diversity Theory of the Eleventh Amendment: A Critical Evaluation*, 102 Harv. L. Rev. 1372, 1379-80 (1989) (same). Others have argued that the decision relied on sovereign immunity doctrines which, although reflected in the eleventh amendment, are not immutable constitutional barriers. *Union Gas*, 491 U.S. at 25 (Stevens, J., concurring). Another voice has argued that *Hans* does not even address the federal question issue, but rather turns on the state law claim. Burnham, *Taming the Eleventh Amendment Without Overruling Hans v. Louisiana*, 40 Case W. Res. 931 (1989). Justice Brennan, in earlier decisions, stated that the eleventh

solved the issue of the extent to which the eleventh amendment applies to federal question cases generally.

The assertion that *Hans* was not overruled by the Court's holding in *Union Gas* may be interpreted in several different ways. It might be interpreted, for example, as an indication that the eleventh amendment applies to some Article I powers although it does not prevent claims that are grounded in the commerce clause, such as *Union Gas*' CERCLA claim. It might also be interpreted as indicating that the amendment only bars those claims not grounded in a statute adopted by Congress, because *Hans*' claim was constitutional rather than statutory. Alternatively, the assertion could be a sign that in the future the Court may hold that the eleventh amendment has no applicability to federal question cases, but that it is unwilling to hand down such a far-reaching decision at this juncture.

The deciding vote in *Union Gas* was cast by Justice White, whose concurring decision merely muddied the waters by stating: "I agree with . . . Justice Brennan . . . that Congress has the authority under Article I to abrogate the Eleventh Amendment immunity of the States, although I do not agree with much of his reasoning."<sup>121</sup> In a footnote, Justice White indicated that *Hans* should not be overruled for the reasons stated in the plurality decision in *Welch v. Texas Department of Highways and Public Transportation*.<sup>122</sup> In *Welch*, the plurality opinion asserted that the eleventh amendment applied to federal question cases.<sup>123</sup> Justice White did not explain, however, what he meant by his reference to *Welch*. Thus, his view as to the exact role of the eleventh amendment was left unresolved. At most, this reference suggests that he may have adopted the moderate view.<sup>124</sup>

As a result of these ambiguous opinions, it is unclear from *Union Gas* as to whether a majority of the Court has adopted the minimalist view or the moderate view. *Union Gas*, however, is instructive with respect to one important issue pertaining to the problem of state copyright liability. A clear majority of the Court rejected the absolutist view and held instead that federal courts can consider citizen-state suits brought pursuant to remedies adopted under at least one of Congress' Article I powers. As the discussion below indicates, the portion of the decision rejecting the absolutist position clearly indicates that the eleventh amendment does not bar citizen-state copyright suits.

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amendment has no applicability to federal question cases. *Supra* note 102. Thus, if he feels *Hans* should not be overruled, its limiting principles would come from outside of the amendment. Justice Stevens adopted this position in *Union Gas*, arguing that the decision is based on notions of federalism. 491 U.S. at 26 (Stevens, J., concurring).

121. *Union Gas*, 491 U.S. at 57.

122. *Id.* at 2295 n.8 (citing *Welch v. Texas Dep't of Highways and Pub. Transp.*, 483 U.S. 468 (1987))

123. *Welch*, 483 U.S. at 485.

124. *See supra* note 103-04 and accompanying text for a discussion of the moderate view.

### 3. *Applicability of the Eleventh Amendment to Copyright Causes of Action*

Although the *Union Gas* decision makes it clear that Congress can create combination citizen and state remedies pursuant to the commerce clause, neither the plurality nor Justice White stated whether their analysis might extend to other Article I powers, including the copyright clause. It seems that the plurality was hinting at a very broad power that could abrogate the immunity under any authority enumerated in Article I.<sup>125</sup> Yet nowhere does the Court explicitly state that proposition. Nevertheless, a review of the rationale of the plurality decision and the Court's rationale in *Fitzpatrick v. Bitzer*,<sup>126</sup> the only other Supreme Court case to recognize a power of "abrogation,"<sup>127</sup> indicates that the Clarification amendment is a constitutional exercise of congressional power.

*Fitzpatrick* was the first case in which the Court held that Congress has the power to create a citizen-state remedy cognizable in federal court. In this case, the plaintiffs sued the State of Connecticut<sup>128</sup> under Title VII of the Civil Rights Act of 1964,<sup>129</sup> which had been adopted pursuant to the fourteenth amendment of the U.S. Constitution. The state argued that the eleventh amendment barred the back pay and attorney's fees sought by the plaintiffs.<sup>130</sup> The Court disagreed, holding that Congress could create a combination citizen and state remedy for monetary relief under the fourteenth amendment because that amendment embodied a limitation on state authority, and thus the eleventh amendment gave the state no immunity.<sup>131</sup> The Court quoted the following passage from *Ex parte Virginia*<sup>132</sup> to explain the decision:

[I]n exercising her rights, a State cannot disregard the limitations which the Federal Constitution has applied to her power. Her rights do not reach to that extent. Nor can she deny to the general government the right to exercise all its granted powers, though they may interfere with the full enjoyment of rights she would have if those powers had not been thus granted. Indeed, every addition of power to the general government involves a corre-

125. See supra note 102.

126. 427 U.S. 445, 452-56 (1976) (permitting a citizen-state suit to proceed).

127. The term "abrogation" is often used in eleventh amendment analysis, in this author's view too loosely and in some instances, incorrectly. The word "abrogation" assumes that the eleventh amendment has some relevance to Article I inquiries. That issue is still subject to debate. If the amendment is not applicable to federal question cases, then Congress is not abrogating anything when it enacts a citizen-state remedy under Article I.

128. The suit was brought against the State Treasurer, the State Comptroller, and the Chairman of the State Employees' Retirement Commission of the State of Connecticut. For eleventh amendment purposes, this was a suit against the State of Connecticut as the real party in interest, not the named party, in determining the applicability of the amendment's immunity. *Fitzpatrick*, 427 U.S. at 445. See also *Leer v. Murphy*, 844 F.2d 628, 631 (9th Cir. 1988) (§ 1983 suit barred because the state was the real party in interest).

129. 42 U.S.C. §§ 2000e-2000e-17 (1982).

130. *Fitzpatrick*, 427 U.S. at 451.

131. *Id.* at 456.

132. 100 U.S. 339 (1879).

sponding diminution of the governmental powers of the States. It is carved out of them.<sup>133</sup>

The passage is significant because it relies on notions of federal supremacy and state surrender of rights, notions not unique to the fourteenth amendment.<sup>134</sup>

In *Union Gas*, the plurality decision employed similar reasoning. It argued that the commerce clause granted Congress the authority to create citizen-state remedies "[b]ecause the Commerce Clause withholds power from the States at the same time as it confers it on Congress, and because the congressional power thus conferred would be incomplete without the authority to render States liable in damages . . . ."<sup>135</sup> The Court concluded that the states accepted this limitation on their authority when they signed the Constitution and this limitation was not altered by the eleventh amendment.<sup>136</sup>

Neither of these decisions used language that limits its scope to the particular powers discussed. Instead, taken together, they speak broadly of constitutional grants which, to be effective, require a superior federal power and a concomitant surrender of state authority. To implement these constitutional grants effectively, Congress necessarily must be able to abrogate state immunity. Moreover, the constitutional grant may either explicitly, as with the fourteenth amendment, or implicitly, as with the commerce clause, diminish state governmental powers.<sup>137</sup>

Important, although perhaps not critical, in the evaluation of whether a particular grant of federal power carries with it a federal power to create combination citizen and state remedies is whether suits for monetary damages by individuals are necessary to protect fully the interests regulated under the power.<sup>138</sup> As the discussion below shows, the copyright clause

133. *Id.* at 346.

134. For example, it does not place emphasis on the fact that the fourteenth amendment was adopted after the eleventh amendment and thus could be seen as a subsequent restriction on the scope of the eleventh amendment's limitation. *See Hutto v. Finney*, 437 U.S. 678, 717-18 (1978) (Rehnquist, J., dissenting).

135. *Union Gas*, 491 U.S. at 19-20.

136. *Id.*

137. The fourteenth amendment explicitly limits state authority. It provides:

*No State shall make or enforce any law which shall abridge the privileges or immunities of citizens of the United States, nor shall any State deprive any person of life, liberty, or property, without due process of law; nor deny to any person within its jurisdiction the equal protection of the laws.*

U.S. Const. amend. XIV (emphasis added). The commerce clause, on the other hand, contains no similar language. Nevertheless, on innumerable occasions it has been construed as including a limitation on state authority. *See, e.g., Employees of the Dep't of Health & Welfare v. Missouri Pub. Health Dep't*, 411 U.S. 279, 286 (1973); *Parden v. Terminal Ry. of the Ala. Docks Dep't*, 377 U.S. 184, 191 (1964) (requiring state-operated railroad to waive sovereign immunity and submit to suit in federal court). The copyright clause, like the commerce clause, contains no explicit language diminishing state authority. It does, however, implicitly limit state power. *See infra* notes 159-73 and accompanying text.

138. The issue of monetary damages is mentioned in *Union Gas*, 491 U.S. at 19-22, but not in *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976).

meets this requirement.<sup>139</sup> Like the commerce clause, the copyright clause is a grant of congressional authority that provides the federal government with the ability to exercise final authority over states.<sup>140</sup> The framers envisioned a uniform national system to which state regulatory powers would be subservient.<sup>141</sup> Furthermore, the framers envisioned that monetary damages in private citizen suits would be an important element in the establishment of this superior federal authority.<sup>142</sup>

The origins of the copyright clause are somewhat shrouded in mystery because the clause was introduced and adopted with little or no debate during the Constitutional Convention and remained uncontroversial during the subsequent ratification process. It seems clear, however, that one of the primary motivations for inclusion of the copyright clause in the Constitution was the desire for a uniform national system of copyright law which would supplant a patchwork system of local state control.<sup>143</sup> Although all of the states except Delaware<sup>144</sup> had passed copyright statutes by

139. See *infra* notes 174-78 and accompanying text. The plurality decision in *Union Gas* implies, but does not hold, that any of the Article I powers would meet this requirement. 491 U.S. at 14-15. The Court has not had an opportunity to decide this issue. In no other case has a majority of the Court addressed the scope of Congress' power to adopt citizen-state remedies pursuant to Article I. Justice Marshall did address it in his dissent in *Hoffman v. Connecticut Dep't of Income Maintenance*, 492 U.S. 96, 106 (1989). He reasoned that because the bankruptcy clause, U.S. Const. art. I, § 8, cl. 4, like the commerce clause, gives "Congress plenary power over national economic activity," Congress could abrogate the state's eleventh amendment immunity under the bankruptcy clause. *Hoffman*, 492 U.S. at 111 (Marshall, J. dissenting). The majority in *Hoffman* did not reach the issue because it held that states could not be sued under the Bankruptcy Code. *Id.* at 2824. See also *Union Gas*, 491 U.S. at 37-38 (Scalia, J., dissenting and concurring) (arguing that Justice Brennan's analysis would permit Congress to enact citizen-state remedies pursuant to any Article I power).

As noted above, *supra* note 102, Justices Brennan, Marshall, Blackmun and Stevens have indicated in earlier opinions that the eleventh amendment does not present a barrier when Congress exercises its Article I powers. Under that analysis, citizen-state copyright actions could be pursued. Justice White has not yet expressed his view on this issue.

140. See *Goldstein v. California*, 412 U.S. 546, 560 (1973) (noting that no state or citizen may escape reach of congressional grant of copyright).

141. See generally *infra* notes 143-52 and accompanying text. See B. Bugbee, *The Genesis of American Patent and Copyright Law* 125-31 (1967).

142. See *infra* notes 169-77 and accompanying text.

143. B. Bugbee, *supra* note 141, at 126 ("to grant charters of incorporation in cases where the public good may require them, and the authority of a single state may be incompetent"); See Latman, Gorman & Ginsberg, *Copyright for the Nineties* 4 (3d ed. 1988).

144. See Copyright Office, *Copyright Enactments, Laws Passed in the United States Since 1783 Relating to Copyright*, Copyright Office Bulletin No. 3 at 1-21 (1963) [hereinafter *Copyright Enactments*].

The colonies provided little, if any, copyright protection to American writers until the 1780's. The only general statute which existed in the colonies before 1783 was a statute adopted by Massachusetts in 1672, in response to the urging of John Usher, a wealthy merchant-bookseller, who sought protection for one of his works. *Massachusetts Records, IV*, pt. 2, 527 (cited in B. Bugbee, *supra* note 141, at 66). It seems to have been of limited value. The next year Massachusetts passed an act providing protection specially for Usher's book. *Id.* There were a few other isolated efforts to protect copyrightable material by private bill, only a few of which were successful. I. Lowens, *Music and Musicians in Early America* 59 (1964) (cited in K. Silverman, *A Cultural History of the American Revolution* 396, 400 (1976)).



the time the Constitution was adopted, these state laws failed to provide American authors<sup>145</sup> with adequate protection. First, all authors were not treated similarly within a single state. Some of the states provided protection to out-of-state authors only if their states passed similar legislation.<sup>146</sup> Second, not all of the states adopted copyright legislation; therefore, an author could not secure protection for a work throughout the entire country. Moreover, Maryland and Pennsylvania had copyright statutes that included provisions preventing these statutes from becoming effective unless all of the other states passed similar copyright legislation. Delaware did not enact similar legislation, so the Maryland and Pennsylvania statutes never took effect. Third, the protection provided by state statutes was not uniform.<sup>147</sup> For example, the period of protection varied from state to state.<sup>148</sup> In addition, some states required registration<sup>149</sup> while others did

The exact impetus for the sudden explosion of protection in the 1780's seems in part to be the result of the substantial increase in writings by Americans. *Id.* Through the efforts of Noah Webster, Joel Barlow, and others, the Continental Congress appointed a committee to explore the issue of copying. J. Madison, 8 *The Papers of James Madison* 97 n.2 (Rutland, Rachel, Ripei & Teute eds. 1973); *Copyright Enactments*, supra, at 1 (one of the members of the Committee was James Madison). On the basis of the Committee's recommendations, the Continental Congress passed an act encouraging all states to protect authors' rights. *Resolution Passed by the Continental Congress, May 2, 1783, H.R.J. Res., Cont. Cong. (1783)*, reprinted in *Copyright Enactments*, supra, at 1. By 1786 all states except Delaware had passed copyright laws. *Id.* at 1-21.

145. Most statutes did not protect works by foreign authors. There were only a few Americans writing marketable copyrightable materials during the colonial period. *See also* K. Silverman, *A Cultural History of the American Revolution* 46-47 (1976). As a result, much of the printing industry was publishing works by European authors. It was advantageous for American publishers not to provide protection for those authors. *Id.* at 46-69. The first U.S. copyright statute only protected American authors. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124 (1790). It was not until 1891 that U.S. copyright law provided protection for foreign authors. Act of March 3, 1891, ch. 565, § 13, 26 Stat. 1110 (1891).

146. Conn. Acts, § 7, reprinted in *Copyright Enactments*, supra note 144, at 2; Mass. Acts, § 3, reprinted in *Copyright Enactments*, supra note 144, at 4; 1791 N.C. Sess. 563-65, § III (J. Iredell ed.), reprinted in *Copyright Enactments*, supra note 144, at 16. These provisions are not remarkable if viewed in the context of the independent status of the states under the Articles of Confederation. Even today most nations extend copyright protection to foreigners only if that protection is reciprocated. *See, e.g.*, 17 U.S.C. § 104 (b)(5) (1988) (U.S. protection extended to a foreign author only if similar protection is provided to U.S. citizens by the country of origin of the foreign author.)

147. *See* Bugbee, supra note 141, at 128.

148. *E.g.*, Conn. Acts §§ 1, 3, reprinted in *Copyright Enactments*, supra note 144, at 2 (providing for two fourteen-year terms); Mass. Acts, § 2, reprinted in *Copyright Enactments*, supra note 144, at 4 (providing for one twenty-one year term); N.H. Laws, § 2, reprinted in *Copyright Enactments*, supra note 144, at 8 (providing for one twenty-year term).

149. *E.g.*, Conn. Acts, § 2 (registration with Secretary of State), reprinted in *Copyright Enactments*, supra note 144, at 2; M. Laws, § 3 (registration with the Clerk of the Maryland General Court), reprinted in *Copyright Enactments*, supra note 144, at 6; Mass. Acts, § 3 (registration with University at Cambridge), reprinted in *Copyright Enactments*, supra note 144, at 4; 1783 N.J. Gen. Assembly Acts, c.21 § 1 (Collins) (registration with Secretary of State), reprinted in *Copyright Enactments*, supra note 144, at 7; N.Y. Laws, § 1 (registration with Secretary of State), reprinted in *Copyright Enactments*, supra note 144, at 19; N.C. Sess. Laws, § 1 (registration with Secretary of State) reprinted in *Copyright Enactments*, supra note 144, at 16; Pa. Laws, § 4 (registration with Prothonotary's Office in Philadelphia), reprinted in *Copyright Enactments*, supra note 144, at 11; S.C. Acts, § 2 (registration with Secretary of

not,<sup>150</sup> and the requirements for granting licenses varied from state to state.<sup>151</sup> These inconsistencies in state laws made it extremely difficult to obtain adequate protection.<sup>152</sup>

The difficulties these laws presented caused a number of vocal and politically influential writers to lobby for a national authority to adopt uniform copyright legislation. It was largely a result of their efforts that the copyright clause was proposed and unanimously adopted by the Constitutional Convention.<sup>153</sup> Several other concerns surrounding the adoption of

State), reprinted in Copyright Enactments, supra note 144, at 13; Va. Acts, § 2 (registration with Clerk of Council), reprinted in Copyright Enactments, supra note 144, at 15.

150. N.H. Laws, § II, reprinted in Copyright Enactments, supra note 144, at 8; 1783 R.I. Acts & Resolves 6, 7 (Carter), reprinted in Copyright Enactments, supra note 144, at 9.

151. Conn. Acts, § 1 (consent of author signed in the presence of two witnesses), reprinted in Copyright Enactments, supra note 144, at 2; Ga. Law, § 1 (permission of author signed in the presence of two witnesses), reprinted in Copyright Enactments, supra note 144, at 17; M. Laws, § II (consent signed in presence of two witnesses), reprinted in Copyright Enactments, supra note 144, at 5; Mass. Acts, § 3 (consent of author), reprinted in Copyright Enactments, supra note 144, at 4; N.H. Laws, § 3 (consent of author), reprinted in Copyright Enactments, supra note 144, at 8; N.J. Laws, § 1 (consent of author in writing duly attested), reprinted in Copyright Enactments, supra note 144, at 7; N.Y. Laws, § 1 (consent of author signed in presence of two witnesses), reprinted in Copyright Enactments, supra note 144, at 19; N.C. Sess. Laws, § I (consent of author signed in presence of two witnesses), reprinted in Copyright Enactments, supra note 144, at 16; Pa. Laws, § III (consent of author), reprinted in Copyright Enactments, supra note 144, at 10; R.I. Acts & Resolves, § 3 (consent of author) reprinted in Copyright Enactments, supra note 144, at 9; S.C. Acts, § 1 (consent of proprietor in writing signed in presence of two or more credible witnesses), reprinted in Copyright Enactments, supra note 144, at 12; Va. Acts, § I (consent of author signed in presence of two witnesses), reprinted in Copyright Enactments, supra note 144, at 15. *See also* Hudson & Goodwin v. Paten, 1 Root 133 (Conn. 1789) (deciding whether New York or Connecticut law applied to a copyright claim to Noah Webster's Institute of English Grammar).

152. A. Latman, R. Gorman & J. Ginsburg, Copyright for the Nineties 5 (1989) [hereinafter Latman].

153. The first printed draft of the Constitution, as reported by the Committee on Detail, contained no mention of copyright. James Madison and Charles C. Pinckney later proposed, on the floor of the convention, a number of amendments giving certain enumerated powers to the federal legislature, including the power to adopt copyright legislation. J. Madison, Notes of the Debates in the Federal Convention 477-78 (A. Koch ed. 1984) [hereinafter Notes]. The clauses and amendments that had been proposed but not yet voted upon were submitted to the Committee of Eleven. There is no record of the Committee's deliberations. The clause was reported by the Committee without alteration and adopted by the Convention without debate. *Id.* at 579-81.

Madison advocated a strong national role in copyright. He had been active in the copyright activities of the Continental Congress. In House Document No. 398, "Observations, April, 1787, on the Vices of the Political System of the United States," Madison addressed the Constitutional Convention about the flaws of the Articles of Confederation. Among the flaws he enumerated was the fact that relationships between the states suffered from "want of uniformity in the laws concerning naturalization and literary property." Documents Illustrative of the Formation of the Union, H.R. Doc. No. 398 at 595 (cited in Fenning, The Origin of the Patent and Copyright Clause of the Constitution, 17 Geo. L. J. 109, 113 (1929)). The Federalist Papers furthers Madison's position on copyrights. There he wrote:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.

the copyright clause suggest that the Convention Delegates intended to create a strong, uniform, national authority. First, by 1787, national copyright legislation was a common component of other national governments—Germany's scheme had origins from at least the early 1600s, Italy's from the late 1400s, and England's dated from the early 1700s.<sup>154</sup> Thus, the notion that a sovereign should regulate copyrights was undoubtedly familiar to the framers. Second, with the emergence of the new nation, many advocated the development of a strong national identity.<sup>155</sup> Many of the framers perceived a strong national literary voice to be an important part of that identity. Federal copyright legislation, by providing encouragement to American writers, was seen as a means to aid in the development of that identity.<sup>156</sup> Third, there was sentiment that a copyright scheme played an important role in maintaining an informed body politic.<sup>157</sup> Thus, the framers gave Congress the authority to adopt copyright legislation to encourage the development of a body of political literature. Finally, the framers undoubtedly were influenced by the fact that many of them were authors. For these reasons, the grant given to Congress was intended to be as forceful as possible to fully realize the goals of the copyright. As the Supreme Court has observed, the copyright clause permits Congress to establish "an exclusive right or monopoly, [whose] effects are [so] pervasive, [that] no citizen or state may escape its reach."<sup>158</sup>

The possibility of both federal and state regulatory systems in the copyright context differentiates the commerce clause and the fourteenth amendment from the copyright clause. The commerce clause and the fourteenth amendment bar state action whether or not the federal government has adopted regulation. States may not regulate interstate commerce or deny due process rights to their citizens regardless of whether the federal government has acted.<sup>159</sup> In contrast, a state may adopt copyright legislation covering copyrightable works in the absence of federal law.

This concurrent copyright power provides states with the authority to provide protection for copyrightable works which may be of "purely local importance and not worthy of national attention or protection . . ."<sup>160</sup> The dual power of regulation, however, does not diminish federal authority in that Congress can prevent state regulation of any copyrightable matters

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J. Madison, *The Federalist Papers* No. 43 at 288 (1788) [hereinafter the *Federalist Papers*].

154. See B. Bugbee, *supra* note 141.

155. See generally K. Silverman, *supra* note 145.

156. See *The Federalist Papers*, *supra* note 153, at 288; K. Silverman, *supra* note 145, at 482.

157. G. Washington, *Address to Congress* (Jan. 8, 1790), reprinted in *Copyright Office, Copyright in Congress, 1789 to 1904*, 115-16 (1976).

158. *Goldstein v. California*, 412 U.S. 546, 560 (1973) (emphasis added).

159. *Missouri Pac. R.R. v. Stroud*, 267 U.S. 404, 408 (1925); *Gibbons v. Ogden*, 22 U.S. (9 Wheat.) 1, 209 (1824). *But see* *Northeast Bancorp, Inc. v. Board of Gov. of the Fed. Reserve Sys.*, 472 U.S. 159, 174 (1985) (states have power to regulate commerce where authorized by Congress); *Prudential Ins. Co. v. Benjamin*, 328 U.S. 408, 433-36 (1946) (South Carolina tax on out-of-state insurance companies did not violate commerce clause).

160. *Goldstein*, 412 U.S. at 558.

which it deems to be of national importance.<sup>161</sup> Thus, as under the commerce clause, states cannot regulate copyright matters that Congress deems are of national significance and within the exclusive authority of the national government, whether the use is by a state or a private citizen.<sup>162</sup>

To the extent the courts have discussed the issue of federal versus state authority, it is clear that state authority is limited. The issue has arisen almost exclusively in preemption cases, in which the Supreme Court and the lower federal courts have held that state law is void under the supremacy clause<sup>163</sup> if it “stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.”<sup>164</sup> Although states have long regulated copyrightable works, they have done so only when those works are not covered under federal copyright law.<sup>165</sup>

Further evidence of the scope of federal copyright power is the fact that Congress traditionally has acted with the clear perception that its authority is supreme. The 1976 Act, which is a very extensive restriction on the ability of the states to regulate copyrightable works, most clearly illustrates this perception.<sup>166</sup> The most significant change brought about by

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161. *Id.* at 560.

162. “When Congress grants an exclusive right or monopoly [under the copyright clause]; its effects are pervasive; no citizen or State may escape its reach.” *Id.*

163. U.S. Const. art. VI, cl. 2.

164. *Goldstein*, 412 U.S. at 561 (quoting *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941)).

165. *See, e.g., Goldstein*, 412 U.S. at 569-70 (states free to regulate tapes and recordings not then covered by federal law).

166. Under § 301 of the 1976 Act, 17 U.S.C. § 301 (1988), state remedies that extend to works within the subject matter of the federal copyright statute are preempted if they provide for rights that are equivalent to those granted under the 1976 Act. *See generally*, Comment, The Evolution of the Preemption Doctrine and its Effect on Common Law Remedies, 19 Idaho L. Rev. 85, 92-93 (1983) (discussing common law causes of actions that have survived federal constitutional and statutory preemption doctrines).

In four cases decided prior to the adoption of section 301, the Supreme Court considered the issue of federal preemption of state intellectual property claims. In *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) (federal patent preemption) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) (same), the Supreme Court held that state remedies proscribing copying were preempted when they proscribed copying that was permitted under federal law. The reach of these decisions, which seemed to preclude almost all state remedies covering intellectual properties, was limited by *Goldstein*, 412 U.S. 546 (federal patent preemption), and *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974) (federal patent preemption). In *Goldstein*, the Court permitted state regulation of sound recordings which, at that time, were not covered by the federal copyright statute. The Court held that as to sound recordings, “Congress [had] drawn no balance; rather it left the area unattended” and thus the states were free to regulate. 412 U.S. at 570. In *Kewanee Oil*, the Court held the state regulation at issue was permissible, even though the federal law covered the works in question. The Court reasoned that the state law did not “clash” with the federal statute, because the state law sought to regulate different yet compatible objectives, thus, the state law was not preempted. 416 U.S. at 491-93. *See also* *Brignoli v. Balch Hardy and Scheinman, Inc.*, 645 F. Supp. 1201, 1205 (S.D.N.Y. 1986) (holding state copyright law preempted when state created right is equivalent to any of the rights provided by 17 U.S.C. § 106 (1988)); *Abrams, Copyright Misappropriation and Preemption: Constitutional and Statutory Limits of State Law Protection*, 1983 Sup. Ct. Rev. 509 (discussing constitutional and statutory preemption of state laws under copyright clause of the Constitution and 1976 Act).

the 1976 Act is its coverage of unpublished works.<sup>167</sup> Under prior law, unpublished works were not covered by federal law and therefore could be protected under state law.<sup>168</sup> The 1976 Act, however, covers any work "fixed in any tangible medium of expression" regardless of whether or not it has been published, leaving little for states to regulate.<sup>169</sup>

Also, as with the commerce clause, the drafters of the copyright clause clearly envisioned that private citizens would be a significant instrument of enforcement. Historically, English copyright laws and the limited copyright legislation adopted during the Articles of Confederation had protected the copyright by allowing suits by private individuals.<sup>170</sup> This was true even when the recoverable damages included fines that were to be turned over to the government.<sup>171</sup> The framers did not contemplate a different framework for the federal law. The copyright clause, by its language, envisions a mechanism to be enforced by individuals. It states that Congress shall "secure . . . to Authors . . . the exclusive right to their respective writings . . ." <sup>172</sup> Many of the same individuals who had been involved in the adoption of the U.S. Constitution provided further evidence of the intent for private suits by establishing this remedy in the first U.S. copyright

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167. What constitutes a published work within the meaning of the statute turns principally on the question of whether the author has made physical copies of the work available for public distribution. See 1 M. Nimmer, *Nimmer on Copyright*, § 4.04, at 4-17 (1988).

168. 1 M. Nimmer, *supra* note 167 § 4.01, at 4-2.

169. 17 U.S.C. § 102(a) (1988).

170. Statute of Anne, § I; Ga. Law, § 1, reprinted in *Copyright Enactments*, *supra* note 144, at 1; Md. Laws, § IV, reprinted in *Copyright Enactments*, *supra* note 144, at 6; Mass. Acts, § 3, reprinted in *Copyright Enactments*, *supra* note 144, at 4; N.H. Laws, § 3, reprinted in *Copyright Enactments*, *supra* note 144, at 8; N.J. Laws, § 1, reprinted in *Copyright Enactments*, *supra* note 144, at 7; N.Y. Laws, § 1, reprinted in *Copyright Enactments*, *supra* note 144, at 19; N.C. Laws, § I, reprinted in *Copyright Enactments*, *supra* note 144, at 16; Pa. Laws, § III, reprinted in *Copyright Enactments*, *supra* note 144, at 10; R.I. Acts & Resolves, § 2, reprinted in *Copyright Enactments*, *supra* note 144, at 3; S.C. Acts, § 1, reprinted in *Copyright Enactments*, *supra* note 144, at 12; Va. Acts, § I, reprinted in *Copyright Enactments*, *supra* note 144, at 15.

171. Statute of Anne, § I (one-half of penny per page penalty to Queen); Conn. Acts, § 1 (damages two times value of all copies), reprinted in *Copyright Enactments*, *supra* note 144, at 2; Ga. Laws, § 1 (damages two times value of all copies printed), reprinted in *Copyright Enactments*, *supra* note 144, at 17; Md. Laws, § II (damages of two pence per sheet), reprinted in *Copyright Enactments*, *supra* note 144, at 6; Mass. Acts, § 3 (damages of £5-3000), reprinted in *Copyright Enactments*, *supra* note 144, at 4; N.H. Laws, § 3 (damages of £5-1000), reprinted in *Copyright Enactments*, *supra* note 144, at 8; N.J. Laws, § 1 (damages of two times value of copies), reprinted in *Copyright Enactments*, *supra* note 144, at 7; N.Y. Laws, § I (damages of two times value of all copies printed), reprinted in *Copyright Enactments*, *supra* note 144, at 19; N.C. Sess. Laws, § I (damages assessed at two times the value to be distributed one-half to state, one-half to plaintiff), reprinted in *Copyright Enactments*, *supra* note 144, at 16; Pa. Laws, § III (damages of two times value of copies), reprinted in *Copyright Enactments*, *supra* note 144, at 10; R.I. Acts & Resolves, § 3 (damages of £5-3000), reprinted in *Copyright Enactments*, *supra* note 144, at 9; S.C. Acts, § 1 (damages of one shilling per sheet to be distributed one-half to state, one-half to plaintiff), reprinted in *Copyright Enactments*, *supra* note 144, at 12; Va. Acts, § I (damages of two times value of all copies printed), reprinted in *Copyright Enactments*, *supra* note 144, at 15.

172. U.S. Const. art. I, § 8, cl.8.

statute.<sup>173</sup>

Finally, to ensure effective copyright enforcement, monetary damages are needed. First, the ephemeral nature of many unauthorized uses makes it difficult to protect copyrights with injunctive orders. Unless authors have some policing mechanism available, they will have a difficult time determining whether their works are being used in violation of a court order. Second, an injunctive order alone may not be enough to encourage a recalcitrant state to recognize the copyrights of other authors. A state subject to a court order simply can use another similar work, almost with impunity. The only risk to the state is the possibility of a similar suit for injunctive relief by the second author. If monetary damages are unavailable, however, the author of the second work, or even the first, may be reluctant to engage in costly litigation.<sup>174</sup> Enforcement of an injunction also includes expenses that may render an injunction of little value.<sup>175</sup> Third, because many copyrighted works have limited lifespans, injunctions are of

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173. See generally *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56-58 (1884) (scope of the first copyright statutes are illustrative of the framers' intent because many of those involved in the adoption of the copyright clause also were involved in the adoption of the first statutes).

174. Unauthorized performances of musical compositions provide a good example of this problem. If a composer wants to challenge the use of a song, someone must be present during the performance of the work to provide evidence of the infringement. If no one who is acting on behalf of the composer is present, more likely than not there will be no evidence to prove a work was performed in violation of any copyright. Clearly, composers and their agents cannot be waiting and listening for the unscheduled moments when their works will be performed in a school play, on a state college jukebox, over a state college radio station, or at a party sponsored by a fraternity at a state school. As a result, most composers are affiliated with performing rights societies which enforce their rights. These societies are authorized by their members or affiliates to grant performance rights licenses and to bring infringement lawsuits. Two of these societies, ASCAP and BMI, collectively own the rights to over 95% of American popular musical compositions. Note, *Blanket Licensing of Music Performing Rights in Syndicated Television: It's Time to Change the System*, 9 *Whittier L. Rev.* 331, 332 (1987) (citing Norton, *Who Pays the Piper*, *Fortune*, June 23, 1986, at 120).

Performing rights societies obtain evidence of copyright infringement by monitoring randomly selected performances of entities or persons who have not purchased licenses from the societies. For example, performing rights societies may listen to a randomly selected broadcast on a college radio station. The compositions that are performed during the monitored time period form the basis of the infringement action. If different time periods had been chosen, the compositions serving as the basis for the lawsuit would have been different. They might differ not only as to the songs performed but also as to the persons who composed them. As a result, the injunctions that issue in such infringement actions are of limited value. They may enjoin only the performances of the specific composer's songs that were performed at the randomly selected times. Therefore, infringers would not be under court order with respect to any other compositions. Accordingly, the infringing users may continue to make unauthorized performances of other compositions without any serious consequence (except, of course, the costs and attorney fees associated with another lawsuit by the performing rights society). Only the threat of damages provides sufficient incentive to halt future unauthorized performances. See generally *Comment Letters*, supra note 42, Letter No. 23 at 7-9 (discussing this problem).

BMI asserts that the recent decisions in the area of copyright and eleventh amendment have resulted in the unwillingness of some government agencies to obtain licenses for musical attractions in government owned stadiums and arenas. *Comment Letters*, supra note 42, Letter No. 18 at 2.

175. See S. Rep. 305, supra note 11, at 12.

limited value. For example, an injunction prohibiting future use of newsworthy photographs and popular songs could be of little value.<sup>176</sup> Fourth, in some cases, courts have refused to award injunctive relief on the ground that such an order would not be equitable.<sup>177</sup> In those situations, if monetary relief were unavailable as well, the copyright owner would be left without redress.<sup>178</sup>

Thus, the copyright clause is similar to the commerce clause in several important respects. Like the commerce clause, the original constitutional plan envisioned a broad-reaching federal authority which, when necessary, would restrict and limit state power. Also similar to the commerce clause, the framers intended that the interests safeguarded by the copyright clause be protected by private citizens in suits in which monetary damages can be recovered. These similarities indicate that the framers of the copyright clause envisioned the possibility that states would be subject to private citizen copyright suits and that the eleventh amendment does not restrict the congressional copyright grant.

### III. POLICY CONSIDERATIONS

The next inquiry is whether Congress should have amended the federal law to provide a clear remedy against state use of copyrighted works or, alternatively, states should be only indirectly subject to the strictures of the 1976 Act.<sup>179</sup> To answer that question, this section of the Article first

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176. See Comment Letters, *supra* note 42, Letter No. 21, Exhibit at 41; S. Rep. 305, *supra* note 11, at 12.

177. See, e.g., *New Era Publications Int'l v. Henry Holt & Co.*, 873 F.2d 576, 584-85 (2d Cir. 1989) (denying injunction because plaintiff's delay in bringing action until after substantial resources invested in publication of book containing protected material); *Abend v. MCA, Inc.*, 863 F.2d 1465, 1478-80 (9th Cir. 1988) (denying injunction prohibiting future use of movie incorporating plaintiff's work because of impossibility of separating plaintiff's work from the film and the public's interest in viewing classic film), cert. granted, 493 U.S. 807 (1989); *Broadcast Music, Inc. v. Fox Amusement Co.*, 551 F. Supp. 104, 110 (N.D. Ill. 1982) (denying injunctive relief when future possible violation of nonpayment of copyright fees was speculative). See also 3 M. Nimmer, *supra* note 167, § 14.06(B) at 14-56 ("where great public injury would be worked by an injunction, the courts might . . . award damages or a continuing royalty instead of an injunction in such special circumstances").

At times, members of the Supreme Court have indicated that relief other than an injunction may be more appropriate in some copyright infringement cases. See, e.g., *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 499-500 (1984) (Blackmun, J., dissenting) (approving circuit court's suggestion that in the case of continuing copyright infringement, damages or continuing royalty may be appropriate remedy).

For cases denying preliminary injunctions, see *Apple Barrel Prods., Inc. v. Beard*, 730 F.2d 384, 390 (5th Cir. 1984) (denying preliminary injunction because defendant would have no remedy if later found not to have infringed copyright); *Universal City Studios, Inc. v. T-Shirt Gallery, Ltd.*, 634 F. Supp. 1468, 1480 (S.D.N.Y. 1986) (denying preliminary injunction because of failure to demonstrate irreparable injury, probable success, or the balance of hardships in their favor); *Farmers Indep. Tel. Co. v. Thorman*, 648 F. Supp. 457, 458-59 (W.D. Wis. 1986) (denying preliminary injunction because defendant would be more harmed than plaintiff).

178. See, e.g., *Abend*, 863 F.2d at 1478-80 (request for injunction prohibiting future use of movie incorporating plaintiff's work denied, author left to damages remedy).

179. See *infra* notes 38-41 and accompanying text for a discussion of the indirect methods by which authors could have attempted to force states to comply with the 1976 Act before the

examines the general purposes of copyright law in order to determine whether a remedy for monetary damages against unauthorized state use is necessary to achieve these goals.<sup>180</sup> Second, it examines whether such a remedy should be provided under state or federal law and whether it should be enforceable in state or federal court. The conclusion of this inquiry is that copyrights serve significant purposes which are undercut by unauthorized state use of copyrighted works and that the need for national uniformity requires that the remedy be enforceable in federal court under federal law.

## A. Foundations of Copyright Law

### 1. Background

The principal justification for copyright protection in American law is the assertion that copyrights encourage authors to produce intellectual properties, works which are of high value to society.<sup>181</sup> The copyright, which provides the author with a series of exclusive rights, provides incentive to produce these works by enabling authors, first, to charge for the use of their works<sup>182</sup> and, second, to limit the circumstances in which their works will be used.<sup>183</sup> These rights provide copyright holders with economic benefits and integrity benefits. The economic benefits are monetary rewards; the integrity benefits are nonmonetary rewards such as personal pride, self-esteem, reputation, self-fulfillment, and self-expression. These economic and integrity benefits can be of sufficient value to induce potential authors to forego other remunerative activities in order to produce intellectual properties. Without these incentives, it is argued, authors will not create intellectual properties in the numbers desired by

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adoption of the Clarification amendment.

180. State use of copyrighted materials may raise additional problems that are beyond the scope of this article. For example, state use of copyrighted material might violate the fourteenth amendment of the U.S. Constitution which prevents states from taking private property without compensation. U.S. Const. amend. XIV, § 1. *See* *Roth v. Pritikin*, 710 F.2d 934, 939 (2d Cir.), cert. denied, 464 U.S. 961 (1983) ("An interest in a copyright is a property right protected by the due process and just compensation clauses of the Constitution."); *Mihalek Corp. v. Michigan*, 595 F. Supp. 903, 908 (E.D. Mich. 1984), *aff'd* on other grounds, 814 F.2d 290 (6th Cir. 1987) (plaintiffs' claim that the state's actions constituted a "taking" of their property in violation of the fifth and fourteenth amendments rejected on the ground that state immunity under eleventh amendment barred liability for damages); S. Rep. No. 1877, 86th Cong., 2d Sess. (1960) ("When the [U.S.] Government deliberately publishes a copyrighted article without obtaining the prior consent of the copyright proprietor, the general assumption would be that the holder, pursuant to the principles of . . . our Constitution, should be entitled to an action against the Government for infringement.") (reprinted in 1960 U.S. Code Cong. & Admin. News 3445). *See also* *Hercules, Inc. v. Minnesota State Highway Dep't*, 337 F. Supp. 795, 798 (D. Minn. 1972) (use of patent invention by the government is a violation of the takings clause).

181. *See* *The Federalist Papers*, *supra* note 153, at 279 n.43 (copyrights necessary to promote production of literary works); Chafee, *Reflections on the Law of Copyright*, 45 *Colum. L. Rev.* 503, 506-11 (1945) (same); Ladd, *The Harm of the Concept of Harm in Copyright*, 30 *J. Copyright Soc'y U.S.A.* 421, 424 (1983) (same).

182. 17 U.S.C. § 106 (1988).

183. *Id.*



society.<sup>184</sup>

The notion that the cluster of legal rights called copyrights should be recognized because they provide incentives to produce socially desirable works finds its origin in the writings of utilitarian theorists. These theorists argue that legal rules recognizing property rights are justifiable only because of the social benefits which the rules produce.<sup>185</sup> Under this view, the legal rules vesting property interests in the creators of intellectual properties lead to the production of works that benefit society.

Among the most significant benefits authors gain from copyrights are the monetary rewards that accrue because authors have legal remedies which allow them to restrict the use of their works.<sup>186</sup> Authors cannot physically prevent others from using their works. For example, absent a legal remedy, an author of a poem, song, or play cannot prevent another from committing that work to memory and performing or otherwise using the work without paying the author.<sup>187</sup> Armed with copyrights, authors can compel others to pay for the use of their works and, through the aggregate charges, recover not only the cost of production but whatever additional return is necessary to produce the economic incentive to create.

184. Hettinger, *Justifying Intellectual Property*, *Phil. & Pub. Aff.* 31, 35-36 (Winter 1988).

185. Utilitarians argue that without the protection provided by property rules, individuals cannot be certain that they will be permitted to enjoy a substantial share of the products of their labor. According to rule utilitarian theory, if the owner of the property rights is given the capacity to control how a particular resource will be used, when the resource will be used, who may use the resource, and to whom this authority may be transferred, individuals will labor diligently and invest freely in the development of resources. Utilitarian theory finds its modern origins in the writings of, *inter alia*, David Hume and Jeremy Bentham, and has been developed in the recent writings of the law and economics movement. J. Bentham, *Theory of Legislation* chs. 7-10 (6th ed. 1890); D. Hume, *A Treatise of Human Nature*, bk. III, pt. II, §§ 2-4, at 436-59 (1961); R. Posner, *Economic Analysis of Law*, 29-39 (1986). *See generally* L. Becker, *Property Rights: Philosophic Foundations* 57-74 (1977). The argument applies easily to copyrightable works. If authors are given the capacity to control the distribution, reproduction, and use of their works, they will be able to recover benefits which in turn will provide strong incentives to create. Hettinger, *supra* note 184, at 47-48.

186. Although the economic incentive behind the grant has been long recognized in copyright law, the literature applying economic analysis to copyright law has been quite limited. Some of the more important contributions in this area are: T. Macaulay, *Speeches on Copyright* (C. Gaston ed. 1914); Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 *Harv. L. Rev.* 281 (1970); Hurt & Suchman, *The Economic Rationale of Copyright*, 56 *Am. Econ. Rev.* (1966); Landes & Posner, *An Economic Analysis of Copyright Law*, 18 *J. Legal Stud.* 325 (1989); Novos & Waldman, *The Effects of Increased Copyright Protection: An Analytical Approach*, 92 *J. Pol. Econ.* 236 (1984); O'Hare, *Copyright: When is Monopoly Efficient?*, 4 *Pol'y Analysis & Mgmt.* 407 (1985); Plant, *The Economic Aspect of Copyright in Books*, 1 *Economica* 167 (1934).

187. Most resources cannot be used by an unlimited number of people without being diminished. For example, a tree cannot be cut down and used for furniture by one person without limiting the capacity of others to use that tree. Intellectual properties, such as copyrights, are unique in that they are not diminished if used by more than a single user. If someone copies or performs a play, it does not diminish the capacity of others to perform or copy that same play. Goods, such as intellectual properties, that are not diminished by use are called "public goods." A. Alchian & W. Allen, *Exchange and Production Theory in Use* 251-53 (1969). The implications for this in a property regime is that if society wants to encourage the production of public goods, it must provide potential creators of these goods with the mechanism to exclude others from their use. *Id.*

Contracts of sale, in which authors reveal previously undistributed works, do not provide sufficient protection for authors because contract remedies are available only against those individuals who are in privity of contract.<sup>188</sup> Therefore, under contract law, authors are able to secure payment only from a limited group of users. Most authors cannot recoup the entire costs of production from the initial users of their works because these costs are generally too large to be borne by those limited groups. The costs can be recovered only if authors receive remuneration from further distribution of their works. Copyrights provide the mechanism by which these additional payments can be assured.<sup>189</sup>

The copyright clause itself emphasizes that American copyright law is founded upon a theory of incentive. The constitutional grant authorizes the creation of copyright rights to "promote the Progress of Science and useful Arts."<sup>190</sup> This function is also prominently emphasized in Supreme Court decisions as well as the congressional reports accompanying the adoption of federal copyright statutes.<sup>191</sup>

In addition to the economic benefits, an author may obtain a variety of other benefits which may be labeled integrity benefits. The term "integrity benefits" refers to various personal rewards that flow from the ability of authors to restrict the use of their works. They include enhanced reputation and self-esteem, privacy interests, and a means to self-definition. For example, authors who have written highly personal works can utilize copyrights to limit the use and distribution of their works.<sup>192</sup> Similarly, professors can use copyrights to maintain or establish professional reputations by licensing their works under circumstances that ensure publication will take place only under their names and that limit alterations of the

188. J. Calamari & J. Perillo, *Contracts* § 17-1, at 691 (3d ed. 1987).

189. Copyrights may not always be necessary to recover costs. In some instances, a contract between the author and the user will provide a sufficient economic return, e.g., some original paintings. *See generally*, Landes & Posner, *supra* note 186.

190. U.S. Const. art. I, § 8, cl.8.

191. As the Supreme Court stated in *Sony Corporation v. Universal City Studios*:

[T]he monopoly privileges that Congress may authorize are neither unlimited nor primarily designed to provide a special private benefit. Rather, the limited grant is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.

*Mazer v. Stein*, 347 U.S. 201, 219 (1954) (Copyright law is "intended definitely to grant valuable enforceable right to authors, publishers, etc. . . 'to afford greater encouragement to the production of literary [or artistic] works of lasting benefit to the world.'" (quoting *Washington Pub. Co. v. Pearson*, 306 U.S. 30, 36 (1936)); H.R. Rep. No. 2222, 60th Cong., 2d Sess. 7 (1909).

192. *See Newman*, *Copyright Law and the Protection of Privacy*, 12 *Colum. J.L. & Arts* 459 (1988) (discussing how privacy is protected by copyright law). *But see Leval*, 36 *J. Copyright Soc'y U.S.A.* 167, 178-79 (1989) (asserting that privacy issues have no place in copyright law). To be sure, American copyrights provide only limited protection for an author's privacy, because the copyright monopoly is not absolute. For example, the fair use doctrine might permit the use of a highly personal work. *See, e.g., Maxtone-Graham v. Burtchaeil*, 803 F.2d 1253, 1260 (2d Cir. 1986) (portions of accounts of unwanted pregnancies could be copied under fair use doctrine).

works.<sup>193</sup> Although American copyright law provides authors with legal remedies that produce these integrity benefits, protection of integrity benefits as an end in itself has not played a major role in development of federal copyright legislation to date.<sup>194</sup> These indirect benefits, however, provide significant incentives for authors.<sup>195</sup>

## 2. *As Applied to Unauthorized State Use*

The economic and integrity benefits of copyrights are as necessary to encourage creation of copyrightable works intended specifically for state use as they are for any other type of work. As noted above, states are extensive users of copyrighted materials, including a significant number of works created only for use by states.<sup>196</sup> The costs of producing textbooks

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193. The integrity benefits discussed here are linked, though somewhat different from, the concerns giving rise to personal and labor theories of property. Labor and personality theorists justify property rights without regard to the consequences for society as a whole. American copyright law is utilitarian. It provides for copyrights only if they create incentives. Leval, *supra* note 192, at 170.

Labor theory of property argues that property rights arise and vest in those individuals who create resources, because they have merged their efforts or energy with the natural elements to produce a resource. Labor theory of property was developed in the writings of John Locke. *See* J. Locke, *The Second Treatise of Government* ("Of Civil Government") ch. 5 (Peardon ed. 1952). It is also seen in the writings of Blackstone and Spencer. *See* 2 W. Blackstone, *Commentaries* 115-16 (Ehrlich ed. 1959); 2 H. Spencer, *The Principles of Ethics* 108-09 (1908).

Personality theory, grounded on notions of justice, builds upon the writings of labor theorists and emphasizes the role of property rights in an individual's realization of self, of human personality. Personality theory finds its development in the writings of, *inter alia*, George Hegel and, more recently, Professor Margaret Radin. G. Hegel, *Philosophy of Right* 41-52 (T. Knox trans. 1967); Radin, *Property and Personhood*, 34 *Stan. L. Rev.* 957, 959 (1982).

194. Until recently, federal copyright law did not include any remedies specifically tailored to provide authors with integrity rights. In 1990, however, Congress amended the 1976 Act to provide moral rights protection for authors who create visual arts. Pub. L. No. 533, 104 Stat. 2749 (codified at 17 U.S.C. §§ 501, 511). These rights are limited in scope and applicability. The limited nature of these rights stems from the widely held view in the U.S. that copyright law should not be tailored to protect these rights. The notion of protecting integrity rights has had a favorable reception in other nations. *See generally*, Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors, and Creators*, 53 *Harv. L. Rev.* 554, 559 (1940); Sarraute, *Current Theory on the Moral Right of Authors and Artists Under French Law*, 16 *Am. J. Comp. L.* 465 (1968); Note, *An Author's Artistic Reputation Under the Copyright Act of 1976*, 92 *Harv. L. Rev.* 1490, 1493 (1979) (arguing that 1976 Act permits author to use economic safeguards to protect the integrity of a work, thus protecting the author's reputation).

Some argue that integrity rights cannot and should not provide a theoretical foundation upon which to base federal copyright remedies. *See, e.g.*, Merryman, *The Refrigerator of Bernard Buffet*, 27 *Hastings L.J.* 1023, 1035-36 (1976); Monta, *The Concept of "Copyright" Versus the "Droit d'Auteur"*, 32 *S. Cal. L. Rev.* 177, 185 (1959). Other commentators, including the Register of Copyrights, argue for the recognition of this personal interest. *See* House Comm. on the Judiciary, 87th Cong., 1st Sess., *Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* 5-6 (Comm. Print 1961); Chafee, *supra* note 181, at 506-07.

195. Koeberke, *Play it Again Samantha? Another Argument for U.S. Adherence to Article 6bis of the Berne Convention*, 27 *Duq. L. Rev.* 609 (1989).

196. *See supra* note 42-54 and accompanying text.

written for public schools, computer programs intended to facilitate the enforcement of parking violations, and manuals to be distributed to state troopers need to be recovered just as much as the costs of producing similar goods for the private sector. While it is critical that states pay for materials made for their use alone, the need to recover monies from states is substantial even when works have not been produced solely for state use. Payments by states help to satisfy the aggregate amount necessary to provide the incentive to create. Unless authors can be certain that they will receive these funds, they will not produce the works used by states in sufficient numbers to meet society's needs.<sup>197</sup>

Other mechanisms occasionally will produce payments by states. For example, contract remedies and the desires of state agencies to maintain continuing relationships with authors will, in many instances, ensure payments. Unfortunately, these alternatives are inadequate to maximize production of copyrightable works. Contract remedies are inadequate because contracts only bind the original purchaser or someone in privacy with the original purchaser. The desire of a state to have future contacts with an author is an effective incentive only if the author is irreplaceable or otherwise in a strong bargaining position. That is not the case with most authors. In most circumstances, a state can simply use another author's works. Copyrights are the necessary legal rules to achieve the desired economic return.<sup>198</sup>

Similarly, integrity benefits are important to authors of works created for state use. Unacceptable alterations or unauthorized use of a work by a state is just as harmful to an author's interests as when private parties make unauthorized use of copyrighted works. Indeed, for some authors, unauthorized use by a state may be even more objectionable. Thus, authors must be given legal remedies to enable them to charge states for the use of their works.

### *B. State Law or Federal Law; State Forum or Federal Forum*

While the discussion above indicates that a remedy should be provided to authors whose works are used by states without authorization, it is not ineluctable that such a remedy be provided solely under federal law or in the federal courts. An analysis of the relevant issues, however, indicates that a federal remedy, enforceable in federal courts, is the better alternative.

A uniform and unitary system of copyright law is one of the essential components of our national copyright law. Indeed, the need for uniformity was one of the major reasons for inclusion of the copyright clause in the

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197. See Comment Letters, *supra* note 42, Letter No. 6 (copyrights necessary to recover cost of producing works for states)

198. In some instances, contract remedies or the desire to have a continuing relationship with an author will be sufficient to insure a state's recognition of an author's rights. This will be true especially when the author has produced a work for use principally by that state. These incentives may not, however, be sufficient to discourage another state from using the work without permission.

Constitution.<sup>199</sup> A system in which state laws covered state government use of copyrighted works would be wholly inconsistent with this scheme. Considerable confusion would result because states would be subject to different rules than other copyright users.<sup>200</sup> Furthermore, as discussed below, the federal copyright statute provides a limited means by which state use can be controlled.<sup>201</sup> If state law regulated some state activities while federal law regulated others, even more confusion would result. For example, combination citizen and state suits for injunctive relief in federal courts could produce standards of state liability different than combination citizen and state suits for monetary relief in state court.

For similar reasons, enforcement of federal copyright law in federal courts presents a better alternative. Congress granted the federal courts exclusive jurisdiction over copyright actions in 1831, long before most federal cases could be brought in federal court.<sup>202</sup> This long tradition has produced a uniformity in copyright law which enables copyright holders and users of copyrighted works to easily comprehend the scope of the copyright monopoly.<sup>203</sup> Concurrent jurisdiction could produce conflicting and undesirable results.<sup>204</sup> Exclusive jurisdiction in copyright cases produces uniformity in the substantive law. Therefore, because the eleventh amendment does not bar enforcement of copyright remedies for monetary

199. For a discussion of the origins of the copyright clause, see *supra* notes 153-58 and accompanying text.

Until the adoption of the 1976 Act, a dual system of copyright covered unpublished works and published works. H.R. Rep. No. 1476, 94th Cong., 2d Sess. 129 (1976) (reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5745). The systems did not, however, overlap. State law covered works prior to publication and federal law covered works after publication. See *supra* note 24 (describing publication under the 1909 Act). Thus, the two separate systems of copyright law did not overlap coverage for any single copyrightable work. This dual system of federal and state law was almost entirely abolished by the 1976 Act because Congress felt it prevented the accomplishment of "the basic constitutional aims of uniformity and the promotion of writing and scholarships." H.R. Rep. No. 1476, *supra*, at 129. See also Brown, *Unification: A Cheerful Requiem for Common Law Copyright*, 24 UCLA L. Rev. 1070 (1977) (discussing unification of copyright law); Note, *Copyright Preemption: Effecting the Analysis Prescribed by Section 301*, 24 B.C.L. Rev. 963, 972-80 (1983) (same).

200. Assuming, of course, they waived their sovereign immunity.

201. See *infra* notes 37-40 and accompanying text.

202. Act of Feb. 3, 1831, ch. 16, § 9, 4 Stat. 436, 438. Congress did not grant the federal courts general federal question jurisdiction until 1875. Act of Mar. 3, 1875, ch. 137, § 1, 18 Stat. 470. There had been a short-lived grant in the Midnight Judges Act of 1801, ch. 4, § 11, 2 Stat. 89, 92, but this was promptly withdrawn. Act of Mar. 8, 1802, ch. 8, § 1, 2 Stat. 132, 132. In 1831, the only federal question cases that could be brought in federal court were admiralty cases, minor criminal cases, patent and copyright suits, and cases involving the Bank of the United States. A. Conkling, *Treatise on the Organization, Jurisdiction and Practice of the Courts of the United States* 92-93 (1830 & photo reprint 1985).

203. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162-63 (1989) (exclusive jurisdiction of federal courts over federal intellectual property law produces development of uniform body of law).

204. Compare *Interpart Corp. v. Italia*, 777 F.2d 678, 684-85 (Fed. Cir. 1985) (holding California's "direct molding process" statute, Cal. Bus. & Prof. Code § 17300 (West Supp. 1985), not preempted by federal intellectual property laws) with *Bonito Boats*, 515 So. 2d 220, 223 (Fla. 1987) (holding Florida's "direct molding process" statute, Fla. Stat. § 559.94 (1985) preempted), *aff'd*, 489 U.S. 141, 143.

damages against states, the remedy should be made available in federal courts.<sup>205</sup>

#### IV. CONCLUSION

It is thus clear that the Clarification amendment was a necessary and lawful exercise of congressional authority. It achieves important copyright objectives and is not prohibited by the eleventh amendment.

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205. Of course, if it is determined that such a remedy could not be enforced in federal courts, a remedy that could be enforced in state court should be adopted. *See* Field, Part One, *supra* note 80, at 546-49 (discussing ability of Congress to create remedies enforceable against states in state court and concluding that neither the eleventh amendment nor other federalism notions would prevent it); Fletcher, *supra* note 102, at 1094-98 (same); *Howlett v. Rose*, 110 S.Ct. 2430, 2434-42 (1990) (state may not defeat federal claim in state court with a sovereign immunity defense).

