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Florida Prepaid Post-Secondary Educ. Expense Bd. v. College Sav. Bank and the United States of America, 119 S. Ct. 2199 (1999)

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FLORIDA PREPAID POST-SECONDARY EDUC. EXPENSE BD. V. COLLEGE SAV. BANK AND THE UNITED STATES OF AMERICA, 119 S. CT. 2199 (1999)

I. INTRODUCTION

By striking down the Patent Remedy Act¹ (“PRA”) as an unconstitutional abrogation of states’ rights by Congress, the Supreme Court has severely limited Congress’s power to enforce the Fourteenth Amendment due process clause.² The Court has required that all future legislation be remedial, as opposed to preventive. Thus, the Court has chosen to bolster states’ rights to sovereign immunity under the Eleventh Amendment³ at the expense of individuals’ property rights and their right to due process under the Fourteenth Amendment. The holding in *Florida Prepaid Post-Secondary Educ. Expense Bd. v. College Sav. Bank*⁴ (“FPP”) will have long-reaching effects on individuals’ property rights and their right to due process. Not only does the Court fail to pay any deference to Congress, but it also sets forth a new requirement that Congress identify a “pattern” of constitutional violations before it may enact appropriate legislation pursuant to its Fourteenth Amendment enforcement powers. After *FPP*, patent owners may have their patents infringed by States without any due process.⁵ No patent owner can sue a state in federal court without the state’s express consent.⁶ For those states that do provide state remedies, due process is often found to be merely illusory.⁷

This Note will first summarize the history and identify recent developments in the area of law surrounding Eleventh Amendment sovereign immunity rights of states and the Fourteenth Amendment rights of individuals to due process. It will then discuss the majority and dissenting opinions in *FPP*. Finally, this Note will examine the implications *FPP* will have on

1. Patent Remedy Act, Pub. L. No. 102-560, 106 Stat. 4230 (1994) (codified as amended at 35 U.S.C. § 271(h) (1994)) [hereinafter PRA].

2. U.S. CONST. amend. XIV.

3. U.S. CONST. amend. XI.

4. *Florida Prepaid Post-Secondary Educ. Expense Bd. v. College Sav. Bank*, 119 S. Ct. 2199, 2214 (1999).

5. *Id.*

6. *Id.*

7. *Id.*

Congress's power to enact appropriate legislation under section five of the Fourteenth Amendment. Congress should not be required to identify a pattern of constitutional violations as a prerequisite to enacting appropriate legislation under section five of the Fourteenth Amendment.

II. BACKGROUND (DEVELOPMENT OF LAW)

A. *Sovereign Immunity - Eleventh Amendment*

The Eleventh Amendment states: “[t]he 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.”⁸ In *Hans v. Louisiana*, the Court held that: (1) each state is a Sovereign entity in our federal system; and (2) it is inherent in the nature of sovereignty not to be amenable to the suit of an individual without its consent.⁹ Over the past century, the Supreme Court has continually redefined the scope of Congress's power to limit states' Eleventh Amendment sovereign immunity. The Court often failed to reach a consensus on its interpretation of the Eleventh Amendment.¹⁰ Currently, the Court does acknowledge that: (1) a state may “expressly” waive its Eleventh Amendment sovereign immunity;¹¹ and (2) Congress may in limited situations, after finding a pattern of constitutional violations, enact legislation to abrogate states' sovereign immunity.¹²

B. *Implied Waiver By a State of Its Sovereign Immunity*

In *Parden*, the Court established the “constructive waiver doctrine” holding that by participating in interstate commerce a State constructively waives its sovereign immunity.¹³ However, the “constructive waiver doctrine”

8. U.S. CONST. amend. XI.

9. *Hans v. Louisiana*, 134 U.S. 1 (1890).

10. *See, e.g.*, *Pennsylvania v. Union Gas Co.*, 491 U.S. 1, 3 (1989) (plurality opinion), overruled by *Seminole Tribe of Florida v. Florida*, 517 U.S. 44, 66 (1996) (5-4 decision); *Dellmuth v. Muth*, 491 U.S. 223, 224 (1989) (5-4 decision); *Parden v. Terminal Ry. of Ala. Docks Dep't*, 377 U.S. 184, 198 (1964) (5-4 decision), overruled by *Welch v. Texas Dep't of Highways & Pub. Trans.*, 483 U.S. 468 (1987) (plurality opinion); *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 235 (1985) (5-4 decision).

11. *College Sav. Bank*, 119 S. Ct. 2219, 2226 (1999) (companion case filed on same date). The Court will generally find a waiver if the State makes a “clear declaration” that it intends to submit itself to Federal Jurisdiction. *Id.*

12. *See generally id.*

13. *Parden*, 377 U.S. at 184. The Court permitted employees of a railroad owned and operated by Alabama to bring action under the Federal Employers' Liability Act (“FELA”) against their employer in federal court. Despite the absence of any provision in the statute specifically referring to the States, the Court held the Act authorized suits against States by virtue of a general provision subjecting to suit “every common carrier by railroad . . . engaging in

announced in *Parden* has been expressly overruled by the companion case *Florida Prepaid Post-Secondary Educ. Expense Bd. v. College Sav. Bank* (“*FPP’s Companion Case*”).¹⁴ In *FPP’s Companion Case*, the Court held there was a fundamental difference between a state expressing unequivocally that it waives its sovereign immunity, and Congress expressing its intention that if a state takes certain action it will be deemed to have waived that immunity.¹⁵ After *FPP’s Companion Case*, Congress may not require a state to constructively waive its sovereign immunity merely by participating in regulated activities such as interstate commerce or advertising.¹⁶ But, a State may still voluntarily waive its sovereign immunity by an unequivocal statement of such intent.¹⁷

The four Justice dissent, in *FPP’s Companion Case*, is persuaded that a state, such as Florida, engaged in interstate advertising of its products should be deemed to have waived any defense of sovereign immunity in patent litigation.¹⁸ When a state engages in commercial ventures that fall outside its basic governmental obligation, the dissent believes that Congress must have the power to require the state to waive its immunity to suit in federal court.¹⁹ The dissent asserts that the lack of such authority by Congress would create an enforcement gap, that when combined with the pressures of a competitive marketplace, could put the state’s regulated private competitors at a significant disadvantage.²⁰

commerce . . . between the States,” 45 U.S.C. § 51 (1940). The Court further held that Alabama had waived its immunity despite the fact that Alabama law disavowed any such suit. *Parden*, 377 U.S. at 184.

14. *College Sav. Bank*, 119 S. Ct. at 2228. The Trademark Remedy Clarification Act (TRCA) (*see* 15 U.S.C. § 1125 (1998)) subjects states to suits brought under section 43(a) of the Trademark Act of 1946 for false and misleading advertising. In *FPP’s Companion Case*, petitioner filed suit claiming the respondent violated section 43(a) by misrepresenting its tuition repayment program. Petitioner claimed that Florida waived its immunity by participating in interstate marketing and administration of its program after the TRCA made it clear that such activity would subject it to suit. The Court held a state does not constructively waive sovereign immunity by participating in interstate commerce. *Id.*

15. *Id.*

16. *See generally id.*

17. *Id.* at 2233.

18. *Id.* at 2233-34. Justice Breyer filed a dissenting opinion in which Justices Stevens, Souter, and Ginsburg joined. The Dissent would not abandon the Constructive Waiver Doctrine. If a State engages in activity from which it might readily withdraw, such as federally regulated commercial activity, Congress should have the power to require the State to waive its immunity from suit in federal court. *Id.*

19. *Id.* at 2235. When a State engages in commercial ventures, it acts like a private person, outside the area of its core duties. It is unlikely that these non-core activities will prove essential to the fulfillment of a basic governmental obligation. *Id.*

20. *Id.* at 2235.

C. Congress's Power to Abrogate State Sovereign Immunity

1. Article One "Commerce Clause Power"

In *Pennsylvania v. Union Gas Co.*,²¹ the Court held that Congress had the power to abrogate state sovereign immunity under both its Article One "Commerce Clause" power²² and its enforcement power of the Fourteenth Amendment.²³ In *Union Gas*, a coal plant worker, brought suit against Pennsylvania for a negligent discharge of hazardous waste into the creek, asserting that the state was liable for clean up costs.²⁴ In response, the state claimed that it was immune from liability under the Eleventh Amendment.²⁵ The four Justice plurality reasoned: (1) the rationale of a decision reaching a similar result with regard to legislation under section five of the Constitution's Fourteenth Amendment is equally applicable to the "Commerce Clause," since both constitutional provisions are plenary grants of authority expanding federal power while restricting state power; and (2) to the extent that the states gave Congress the authority to regulate commerce, they relinquished their immunity and consented to suit where Congress finds it necessary.²⁶

However, Congress's expanded authority under its Article One "Commerce Clause" power did not last long. In *Seminole Tribe*, the Court expressly overruled *Union Gas* and held that Congress could not abrogate the sovereign immunity of the states when acting pursuant to its plenary power to regulate commerce under Article One of the Constitution.²⁷ The Court reasoned that it could not interpret its decision in *Fitzpatrick v. Bitzer*²⁸ to

21. 491 U.S. 1 (1989).

22. U.S. CONST. art. I, § 8, cl. 3 ("The Congress shall have the Power . . . to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.").

23. *Union Gas*, 491 U.S. at 1. A four Justice plurality expressed the view that Congress has the authority to render States liable in money damages in federal court when legislating pursuant to the Constitution's commerce clause. *Union Gas*, 491 U.S. at 14.

24. *Union Gas*, 491 U.S. at 3. The coal plant worker brought suit under the Comprehensive Environmental Response, Compensation, and Liability Act of 1980 ("CERCLA") (42 U.S.C. §§ 9604-07 (Law. Co-op. 1980)) and the Super-fund Amendments and Reauthorization Act of 1986 ("SARA") (100 Stat. 1613 (1986)) that imposed liability on site owners and operators for hazardous waste release. Both statutes were enacted by Congress pursuant to its Article One commerce clause power. *Union Gas*, 491 U.S. at 4.

25. *Union Gas*, 491 U.S. at 5.

26. *Id.*

27. *Seminole Tribe*, 517 U.S. at 44. In a five to four decision, the Court held that Congress had no authority to abrogate states' sovereign immunity under its Article One commerce clause power. The Court struck down the Indian Gambling Regulatory Act ("IGRA") (18 U.S.C. § 2701 (1988)) which Congress enacted pursuant to its authority under the Indian Commerce Clause. The IGRA gave Indian Tribes the power to sue states in federal courts. *Id.*

28. 427 U.S. 445 (1976).

justify limiting state immunity under provisions such as the Commerce Clause that pre-dated the ratification of the Eleventh Amendment.²⁹

2. Due Process Clause of the Fourteenth Amendment

The Fourteenth Amendment provides in relevant part: “[s]ection 1. . . 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.”; “[s]ection 5. . . The Congress shall have power to enforce, by appropriate legislation, the provisions of this article.”³⁰

In *Fitzpatrick*,³¹ the Court held that section five of the Fourteenth Amendment empowered Congress to enforce the amendment by appropriate legislation, including the power to abrogate states’ Eleventh Amendment sovereign immunity.³² The Court reasoned that the prohibitions of the Fourteenth Amendment are directed at the states, thereby expanding federal authority while limiting states’ powers.³³

Several cases between 1985 and 1990 placed an additional requirement on Congress to express unequivocally its intention to abrogate sovereign immunity when enacting legislation pursuant to its authority under the Fourteenth Amendment.³⁴ In *Chew v. California*, an inventor from Ohio attempted to sue California for patent infringement.³⁵ Applying the Courts decision in *Scanlon*,³⁶ the Federal Circuit in *Chew* held that federal patent laws failed to contain the requisite statement of unmistakably clear intent required to abrogate state sovereign immunity in infringement suits.³⁷

29. *Id.* See also Kristen Healey, *Comment: The Scope of Eleventh Amendment Immunity from Suits Arising Under Patent Law After Seminole Tribe v. Florida*, 47 AM. U. L. REV. 1735, 1751-52 (1998).

30. U.S. CONST. amend. XIV.

31. 427 U.S. 445 (1976).

32. *Id.* A class action suit was brought on behalf of all present and retired males in the state of Connecticut, claiming discrimination in the state’s retirement benefit plan. The suit claimed the discriminatory retirement plan was in violation of the 1972 Amendments to Title VII of the Civil Rights Act of 1964. The Court held that Congress did possess authority pursuant to the Fourteenth Amendment to subject states to suit in federal court. *Id.*

33. *Id.*

34. See generally *Chew v. California*, 893 F.2d 331 (Fed. Cir. 1990); *Scanlon*, 473 U.S. at 244-43; *Dellmuth*, 492 U.S. at 223.

35. *Chew*, 892 F.2d at 332-33. See generally 35 U.S.C. §§ 1 – 296 (1994) (dealing with the patent laws).

36. 473 U.S. at 243-244 (holding that “Congress must express its intention to abrogate the Eleventh Amendment in unmistakable language in the statute itself”).

37. *Chew*, 892 F.2d at 334. The Court required Congress to express its intention to abrogate sovereign immunity in unmistakably clear language in the statute itself. *Id.*

D. Federal Statute – Patent Remedy Act (PRA)

In response to *Chew*, Congress amended the patent laws to express its “unmistakably clear” intent to abrogate the sovereign immunity of the states.³⁸ Section 271(h) of the PRA now states: “[a]s used in this section, the term ‘whoever’ includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity.”³⁹ Section 296(a) addresses the sovereign immunity issue even more specifically: “[a]ny State, any instrumentality of a State, and any officer or executive of a State or instrumentality of a State acting in his official capacity, shall not be immune, under the Eleventh Amendment of the Constitution . . . , from suit in federal court.”⁴⁰

III. FLORIDA PREPAID POST-SECONDARY EDUC. EXPENSE BD. V. COLLEGE SAV. BANK

A. Summary Of Facts

College Savings Bank (“CSB”) is a New Jersey chartered savings bank located in Princeton, New Jersey.⁴¹ Since 1987, CSB has sold certificates of deposit contracts known as College Sure® CDs.⁴² The purpose of the College Sure® CD is to help individuals save money for the unknown cost of college education expenses.⁴³ CSB guarantees returns sufficient to fund the uncertain future cost of education.⁴⁴ The College Sure® CD is administered using an apparatus and methods disclosed in College Savings’ U.S. Patent No. 4,722,055, entitled “Method and Apparatus for funding Liability of Uncertain Costs.”⁴⁵

The Florida Prepaid Post-Secondary Education Expense Board (“Florida Board”), a corporate body of the State of Florida, administers a similar investment program aimed at aiding individuals fund the cost of Florida public colleges and universities.⁴⁶ CSB claims that the Florida Board directly and indirectly infringed on CSB’s patent.⁴⁷

38. See *College Sav. Bank*, 119 S. Ct. at 2203.

39. 35 U.S.C. § 271(h) (1994).

40. 35 U.S.C. § 296(a) (1994).

41. *College Sav. Bank v. Florida Prepaid Post-Secondary Educ. Expense Bd.*, 948 F. Supp. 400, 401 (D.N.J. 1996).

42. *Id.*

43. *Id.*

44. *Id.*

45. *Id.*

46. *College Sav. Bank*, 948 F. Supp. at 401.

47. *Id.*

CSB brought an infringement action against the Florida Board in United States District Court for the District of New Jersey pursuant to the PRA,⁴⁸ which explicitly provides that states may be sued for patent infringement in the federal courts.⁴⁹ The Florida Board moved to dismiss CSB's claim as barred by Eleventh Amendment state sovereign immunity.⁵⁰ The Florida Board asserted that the PRA was an unconstitutional attempt by congress to use its Article One powers, under the Patent Clause,⁵¹ to abrogate state sovereign immunity and to expand the federal courts' Article III jurisdiction.⁵² CSB argued that the PRA was properly enacted by Congress pursuant to its enforcement power under section five of the Fourteenth Amendment.⁵³ The United States intervened as of right,⁵⁴ to defend the constitutionality of the PRA.

B. District Court Opinion

The District Court upheld the PRA, stating it was a valid exercise of congressional power under the Fourteenth Amendment to abrogate state sovereign immunity.⁵⁵ In addition, the District Court held that: (1) the Florida Board did not waive its Eleventh Amendment immunity by engaging in interstate marketing and administration of its investment contracts; and (2) Congress could not abrogate state sovereign immunity on Lanham Act claims.⁵⁶

The District Court reasoned Congress met both the requirements set forth in *Seminole Tribe*,⁵⁷ first, Congress has unequivocally expressed its intent to abrogate immunity; and second, Congress had acted pursuant to a valid exercise of power.⁵⁸ The court found that Congress had revised the PRA to make its intention to abrogate states' sovereign immunity unmistakably clear, and that the Fourteenth Amendment authorized Congress to protect against state infringement of patent rights without due process.⁵⁹

48. 35 U.S.C. §§ 271(h), 296 (1994).

49. *College Sav. Bank v. Florida Prepaid Post-Secondary Educ. Expense Bd.*, 148 F.3d 1343, 1346 (Fed. Cir. 1998).

50. *Id.*

51. U.S. CONST. art. I, § 8, cl. 8.

52. *College Sav. Bank*, 148 F.3d at 1346. *See also* U.S. CONST. art. III.

53. *Id.*

54. *See* 28 U.S.C. § 2403(a) (1994).

55. *College Sav. Bank*, 148 F.3d at 1346.

56. *Id.*

57. 116 S. Ct. at 1123.

58. *College Sav. Bank*, 948 F. Supp. at 420.

59. *Id.* at 421-22.

C. Federal Circuit Court Opinion

The Federal Circuit Court affirmed the District Court's decision denying the Florida Board's motion to dismiss the claim as barred by the Eleventh Amendment.⁶⁰ The Circuit Court held that Congress unmistakably expressed its intent to abrogate state sovereign immunity for patent infringement suits brought in the federal court pursuant to its authority under section five of the Fourteenth Amendment.⁶¹ The Circuit Court did not address CSB's arguments that the Florida Board waived its sovereign immunity either by failing to raise the sovereign immunity defense earlier in litigation or by participating in the patent system.⁶²

The Circuit Court reasoned that patents are property subject to the protections of the Due Process Clause and Congress's objective in enacting the PRA was permissible because it sought to prevent states from depriving patent owners of property without due process.⁶³ Affirming the District Court, the Circuit Court held Congress may abrogate a state's sovereign immunity under the Eleventh Amendment, only when Congress has both unequivocally expressed its intent to abrogate immunity, and acted pursuant to a valid exercise of authority.⁶⁴ Congress had revised the statutory language of the PRA, in response to the Circuit Court's decision in *Chew*,⁶⁵ to unequivocally express its intent to abrogate state sovereign immunity.⁶⁶

In determining that Congress did have the power to abrogate states' sovereign immunity, the Circuit Court cited both *Seminole Tribe*⁶⁷ and *Fitzpatrick*,⁶⁸ stating that the Fourteenth Amendment "fundamentally altered the balance of state and federal power struck by the Constitution."⁶⁹ Section five of the Fourteenth Amendment grants Congress the power to enforce the prohibitions of section one "by appropriate legislation."⁷⁰ Congress may use any rational means to effectuate the substantive provisions of the amendments.⁷¹

60. See *College Sav. Bank*, 148 F.3d at 1346.

61. *Id.* at 1346.

62. *Id.* at 1345.

63. *Id.* at 1349-50.

64. See *Seminole Tribe*, 517 U.S. at 55.

65. 893 F.2d at 331.

66. See *College Sav. Bank*, 148 F.3d at 1347. See also 35 U.S.C. §§ 271(h), 296 (1994).

67. 517 U.S. at 59.

68. 427 U.S. at 455.

69. See *College Sav. Bank*, 148 F.3d at 1348.

70. U.S. CONST. amend. XIV.

71. See *College Sav. Bank*, 148 F.3d at 1348.

The Circuit Court also required a showing of proportionality between the injury to be prevented or remedied and the means adopted to that end.⁷² State patent infringement causes considerable harm to the patentee and to the patent system as a whole.⁷³ Abrogation of state sovereign immunity, however, subjects states to no greater burdens than those that must be endured by private parties.⁷⁴ Therefore, the PRA was found to meet the required congruence between the harm to be prevented and the means selected to accomplish those ends.⁷⁵

IV. ANALYSIS

A. *Majority Opinion*

Chief Justice Rehnquist announced the judgment of the Court and delivered an opinion joined by Justices O'Connor, Scalia, Kennedy, and Thomas.⁷⁶ The United States Supreme Court reversed the decision of the Circuit Court, thereby holding that Congress's abrogation of states' sovereign immunity through the PRA is unconstitutional and invalid.⁷⁷ The PRA can not be sustained as legislation enacted to enforce the guarantees of the Fourteenth Amendment's Due Process Clause.⁷⁸

1. Eleventh Amendment - States Right to Sovereign Immunity

The Eleventh Amendment provides: "[t]he 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."⁷⁹ The Court interpreted the Eleventh Amendment as early as the 1890's to mean that each state is a sovereign entity in our federal system, and "it is inherent in the nature of sovereignty not to be amenable to the suit of an individual without its consent."⁸⁰

In determining if Congress validly enacted the PRA to abrogate states' sovereign immunity, the Court agrees with the two requirements set forth by the Circuit Court.⁸¹ First, whether congress has unequivocally expressed its

72. *Id.* at 1353. The circuit court held that if the means and ends lacked proportionality, then the legislation may become substantive in operation and effect. *Id.*

73. *Id.* at 1354.

74. *Id.* at 1355.

75. *Id.*

76. *See College Sav. Bank*, 119 S. Ct. at 2201.

77. *Id.* at 2202.

78. *Id.*

79. U.S. CONST. amend. XI.

80. *See Hans*, 134 U.S. at 13.

81. *See College Sav. Bank*, 119 S. Ct. at 2205.

intent to abrogate the immunity; and second, whether Congress has acted pursuant to a valid exercise of power.⁸² The Court agreed with the findings of the Circuit Court in that Congress had made its intention to abrogate state sovereign immunity via the PRA unmistakably clear.⁸³ The PRA provides “any state. . .shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of Sovereign immunity, from suit in federal court. . .for infringement of a patent.”⁸⁴

The Court then turns to the question of whether Congress has the power to compel a State to surrender its sovereign immunity. Congress asserted it had the power to enact the PRA pursuant to three sources of constitutional authority: the Patent Clause,⁸⁵ the Interstate Commerce Clause,⁸⁶ and section five of the Fourteenth Amendment.⁸⁷

2. U.S. Const. Article One: The Patent Clause and the Interstate Commerce Clause

The Court, in *Seminole Tribe*, held that Congress may not abrogate state sovereign immunity pursuant to its Article One powers.⁸⁸ Therefore, the PRA can not be sustained as a valid abrogation under either the Interstate Commerce Clause or the Patent Clause.⁸⁹

3. The Fourteenth Amendment Due Process

Congress retains the authority to abrogate state sovereign immunity pursuant to the Fourteenth Amendment.⁹⁰ But the legislation must be “appropriate” under section five of the Fourteenth Amendment.⁹¹ Appropriate legislation requires that there be a congruence and proportionality between the injury to be prevented and the means adopted to that end.⁹² For Congress to invoke section five, it must identify conduct transgressing the Fourteenth Amendment’s substantive provisions, and must tailor its legislation to remedy such conduct.⁹³

82. *Id.* (citing *Seminole Tribe*, 517 U.S. at 55).

83. *Id.* The Court stated Congress’s intent could not be any clearer.

84. 35 U.S.C. § 296(a) (1994).

85. U.S. CONST. art. I, § 8, cl. 8.

86. U.S. CONST. art. I, § 8, cl. 3.

87. *See College Sav. Bank*, 119 S. Ct. at 2205.

88. *See Seminole Tribe*, 517 US at 72-73.

89. *Id.*

90. *See College Sav. Bank*, 119 S. Ct. at 2205.

91. *City of Borne v. Flores*, 521 U.S. 507, 518-19 (1997) (the Court emphasized that Congress’ enforcement power is remedial in nature, but that legislation may be constitutional even though it intrudes into legislative spheres of authority previously reserved for the states).

92. *See College Sav. Bank*, 119 S. Ct. at 2207.

93. *Id.*

The underlying conduct at issue here is state infringement of patents and the use of sovereign immunity by states to deny patent owners a remedy for the infringement of their patent rights.⁹⁴ The conduct of unremedied patent infringement by states must give rise to the Fourteenth Amendment violation that Congress sought to remedy in the PRA.⁹⁵

In enacting the PRA, Congress failed to identify any pattern of patent infringement by states.⁹⁶ The House Report identified only two examples of patent suits against states, and the Circuit Court identified only eight patent-infringement suits prosecuted against the states in the past 110 years.⁹⁷ The Court found that Congress acted to prevent the speculative harm that patent infringement by states might increase in the future, and not to remedy an existing pattern of patent infringements by states without providing due process to the patent owner.⁹⁸

For Congress to have authority to enact the Patent Remedy Act pursuant to the Fourteenth Amendment, Congress must find that a state has deprived a person of life, liberty, or property, without due process of law.⁹⁹ The Court determined that deprivation by state action of a constitutionally protected interest is not in itself unconstitutional, it becomes unconstitutional when the deprivation is without due process of law.¹⁰⁰ A state's infringement of a patent, though interfering with a patent owner's right to exclude others, does not by itself violate the constitution.¹⁰¹ A deprivation of property without due process only results where a state provides no remedy, or only inadequate remedies, to injured patent owners.¹⁰²

The Court determined that Congress did not find that state remedies were constitutionally inadequate, but that they were less convenient than federal remedies for purposes of uniformity.¹⁰³ Aggrieved parties, in the state of Florida, may pursue either a legislative remedy through a claims bill¹⁰⁴ or a judicial remedy through a takings or conversion claim.¹⁰⁵ The need for uniformity in patent law is important, but that is a factor that should be addressed under the Article One Patent Powers rather than in a determination

94. *Id.*

95. *Id.*

96. *Id.*

97. *Id.*

98. *College Sav. Bank*, 119 S. Ct. at 2208.

99. *Id.*

100. *Id.* (quoting *Zinermon v. Burch*, 494 U.S. 113, 125 (1990)).

101. *College Sav. Bank*, 119 S. Ct. at 2207.

102. *Id.*

103. *Id.* at 2209.

104. *See* FLA. STAT. ANN. § 11.065 (West 1997).

105. *See Jacobs Wind Elec. Co. v. Florida Dep't of Transp.*, 626 So.2d 1333 (Fla. 1993).

of whether state sovereign immunity deprives a patentee of property without due process.¹⁰⁶

The Court focuses on Congress's failure to identify a pattern of constitutional violations, holding that the lack of such a pattern causes the provisions of the PRA to be out of proportion to proposed remedial object.¹⁰⁷ Therefore, the PRA can not be understood as responsive to, or designed to remedy, unconstitutional behavior.¹⁰⁸

The PRA subjects states to an unlimited range of liability, because Congress failed to limit the coverage of the PRA to cases involving constitutional violations.¹⁰⁹ As a means to meet the proportionality requirement, the Court identified three potential limitations to the Act: (1) limiting the Act's coverage to cases where a state refuses to offer any state-court remedy for patent owners whose patents it had infringed; (2) confining the reach of the Act by limiting the remedy to certain types of infringement, such as non-negligent or infringement authorized pursuant to state policy; or (3) only providing for suits against states with questionable remedies or a high incidence of infringement.¹¹⁰

4. The Fifth Amendment: "Takings" Claim

The Court did not consider whether Congress could validly abrogate state sovereign immunity pursuant its authority under the Just Compensation Clause of the Fifth Amendment because Congress failed to expressly invoke its authority under the clause.¹¹¹

B. *Dissenting Opinion*

Justice Stevens filed the dissenting opinion, with whom Justices Souter, Ginsburg, and Breyer joined.¹¹² The dissenting Justices believe that Congress's abrogation of states' sovereign immunity via the PRA was constitutional.¹¹³ The PRA should be sustained as valid legislation enacted to enforce the guarantees of the Fourteenth Amendment's Due Process Clause.¹¹⁴

The dissent emphasizes the fact that the Constitution grants Congress plenary authority over patents and copyrights.¹¹⁵ Congress granted the federal

106. *See College Sav. Bank*, 119 S. Ct. at 2209.

107. *Id.* at 2210.

108. *Id.*

109. *Id.*

110. *Id.*

111. *See College Sav. Bank*, 119 S. Ct. at 2208.

112. *Id.* at 2201.

113. *Id.* at 2211.

114. *Id.*

115. *Id.* (citing U. S. CONST. art. I, § 8, cl. 8).

courts with exclusive jurisdiction over patent infringement litigation.¹¹⁶ In 1992, Congress enacted the PRA to unambiguously authorize patent infringement actions against states or state agencies.¹¹⁷ The dissent asserts that the absence of effective state remedies supports the conclusion that the PRA was an appropriate exercise of Congress's power under section five of the Fourteenth Amendment to prevent state infringements of patents without due process of law.¹¹⁸

1. Policy Requires National Uniformity - Governed By Federal Law

The dissent asserts that Congress's Article One "Patent Power" is directly relevant to this case because it establishes the constitutionality of the congressional decision to grant exclusive jurisdiction over patent infringement cases in the federal courts.¹¹⁹ While the Court acknowledges the need for uniformity in patent law is important, the Court discounts its significance as merely a factor to consider in the "Article I patent-power calculus" and refuses to consider it in the determination of whether sovereign immunity deprives a patentee of property without due process of law.¹²⁰ The dissent disagrees and asserts that Congress had the authority to vest exclusive jurisdiction in the federal courts as well as to abrogate states' sovereign immunity to federal court jurisdiction.¹²¹

Supporting the need for national uniformity, the dissent asserts that there is a strong federal interest in promoting the "constitutional goals of stimulating invention and rewarding the disclosure of novel and useful advances of technology."¹²² Patent litigation often raises difficult technical issues that are unfamiliar to the average trial judge.¹²³ Inconsistent application of the patent laws has led to undue forum shopping and unsettling inconsistency in patent adjudications.¹²⁴

116. *Id.* (citing *Campbell v. Haverhill*, 155 U.S. 610, 620 (1895)).

117. PRA, *supra* note 1.

118. *See College Sav. Bank*, 119 S. Ct. at 2211.

119. *Id.* at 2213.

120. *Id.*

121. *Id.* (the Dissent argues that the decision to vest exclusive jurisdiction over patent infringement cases in federal court was appropriate, and that it was equally appropriate for Congress to abrogate state sovereign immunity in patent infringement cases in order to close a loophole in the uniform federal scheme).

122. *Id.* at 2212 (citing *Bonito Boats, Inc. v. Thunder Crafts Boats, Inc.*, 489 U.S. 141, 162-163 (1989) (stating for the proposition that federal interests are threatened by inadequate protections of patents. Therefore, uniformity, consistency, and familiarity with the patent jurisprudence are matters of overriding significance)).

123. *College Sav. Bank*, 119 S. Ct. at 2211.

124. *Id.*

2. The PRA Was a Valid Exercise of Congress's Fourteenth Amendment Enforcement Power

The dissent believes that the PRA is a valid exercise of Congress's Fourteenth Amendment enforcement power because it meets the test set forth in *Flores*.¹²⁵ Congress has met the required congruence and proportionality between the injury to be prevented or remedied and the means adapted to that end.¹²⁶ The dissent disagrees with the constitutional distinction that the majority draws between negligent and intentional patent infringement.¹²⁷ Respondent CSB has alleged that the Florida Board's infringement was willful.¹²⁸ Therefore, the question presented in this case is whether the PRA, which clarified Congress's unmistakable intent to subject state infringers to federal court jurisdiction, may be applied to willful infringers.¹²⁹

The dissent believes that, prior to this case, no requirement existed for Congress to identify a pattern of wide spread constitutional violations by the states.¹³⁰ The majority based its opinion on perceived deficiencies in the evidence reviewed by Congress before enacting the legislation.¹³¹ Based upon this perceived lack of evidence, the majority held the PRA unconstitutional because Congress failed to identify a pattern of infringement by the states.¹³² The dissent finds the legislative record to have sufficient evidence of constitutional violations by states because Congress heard testimony about inadequate state remedies for patent infringement when considering the PRA.¹³³ Congress also heard general testimony that state remedies would likely be insufficient to compensate patentees whose patents were infringed by states.¹³⁴ The legislative record referenced several cases of patent infringement

125. *Id.* at 2213. *See also Flores*, 521 U.S. at 520 (The *Flores* proportionality test is essentially: "There must be a congruence and proportionality between the injury to be prevented or remedied and the means adopted to that end. Lacking such a connection, legislation may become substantive in operation and effect.").

126. *College Sav. Bank*, 119 S. Ct. at 2213.

127. *Id.* (the dissent disagrees with the majority's rationale that patent infringement is analogous to the holding in *Daniels v. Williams*, 474 U.S. 327, 332-34 (1986), where the court found mere negligence in a personal injury case did not deprive anyone of liberty without due process of law).

128. *Id.*

129. *Id.* at 2212. *See Bonito Boats*, 489 U.S. at 162-63.

130. *College Sav. Bank*, 119 S. Ct. at 2217.

131. *Id.* at 2214.

132. *Id.* at 2210.

133. *Id.* at 2214.

134. *Id.* at 2215 (the legislative record references several cases of patent infringement involving states, *see e.g.*, *Paperless Accounting, Inc. v. Mass Transit Admin.*, Civil No. HAR 84-2922 (D. Md. 1985) (cited in House Hearing, at 56); *Hercules, Inc. v. Minnesota States Highway Dep't*, 337 F. Supp. 795 (Minn. 1972) (House Hearing, at 51)).

involving states, including *Chew*.¹³⁵ The dissent believes that the decision in *Chew* clearly supports Congress's authority to enact the PRA because the Federal Court did not require a determination of whether a patent owner had any remedy in state court.¹³⁶

Congress determined that state infringement of patents was likely to increase.¹³⁷ The dissent provides several examples where States, especially state universities, have been involved in patent cases since 1992.¹³⁸

The dissent finds it ironic that the Court would require Congress to review the remedies available in each state for patent infringements, since Congress had already preempted state jurisdiction over patent infringement.¹³⁹ It is reasonable for Congress to assume that such remedies simply did not exist.¹⁴⁰

3. Congress's Fourteenth Amendment Enforcement Powers are Preventive, Not Merely Remedial

The dissent finds Congress had sufficient evidence of actual or potential constitutional violations to meet the standard set forth in *Flores*, that Congress has authority to enact appropriate enforcement legislation under the Fourteenth Amendment to "remedy or prevent" unconstitutional actions.¹⁴¹ The dissent does not agree with the majority's attempt to restate the standard to allow for remedial legislation only.¹⁴² In *Flores*, the Court merely restated the principle that Congress's enforcement power encompasses legislation that both deters and remedies constitutional violations, even if it prohibits conduct that is not unconstitutional and intrudes into areas of autonomy previously reserved for the states.¹⁴³ The dissent distinguishes the PRA from the Religion Freedom Restoration Act (RFRA). The dissent asserts the PRA is remedial legislation, as opposed to an attempt by Congress to substantively change the Court's interpretation of the Constitution. The RFRA was struck down because it was an attempt by Congress to usurp the Supreme Court's authority to interpret the United States Constitution.¹⁴⁴

135. *College Sav. Bank*, 119 S. Ct. at 2214 (referring to *Chew*, 893 F.2d at 331).

136. *College Sav. Bank*, 119 S. Ct. at 2214.

137. *Id.* at 2215.

138. *See, e.g.*, *University of Colo. Foundation, Inc. v. American Cyanamid Co.*, 974 F. Supp. 1339 (Colo. 1997) (patent infringement action filed by University of Colorado); *Genentech v. Regents of Univ. of Cal.*, 143 F.3d 1446 (Fed. Cir. 1998) (declaratory judgement suit filed by Genentech); and *Ciba-Geigy v. Alza Corp.*, 804 F. Supp. 614 (N.J. 1992) (counterclaim brought by Alza Corp. against Regents of University of California).

139. *College Sav. Bank*, 119 S. Ct. at 2216.

140. *Id.*

141. *Id.* at 2217.

142. *Id.*

143. *Id.*

144. *Id.* (citing *Flores*, 521 U.S. at 525 (the Court held Congress's Fourteenth Amendment enforcement power is corrective or preventive, not definitional)).

In contrast to the majority, the dissent finds precise congruence between the means used (abrogation of state sovereign immunity in patent infringement cases) and the ends to be achieved (elimination of the risk that the defense of sovereign immunity will deprive some patentees of property without due process of the law).¹⁴⁵ The congruence is precise regardless if the infringement of patents by states is rare or infrequent.¹⁴⁶ If infringements are rare, then the statute will only operate in those infrequent cases.¹⁴⁷ But if a pattern of infringement were to develop, then the impact of the statute will expand in harmony with the growth of the problem that Congress is attempting to prevent.¹⁴⁸ Under either scenario, the PRA will have no impact on states' enforcement of their laws.¹⁴⁹ As a result, the dissent asserts that the PRA puts states in the same position as all private users of the patent system, and virtually the same position as the United States.¹⁵⁰

C. *Author's Analysis*

1. States May Deprive Patent Owners of Their Property Without Due Process of Law

As a result of the Court's decision in *FPP*, patent owners may have no protection against state infringement of their patents.¹⁵¹ State sovereign immunity provided by the Eleventh Amendment prevents a patent owner from filing suit against a state in federal court.¹⁵² Currently, the patentee may be deprived of property without due process unless the state has voluntarily submitted to federal jurisdiction or the state has provided for a state remedy.¹⁵³ If states fail to provide one of the above remedies, then a patent owner has no remedy against state infringement until Congress enacts new legislation that abrogates the state's sovereign immunity.

2. Congress's Power to Enact Appropriate Enforcement Legislation Under Section Five of the Fourteenth Amendment is Severely Limited

The Court has severely limited Congress's ability to enforce the substantive provisions of the Fourteenth Amendment.¹⁵⁴ By requiring

145. *College Sav. Bank*, 119 S. Ct. at 2218.

146. *Id.*

147. *Id.*

148. *Id.*

149. *Id.*

150. *College Sav. Bank*, 119 S. Ct. at 2218.

151. *Id.* the Court struck down the PRA as an unconstitutional attempt by Congress to abrogate state sovereign immunity.

152. U.S. CONST. amend. XI.

153. See *College Sav. Bank*, 119 S. Ct. at 2204.

154. See generally *id.* at 2211-18.

appropriate legislation to be “remedial” versus preventive in nature, the Court has handicapped Congress’s power to protect individual’s constitutional rights.¹⁵⁵ Section five of the Fourteenth Amendment authorizes Congress to enact all “appropriate”¹⁵⁶ legislation to enforce the substantive provisions of section one of the Fourteenth Amendment.¹⁵⁷ The express language of the Fourteenth Amendment does not limit appropriate legislation to remedial only.¹⁵⁸ Over the years, the phrase “appropriate legislation” has been subject to judicial interpretation. Initially, the Court’s interpretation provided a broader definition¹⁵⁹ of “appropriate legislation,” but the recent trend has been to narrow the scope of appropriate legislation to remedial only.¹⁶⁰ The Court in *FPP* has narrowed its interpretation further by requiring Congress to identify a “pattern” of widespread and persisting constitutional violations as a prerequisite for appropriate legislation.¹⁶¹ Although language of this type has been used in prior Court decisions,¹⁶² it has never been a prerequisite to appropriate legislation.¹⁶³

The Court is creating new jurisprudence by requiring Congress to identify widespread and pervasive constitutional violations as a prerequisite to appropriate legislation.¹⁶⁴ Citing *Scanlon*, the dissent asserted that the only requirement previously placed upon Congress to enact appropriate enforcement legislation was that Congress make its intention to abrogate states’ sovereign immunity “unmistakably clear.”¹⁶⁵ But, in that case the Court struck down the legislation as inappropriate legislation under section five of

155. *Id.*

156. THE AMERICAN HERITAGE DICTIONARY 192 (Second College ed. 1985) (defines “appropriate” as “suitable for a particular person, condition, occasion, or place; proper; fitting”).

157. U.S. CONST. amend. XIV.

158. *Id.* (the statutory language only requires that legislation be “appropriate”, not remedial).

159. *See Ex parte Virginia*, 100 U.S. 339, 345-46 (1879) (holding that any legislation enacted to ensure compliance with the Fourteenth Amendment and to provide equality of civil rights is appropriate under the enforcement clause). The Court also observed that the Fourteenth Amendment was intended to be a limitation of the power of states and enlargements of the power of Congress. *Id.*

160. *See South Carolina v. Katzenbach*, 383 U.S. 301, 326 (1966) (holding that in order to enforce the provisions of the Fourteenth Amendment congressional action must be construed as “remedial”).

161. *See College Sav. Bank*, 119 S. Ct. at 2210 (striking down the PRA because it did not respond to a history of “widespread and persisting deprivation of constitutional rights” as required to enact proper prophylactic Fourteenth Amendment legislation).

162. *See Katzenbach*, 383 U.S. at 301 (The Court upheld the Voting Rights Act of 1965, noting evidence in the record of subsisting and pervasive discrimination amounting to constitutional violations).

163. *See id.* at 333-34 (the Court, however, did not require widespread and pervasive discrimination as a prerequisite to enacting appropriate legislation).

164. *See College Sav. Bank*, 119 S. Ct. at 2217.

165. *Id.* at 2214 (citing *Scanlon*, 473 U.S. at 247).

the Fourteenth.¹⁶⁶ One deficiency with the dissent's argument, is that once the Court determined that the legislation failed the unmistakably clear intention doctrine,¹⁶⁷ the Court was not required to analyze other required elements.

Requiring Congress to identify a pattern of constitutional violations will cause Fourteenth Amendment enforcement legislation to become more costly and time consuming. For future legislation to be upheld, Congress will be required to investigate and document a pattern of constitutional violations in the legislative record to prevent appropriate Fourteenth Amendment legislation from being struck down.¹⁶⁸ Congress may only effectuate laws against state patent infringers that do not provide state remedies or only provide inadequate remedies. Therefore, the new requirement will prevent Congress from enacting legislation enforceable against all states.¹⁶⁹

The new requirement preempts Congress from establishing a Uniform National Patent Policy that provides consistent protections against both private and state patent infringement. Because Congress may only abrogate states' sovereign immunity after finding a history of infringement without due process, states that provide minimal state remedies for state infringements may protect their right to sovereign immunity. Although the Court states that a finding of inadequate state remedies would enable Congress to abrogate state sovereign immunity,¹⁷⁰ the Court fails to provide standards or examples of inadequate State remedies.¹⁷¹ The lack of such standards leads to the conclusion that any state remedy will be sufficient to protect the state from abrogation of its sovereign immunity, or at least make it less likely that the Court will uphold such an abrogation.

3. Despite the Court's opinion, Congress Should Not be Required to Identify a Pattern of Constitutional Violations as a Prerequisite to Enacting Fourteenth Amendment Legislation

The Separation of Powers Doctrine provides the Supreme Court exclusive authority to interpret the United States Constitution,¹⁷² while it empowers Congress to enact appropriate legislation to enforce the Supreme Court's

166. *See Scanlon*, 473 U.S. at 247.

167. *Id.*

168. *See College Sav. Bank*, 119 S. Ct. at 2207 (the PRA was struck down because the legislative record only identified two examples of patent infringement suits against states).

169. *Id.* (stating where adequate state remedies are provided and followed, no deprivation of property without due process may result).

170. *Id.*

171. *Id.* at 2207-8.

172. *Marybury v. Madison*, 1 Cranch 137, 5 U.S. 137 (1803).

interpretation of the Constitution.¹⁷³ In *Flores*, the Court reaffirmed the Doctrine by declaring the Religious Freedom Restoration Act (RFRA)¹⁷⁴ an unconstitutional attempt by Congress to expand the substantive provisions of the Fourteenth Amendment.¹⁷⁵ Congress enacted RFRA, in direct response to the Supreme Court's holding in *Employment Div. v. Smith*, as an attempt to overrule the Court's interpretation of the Constitution.¹⁷⁶ One of Congress's stated purposes for enacting the RFRA was to restore the compelling-interest test¹⁷⁷ that prohibited a state government from substantially burdening a person's exercise of religion unless the government could demonstrate that the burden was in furtherance of a compelling governmental interest.¹⁷⁸ The Court struck down the RFRA because if Congress could define its own powers by altering the Court's interpretation of the Fourteenth Amendment, then the Constitution would no longer be "superior paramount law, unchangeable by ordinary legislative means."¹⁷⁹

In contrast to the RFRA, Congress's enactment of the PRA was not an attempt to usurp the Judicial Branch's authority to interpret the Constitution.¹⁸⁰ Congress passed the PRA as remedial legislation to protect patent owners' rights from being deprived without due process of law.¹⁸¹ The Court has interpreted the Constitution holding that patent infringement by states without providing a remedy equates to a Constitutional violation under the Fourteenth Amendment.¹⁸² Therefore, Congress has the authority to enact appropriate legislation to prevent such deprivations of property without due process of law.¹⁸³

Despite the Court's decision in *FPP*, Congress should not be required to identify a pattern of constitutional violations before it can enact appropriate

173. *Katzenbach v. Morgan*, 384 U.S. 641, 651 (1966) (stating it is for Congress to "determine whether and what legislation is needed to secure the guarantees of the Fourteenth Amendment," and its conclusions are entitled to much deference).

174. 42 U.S.C. § 2000(b)(b) (1998).

175. *See generally Flores*, 521 U.S. at 507.

176. *Employment Div. v. Smith*, 494 U.S. 872 (1990) (holding that under the free exercise clause, neutral laws of general applicability may be applied to religious practices even when not supported by a compelling governmental interest).

177. *See Sherbert v. Verner*, 374 U.S. 398 (1963). The Supreme Court applied a compelling-interest test for purposes of determining whether a governmental regulation violated the Federal Constitution's First Amendment Clause. In applying the test, the court asked: (1) whether the regulation substantially burdens a religious practice; and (2) if so, whether the burden was justified by a compelling interest. *Id.*

178. *See Flores*, 521 U.S. at 515-16.

179. *Id.* at 529.

180. *See College Sav. Bank*, 119 S. Ct. at 2218 (the dissent argues it merely effectuates settled federal policy to confine patent infringement litigation to federal judges).

181. *Id.*

182. *Id.* at 2208 (citing *Zimmerman*, 494 U.S. at 125).

183. *See Morgan*, 384 U.S. at 651.

legislation. The new requirement will have the effect of requiring several patent owners to be deprived of property rights without due process of law. Since the Court has already decided that state infringement of patents without due process is a Constitutional violation,¹⁸⁴ Congress should be empowered to ensure that all patent owners are guaranteed a remedy for such a violation and not just those patent owners that are fortunate to have their patents infringed after a widespread pattern of constitutional violations has occurred. States should not be allowed to infringe on private patents without providing some form of remedy. It is illogical to require that several individuals have their constitutional rights violated before Congress may enact legislation to prevent such violations.

4. Where Does Congress Go From Here?

Congress must revise the PRA to meet the three requirements of appropriate Fourteenth Amendment legislation, as set forth in *FPP*: (1) Congress must identify a pattern of constitutional violations; (2) it must express its intent to abrogate sovereign immunity with unmistakable clarity; and (3) the means selected must be proportionate to ends.¹⁸⁵ The Court has failed to provide Congress with clear guidance on how to fulfill the first and third requirements.

In regard to the first requirement, the Court has failed to quantify the number of constitutional violations that Congress must identify before the deprivation equates to a “pattern” of constitutional violations. In *FPP*, the Court struck down the PRA even though it acknowledged that Congress identified at least two incidents of constitutional violations.¹⁸⁶ From the Court’s decision in *FPP*, Congress can infer that a substantial number of violations must occur before the Court will find that a “pattern” of unconstitutional patent infringements has occurred. The ambiguity associated with the Court’s interpretation of a “pattern” of constitutional violations may prevent Congress from enacting any patent regulation legislation pursuant to its Fourteenth Amendment enforcement power.

In regard to the third element, the Court provided three recommendations of ways Congress could limit the statute so that the means selected by Congress were proportionate to its ends.¹⁸⁷ Of the three recommended limitations, only the first recommendation appears practical without further explanation by the Court.¹⁸⁸ Congress could easily limit the Act’s coverage to

184. See *College Sav. Bank*, 119 S.Ct. at 2208.

185. *Id.* at 2206-07.

186. *Id.* at 2207.

187. See *supra* text accompanying note 110.

188. See *supra* text accompanying note 110 (the Court’s first recommendation was for Congress to limit the Act’s coverage to cases where a state refuses to offer any state-court remedy for patent owners whose patents it had infringed).

cases where a state refuses to offer any state-court remedy. One advantage to a limitation of this type is that it could be incorporated into the statutory language without requiring Congress to perform an exhaustive investigation into the types of remedies available in each state.

The other two recommendations do not appear to be practical without further clarification because the Court has not articulated standards by which such legislation would be upheld.¹⁸⁹ For example, Congress cannot provide for suits against only those states with questionable remedies, without the Court first defining the types of remedies that are acceptable versus questionable. Similarly, the Court has also failed to define what equals a high incidence of infringement.

Based upon the Court's interpretation of the three requirements in *FPP*, it appears unlikely that Congress will enact any appropriate patent legislation under the Fourteenth Amendment against states that provide a state remedy of any type. Thus, many private patent owners that have their patents infringed by states may not be provided any due process, or at best may receive state due process that is often illusory.

Although the PRA has been held an unconstitutional abrogation of state sovereign immunity under Article One and under the Fourteenth Amendment, the Court has not yet decided if it would be upheld as a valid exercise of Congress' Fifth Amendment "Takings" clause power.¹⁹⁰ Upon a general review of the issue it appears that any attempt to ground the PRA in the Takings Clause of the Fifth Amendment will fail.

The Takings Clause of the Fifth Amendment requires that states pay just compensation when property is taken for a public purpose pursuant to a state's power of eminent domain.¹⁹¹ In general terms, the Court will authorize a taking when a state justly compensates a private individual for state deprivation of his property, and the deprivation was for a public purpose.¹⁹² The Court will only find a taking if the state action causes a drastic reduction in the value of the property¹⁹³ or a permanent physical occupation by the state exists.¹⁹⁴ Since it would be difficult for a patent owner to prove a drastic reduction in the value of his property or an analogy to a permanent physical occupation, the Court would probably not uphold the PRA under a Fifth

189. See *supra* text accompanying note 110 (the Court's other two recommendations were: (1) for Congress to confine the reach of the Act by limiting the remedy to certain types of infringement, such as non-negligent or infringement authorized pursuant to state policy; or (2) for Congress to only provide for suits against states with questionable remedies or a high incidence of infringement).

190. See *College Sav. Bank*, 119 S. Ct. at 2208.

191. U.S. CONST. amend. V.

192. *Ruckelshaus v. Monsanto Co.*, 467 U.S. 986, 1000-04 (1984).

193. *Pennsylvania Coal Co. v. Mahon*, 260 U.S. 393 (1922).

194. *Loretto v. Teleprompter Manhattan CATV Corp.*, 458 U.S. 419 (1982).

Amendment Takings analysis. The Court would probably find patent infringement more similar to regulation of property that does not require just compensation. Associate Professor Thomas Cotter and Christina Bohannon have considered the Constitutionality of the PRA under the Fifth Amendment and assert that it can not be upheld as valid Fifth Amendment legislation pursuant to the Takings Clause.¹⁹⁵ Since Congress' purpose in enacting the PRA is to prevent states from making unlawful uses of patents, it is difficult to perceive how Congress could forbid the states from effecting takings of intellectual property and, at the same time, claim that it is enforcing the Takings clause, which allows the states to effect takings upon payment of just compensation.¹⁹⁶

5. The Courts' Trend Toward Restricting Federal Power

The broader significance of *FPP* is the radically new and restricted view of federal power. When considered with the restrictions placed upon Article I by *Seminole Tribe*, *FPP* represents the view of a 5-Justice majority that federal power is much less extensive than had previously been thought. As Professor Tribe has said, "the Court's current dedication to a states' rights doctrine seems to be a free floating cloud that can rain on almost any source of Congressional power."¹⁹⁷

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195. See Christina Bohannon & Thomas F. Cotter, *When the State Steals Ideas: Is the Abrogation of State Sovereign Immunity from Federal Infringement Claims Constitutional in Light of Seminole Tribe?*, 4 FORDHAM L. REV. 1435, 1458-69 (1999).

196. *Id.* at 1469.

197. Nina Bernstein, *An Accountability Issue*, N.Y. TIMES, April 1, 1996, at A1.