

## EX PARTE YOUNG REMEDY FOR STATE INFRINGEMENT OF INTELLECTUAL PROPERTY

by  
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*Unclear standards govern the availability of an Ex parte Young remedy to a plaintiff who sues a state official for intellectual property infringement. This Comment proposes a new test to standardize federal court adjudication of a plaintiff's Ex parte Young claims. The test provides an analytical framework to assess the sufficiency of the connection between a defendant state official and the alleged infringement. Plaintiffs can also use the test to draft effective Ex parte Young claims making them more likely to survive pre-trial judicial scrutiny.*

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## I. INTRODUCTION

Does Eleventh Amendment sovereign immunity give states carte blanche to violate patents, copyrights and trademarks? Recent decisions by the Supreme Court suggest that states can violate private intellectual property rights without fear of suit for damages in federal court.<sup>1</sup> The Eleventh Amendment of the Constitution of the United States bars suits against a state by private entities.<sup>2</sup> Concurrently, section 1338(a) of title 28 of the United States Code gives the federal district courts original jurisdiction in intellectual property infringement cases.<sup>3</sup> There are only two situations in which a plaintiff can overcome state sovereign immunity. The first occurs when a state waives its immunity by consenting to the suit.<sup>4</sup> The second arises when Congress abrogates state immunity.<sup>5</sup> Unfortunately, the Supreme Court has placed increasing restrictions on congressional ability to abrogate state immunity.<sup>6</sup> As a result, remedies available against state infringement of intellectual property are extremely limited.

A plaintiff may be able to obtain equitable relief against state infringement of intellectual property based on the doctrine of *Ex parte Young*.<sup>7</sup> This doctrine provides that state sovereign immunity does not protect state officials who violate federal laws or the Constitution while

<sup>1</sup> Daniel P. Valentine, *The Plenary Power of States to Infringe Intellectual Property Under the Cloak of Sovereign Immunity*, 6 J. HIGH TECH. L. 165, 186 (2006).

<sup>2</sup> "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." U.S. CONST. amend. XI.

<sup>3</sup> 28 U.S.C. § 1338(a) (2000) ("The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.").

<sup>4</sup> Valentine, *supra* note 1, at 170.

<sup>5</sup> *Id.* at 172.

<sup>6</sup> *Id.* at 183–84.

<sup>7</sup> 209 U.S. 123 (1908).

performing their state sanctioned duties.<sup>8</sup> The doctrine is limited, however, and only allows for an injunction against ongoing and prospective violations.<sup>9</sup> It does not allow recovery of monetary damages for past violations of a plaintiff's intellectual property rights.<sup>10</sup> Nevertheless, because the scope of the *Ex parte Young* doctrine has narrowed concurrently with the Supreme Court's Eleventh Amendment jurisprudence, it may be difficult to obtain even injunctive relief.

A. *Challenges In Obtaining Relief From State Infringement of Intellectual Property*

A recent decision by the Court of Appeals for the Federal Circuit (CAFC) demonstrates the challenges in obtaining a remedy against state infringement of intellectual property rights. In *Pennington Seed, Inc. v. Produce Exchange No. 299*,<sup>11</sup> the CAFC dismissed a patent infringement action by Pennington Seed Inc. against the University of Arkansas.<sup>12</sup> Pennington Seed markets AgResearch's patented fescue grass seed under a license agreement.<sup>13</sup> Pennington Seed alleged that the university and its officials were "actively growing, marketing, offering for sale, promoting and selling a product containing" its patented seeds.<sup>14</sup> Pennington Seed also sought an injunction against the president, the chairman of the board, and a professor of the university to prevent future violations of the patent.<sup>15</sup>

The CAFC upheld the district court ruling that the university enjoyed sovereign immunity under the Eleventh Amendment because it was "an instrumentality of the State of Arkansas."<sup>16</sup> The court also ruled that Pennington Seed had failed to show a sufficient causal connection between the conduct of the university officials and the alleged patent infringement activity.<sup>17</sup> Consequently, the court refused to award Pennington Seed an *Ex parte Young* injunction against the university officials.<sup>18</sup> This case shows that state sovereign immunity will bar a plaintiff from obtaining damages from a state when it infringes the

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<sup>8</sup> *Id.* at 159–60. "The theory of *Young* was that an unconstitutional statute is void, and therefore does not 'impart to [the official] any immunity from responsibility to the supreme authority of the United States.' *Young* also held that the Eleventh Amendment does not prevent federal courts from granting prospective injunctive relief to prevent a continuing violation of federal law." *Green v. Mansour*, 474 U.S. 64, 68 (1985) (citations omitted) (alteration original).

<sup>9</sup> *Green*, 474 U.S. at 68.

<sup>10</sup> *Edelman v. Jordan*, 415 U.S. 651, 668–69 (1974).

<sup>11</sup> 457 F.3d 1334 (Fed. Cir. 2006).

<sup>12</sup> *Id.* at 1345.

<sup>13</sup> *Id.* at 1338.

<sup>14</sup> *Id.*

<sup>15</sup> *Id.* at 1337–38.

<sup>16</sup> *Pennington Seed Inc. v. Produce Exch. No. 299*, No. 04-4194-CV CSOW, 2004 WL 5180533 at \*1 (W.D. Mo. Nov. 29, 2004).

<sup>17</sup> *Pennington Seed*, 457 F.3d at 1342–43.

<sup>18</sup> *Id.* at 1343.

plaintiff's intellectual property rights. The case also demonstrates that an injunctive remedy may not be available unless the plaintiff can show *sufficient* connection between the defendant state officials and the infringement.

*B. Unclear Federal Court Standards For Providing Ex Parte Young Relief*

The Supreme Court has not yet defined the amount and type of connection required to invoke an *Ex parte Young* injunction against a state official. However, in *Ex parte Young* the Court stated that "it is plain that such officer must have some connection with the enforcement of the act, or else it is merely making him a party as a representative of the State, and thereby attempting to make the State a party."<sup>19</sup> The lack of clear standards to assess the *connection* required between a state official and the alleged violation of federal law has led to inconsistent decisions from federal courts. Some courts, like the CAFC, have required a specific causal connection between the state officials and the alleged infringement.<sup>20</sup> Other courts have taken a far more lenient approach.

For example, in *Salerno v. City University of New York*,<sup>21</sup> the District Court of the Southern District of New York required the plaintiff to show only *some* connection between the state official and the alleged illegal act. In *Salerno*, a documentary creator claimed that she produced a film for the City University of New York (CUNY) and the Calandra Institute as a work-for-hire product.<sup>22</sup> Normally, the copyright in a work-for-hire product is owned solely by the hiring entity—CUNY in this case.<sup>23</sup> However, the documentary creator asserted her copyright in the film because she claimed that it contained portions of her prior copyrighted work.<sup>24</sup> She also sought an injunction against the chancellor of CUNY (chancellor) and the director of the Calandra Institute (director) to prevent future violations of her copyright.<sup>25</sup>

The *Salerno* court held that the Eleventh Amendment barred plaintiff's copyright claims against CUNY and the Calandra Institute because both could "be treated as arms of the State."<sup>26</sup> However, the court allowed the claims for injunctive relief to proceed to trial even though the plaintiff had failed to specifically connect the state officials to the copyright violation.<sup>27</sup> The plaintiff's complaint alleged only that the chancellor and director were responsible "for the administration and

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<sup>19</sup> *Ex parte Young*, 209 U.S. 123, 157 (1908).

<sup>20</sup> *See, e.g., Pennington Seed*, 457 F.3d at 1342–43.

<sup>21</sup> 191 F. Supp. 2d 352 (S.D.N.Y. 2001).

<sup>22</sup> *Id.* at 355.

<sup>23</sup> 17 U.S.C. § 201(b) (2000).

<sup>24</sup> *Salerno*, 191 F. Supp. 2d at 355.

<sup>25</sup> *Id.*

<sup>26</sup> *Id.*

<sup>27</sup> *Id.* at 357.

implementation” of copyright policies.<sup>28</sup> The *Salerno* court held that this connection was sufficient to invoke the *Ex parte Young* remedy.<sup>29</sup> This is in stark contrast to the *Pennington Seed* holding that a state official merely involved in administering university patent policy does not have sufficient connection with the alleged infringement.<sup>30</sup> Thus, the *Salerno* court required a much weaker connection between the state officials and the alleged copyright infringement to allow the *Ex parte Young* action to proceed.

Similarly, in *Hairston v. North Carolina Agricultural & Technical State University*,<sup>31</sup> the District Court of North Carolina allowed a photographer to seek an injunction against the use of his copyrighted photographs.<sup>32</sup> Hairston had taken a photograph titled “The Greensboro Four.”<sup>33</sup> The photograph was reproduced on football program literature sold by the North Carolina Agricultural & Technical State University at its football games.<sup>34</sup> The district court held that the university enjoyed sovereign immunity under the Eleventh Amendment because it was an agency of the State of North Carolina.<sup>35</sup> Therefore, the court dismissed Hairston’s claims of copyright infringement.<sup>36</sup> However, the court upheld Hairston’s *Ex parte Young* actions against the chancellor, vice chancellor, and the associate chancellor for development and university relations.<sup>37</sup> The court did not address whether these officials were sufficiently connected with the alleged copyright infringement.<sup>38</sup> Nevertheless, the court allowed the *Ex parte Young* action to proceed, citing the *Salerno* decision.<sup>39</sup>

At the far end of the spectrum, the District Court of Minnesota allowed a corporation’s *Ex parte Young* suit to proceed even though the complaint did not name individual state officials. In *Hercules Inc. v. Minnesota State Highway Department*,<sup>40</sup> the plaintiff simply alleged—without naming any state officials as defendants—that the highway department of the State of Minnesota had infringed its patent.<sup>41</sup> The district court held that the Eleventh Amendment barred the patent infringement action

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<sup>28</sup> Amended Complaint Jury Demand at 3–4, *Salerno v. City Univ. of N.Y.*, 191 F. Supp. 2d 352 (S.D.N.Y. 2001) (No. 99 Civ. 11151).

<sup>29</sup> *Salerno*, 191 F. Supp. 2d at 357.

<sup>30</sup> *Pennington Seed, Inc. v. Produce Exch. No. 299*, 457 F.3d 1334, 1342–43 (Fed. Cir. 2006).

<sup>31</sup> No. 1:04 CV 1203, 2005 WL 2136923 at \*2 (M.D.N.C. Aug. 5, 2005).

<sup>32</sup> *Id.* at \*8.

<sup>33</sup> *Id.* at \*2.

<sup>34</sup> *Id.*

<sup>35</sup> *Id.* at \*3.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.* at \*8.

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> 337 F. Supp. 795 (D. Minn. 1972).

<sup>41</sup> *Id.* at 796.

against the State of Minnesota.<sup>42</sup> However, the court decided to interpret the plaintiff's complaint as if it named the state officials of the highway department and allowed the plaintiff to amend the complaint.<sup>43</sup>

These cases illustrate that the standards which govern the connection required to invoke the *Ex parte Young* remedy are unclear. Under *Pennington Seed*, a mere showing that the named officials were responsible for overseeing university patent policies was insufficient to subject them to suit.<sup>44</sup> On the other hand, under *Salerno*, officials responsible for administering and implementing university copyright policies could be subjected to suit under the *Ex parte Young* doctrine.<sup>45</sup> The *Hairston* and *Hercules* decisions did not require any specific connection between the named state officials and the infringement. Note also that although *Hercules* was decided in 1972, *Salerno*, *Hairston*, and *Pennington Seed* were decided in 2001, 2005, and 2006 respectively. Because the Supreme Court has not specified standards for the connection, the differences in the federal court decisions cannot be solely attributed to an evolution of the *Ex parte Young* doctrine.

### C. Organization of This Comment

This Comment proposes a new test to assess the connection required between a state official and the violation of federal law to invoke the *Ex parte Young* remedy. Part II examines the evolution of the Supreme Court's Eleventh Amendment jurisprudence which establishes the limits on congressional power to abrogate state immunity. Part III examines the concurrent evolution of the *Ex parte Young* doctrine to assess its limitations. Part III also reviews a plaintiff's remedies to show that an *Ex parte Young* injunction may be the most effective remedy against ongoing and prospective violations of a plaintiff's rights. Part IV surveys the standards applied by federal courts in assessing the availability of *Ex parte Young* relief to a plaintiff. Part V proposes the new three-element test for assessing the viability of an *Ex parte Young* remedy in intellectual property infringement cases. The test is applied to the facts of the *Pennington Seed* and *Hairston* cases to demonstrate its effectiveness. Application of the test to the *Pennington Seed* case shows that it was decided correctly by the CAFC. On the other hand, the test shows that in the *Hairston* case only one out of the three named state officials had a sufficient connection with the alleged infringement. Thus, the test provides a structured analytical framework to assess a plaintiff's *Ex parte Young* claims against individual state officials. The Comment concludes by summarizing the benefits of the proposed test.

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<sup>42</sup> *Id.* at 800.

<sup>43</sup> *Id.*

<sup>44</sup> *Pennington Seed, Inc. v. Produce Exch. No. 299*, 457 F.3d 1334, 1342–43 (Fed. Cir. 2006).

<sup>45</sup> *Salerno v. City Univ. of N.Y.*, 191 F. Supp. 2d 352, 357 (S.D.N.Y. 2001).

## II. SCOPE OF THE ELEVENTH AMENDMENT STATE IMMUNITY

The evolution of the Supreme Court's Eleventh Amendment jurisprudence shows an initial century-long expansion of federal power at the expense of the power of the states. Subsequently, the Court reversed course and placed increasing restrictions on congressional ability to abrogate state sovereign immunity.<sup>46</sup> The resurgence of state immunity has severely limited a plaintiff's remedies against state infringement of intellectual property.<sup>47</sup>

### A. Establishment of State Sovereign Immunity

The plain language of the Eleventh Amendment suggests that a state is not immune from suit in federal court initiated by its own citizens. The text shows that a state is immune only from suits brought by citizens of a different state or subjects of a foreign state.<sup>48</sup> However, in an early decision, in 1890, the Supreme Court adopted a much broader reading of the Eleventh Amendment. The Court held in *Hans v. Louisiana*<sup>49</sup> that even a state's citizens could not subject it to suit in federal court without its consent.<sup>50</sup>

The Court based its decision on three factors. First, the Court noted the haste with which the states adopted the Eleventh Amendment following the Court's decision in *Chisholm v. Georgia*.<sup>51</sup> The *Chisholm* decision had allowed suits against a state by citizens of another state or a foreign nation.<sup>52</sup> Second, the Court pointed to Hamilton's statement in the Federalist No. 81 that "[i]t is inherent in the nature of sovereignty not to be amenable to the suit of an individual *without its consent*."<sup>53</sup> The Court also noted that there was widespread support for Hamilton's statement during the constitutional debates at the Virginia Convention.<sup>54</sup> Third, the Court reviewed its prior decisions and Justice Iredell's strong dissent in *Chisholm*.<sup>55</sup> The Court concluded that it was enough to declare the "rule which exempts a sovereign state from prosecution in a court of justice" because reasons for the rule had been "fully discussed by writers on public law."<sup>56</sup> Thus, under this expansive reading of the Eleventh

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<sup>46</sup> Valentine, *supra* note 1, at 173–74.

<sup>47</sup> *Id.* at 193.

<sup>48</sup> See *supra* note 2.

<sup>49</sup> 134 U.S. 1 (1890).

<sup>50</sup> *Id.* at 21.

<sup>51</sup> 2 U.S. (2 Dall.) 419 (1793).

<sup>52</sup> *Hans*, 134 U.S. at 11.

<sup>53</sup> *Id.* at 13. (quoting THE FEDERALIST NO. 81, at 446 (Alexander Hamilton) (E.H. Scott ed., 2002)).

<sup>54</sup> *Id.* at 14.

<sup>55</sup> *Id.* at 16–20.

<sup>56</sup> *Id.* at 21.

Amendment, a state could be subjected to suit in federal court only if it waived its immunity by consenting to the suit.<sup>57</sup>

*B. Expansion of Congressional Power to Abrogate State Sovereign Immunity*

The Supreme Court addressed the issue of abrogation of state immunity under Section Five of the Fourteenth Amendment in *Fitzpatrick v. Bitzer*.<sup>58</sup> The Court held that the Constitution gave Congress the authority to abrogate state immunity.<sup>59</sup> The Court based its decision primarily on the text of the Fourteenth Amendment.<sup>60</sup> Section One of the Fourteenth Amendment provides that no state shall “deprive any person of life, liberty, or property, without due process of law . . . .”<sup>61</sup> In addition, Section Five of the Fourteenth Amendment gives Congress the power to enforce by appropriate legislation the substantive provisions of the Fourteenth Amendment defined in its other sections.<sup>62</sup> The Court emphasized that the Fourteenth Amendment was an enlargement of congressional power and simultaneously a limitation on state sovereignty.<sup>63</sup> Congress had the authority to enact legislation to enforce the substantive rights outlined in the other sections of the Fourteenth Amendment thereby limiting state authority.<sup>64</sup> The Court declared that such legislation could include authorization for private suits against states or state officials.<sup>65</sup>

The expansion of federal power continued when the Supreme Court ruled, in *Pennsylvania v. Union Gas Co.*,<sup>66</sup> that Congress could abrogate state immunity through a valid exercise of its Commerce Clause powers.<sup>67</sup> That case arose because tar from a coal gasification plant operated by the predecessors of Union Gas had seeped into a creek.<sup>68</sup> The Environmental Protection Agency declared the creek a hazardous waste site.<sup>69</sup> Subsequently, the United States and the State of Pennsylvania initiated efforts to clean the hazardous waste site.<sup>70</sup> The United States sued Union Gas to recoup cleanup costs under the Comprehensive Environmental

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<sup>57</sup> *Id.* at 17.

<sup>58</sup> 427 U.S. 445 (1976).

<sup>59</sup> *Id.* at 457.

<sup>60</sup> *Id.* at 453–54.

<sup>61</sup> U.S. CONST. amend. XIV, § 1.

<sup>62</sup> U.S. CONST. amend. XIV, § 5.

<sup>63</sup> *Fitzpatrick*, 427 U.S. at 454.

<sup>64</sup> *Id.* at 456.

<sup>65</sup> *Id.*

<sup>66</sup> 491 U.S. 1 (1989).

<sup>67</sup> *Id.* at 23.

<sup>68</sup> *Id.* at 5.

<sup>69</sup> *Id.* at 6.

<sup>70</sup> *Id.*



Response Compensation and Liability Act (CERCLA).<sup>71</sup> Union Gas in turn sued the State of Pennsylvania because the state was the owner and operator of the hazardous waste site.<sup>72</sup> The Third Circuit affirmed the district court decision to dismiss the complaint against the State of Pennsylvania because CERCLA did not abrogate state immunity.<sup>73</sup> However, Congress passed the Superfund Amendments and Reauthorization Act (SARA) to amend CERCLA while the case was pending before the Supreme Court.<sup>74</sup> The Supreme Court remanded the case for reconsideration by the Third Circuit in light of SARA.<sup>75</sup>

On remand, the Third Circuit concluded that Congress had used its authority under the Commerce Clause powers to abrogate state sovereign immunity in SARA.<sup>76</sup> The Supreme Court granted certiorari to review the appeals court decision.<sup>77</sup> The Court held that Congress could abrogate state immunity “when exercising its plenary authority to regulate interstate commerce.”<sup>78</sup> The Court declared that “the States surrendered a portion of their sovereignty when they granted Congress the power to regulate commerce.”<sup>79</sup> The Court also noted that congressional power to regulate commerce would be incomplete without the authority to enforce this power against the states.<sup>80</sup> Congress has the authority to fashion appropriate remedies, including private suits, against states.<sup>81</sup> The Court asserted that its ruling was consistent with *Hans* because the states had consented to such suits when they ratified the Constitution.<sup>82</sup> Thus, the *Union Gas* decision established the rule that Congress could abrogate state sovereign immunity when exercising its Article I powers.

### C. Limitations on Congressional Power to Abrogate State Sovereign Immunity

Recent Supreme Court decisions have reversed the century-long expansion of congressional power to abrogate the state sovereign immunity. In particular, these decisions have significantly limited the conditions under which Congress can enforce the provisions of Section One of the Fourteenth Amendment. The Court has ruled that Congress must unequivocally declare its intent to abrogate state immunity in any

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<sup>71</sup> *Id.* See also Comprehensive Environmental Response Compensation and Liability Act, 42 U.S.C. §§ 9601–9607 (2000).

<sup>72</sup> *Union Gas*, 491 U.S. at 6.

<sup>73</sup> *Id.*

<sup>74</sup> *Id.* See also Superfund Amendments and Reauthorization Act of 1986 (SARA), Pub. L. 99-499, 100 Stat. 1613.

<sup>75</sup> *Union Gas*, 491 U.S. at 6.

<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

<sup>78</sup> *Id.* at 15.

<sup>79</sup> *Id.* at 14 (quoting *Parden v. Terminal Ry.*, 377 U.S. 184, 191 (1964)).

<sup>80</sup> *Id.* at 19–20.

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

legislation enacted under Section Five of the Fourteenth Amendment.<sup>83</sup> The Court has also redefined the scope of congressional power by interpreting the text of the Fourteenth Amendment in light of the congressional debates preceding its enactment.<sup>84</sup> The Court has ruled that Congress can abrogate state sovereign immunity only to provide a remedy for violations of the Fourteenth Amendment.<sup>85</sup> Congress cannot abrogate state immunity to redefine or expand the constitutional rights guaranteed by the Fourteenth Amendment.<sup>86</sup> The Court has placed a further limitation by requiring that the remedy must be proportional to the constitutional violation.<sup>87</sup>

However, the most severe restriction on congressional power to abrogate state sovereign immunity was established by the Supreme Court decision in *Seminole Tribe of Florida v. Florida*.<sup>88</sup> In that case, the Court overturned *Union Gas* to hold that Congress could not abrogate state sovereign immunity under its Article I powers.<sup>89</sup> Congress had abrogated state sovereign immunity through the Indian Gaming Regulatory Act (IGRA).<sup>90</sup> Congress enacted IGRA under its Article I Commerce Clause powers “[t]o regulate commerce . . . with the Indian Tribes.”<sup>91</sup> IGRA allowed Indian tribes to conduct gaming activities in a state only if they had a valid compact with the state.<sup>92</sup> IGRA imposed a duty upon the states to negotiate in good faith with Indian tribes and authorized the tribes to sue the state if it failed to do so.<sup>93</sup>

The Seminole Tribe sued the State of Florida and the governor of Florida under IGRA for failing to negotiate additions to a gaming compact.<sup>94</sup> The tribe claimed that Congress had abrogated Florida’s sovereign immunity by explicitly declaring such intent in IGRA.<sup>95</sup> The Supreme Court agreed with the tribe that Congress had unequivocally expressed its intention to abrogate state sovereign immunity in the text of IGRA.<sup>96</sup> However, the Court held that the Eleventh Amendment placed a limit on congressional power to expand federal court jurisdiction under Article III of the Constitution.<sup>97</sup> The Court stated that:

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<sup>83</sup> *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 242 (1985).

<sup>84</sup> *City of Boerne v. Flores*, 521 U.S. 507, 519–20 (1997).

<sup>85</sup> *Id.* at 524.

<sup>86</sup> *Id.* at 529.

<sup>87</sup> *Id.* at 530.

<sup>88</sup> 517 U.S. 44 (1996).

<sup>89</sup> *Id.* at 72–73.

<sup>90</sup> *Id.* at 47. *See also* Indian Gaming Regulatory Act (IGRA), 25 U.S.C. §§ 2701–2721 (2000).

<sup>91</sup> U.S. CONST. art. I, § 8, cl. 3.

<sup>92</sup> *Seminole Tribe*, 517 U.S. at 47.

<sup>93</sup> *Id.*

<sup>94</sup> *Id.* at 51–52.

<sup>95</sup> *Id.* at 55.

<sup>96</sup> *Id.* at 56.

<sup>97</sup> *Id.* at 72–73.

[T]he background principle of state sovereign immunity embodied in the Eleventh Amendment is not so ephemeral as to dissipate when the subject of the suit is an area, like the regulation of Indian Commerce . . . . Even when the Constitution vests in Congress complete lawmaking authority over a particular area, the Eleventh Amendment prevents congressional authorization of suits by private parties against unconsenting States. The Eleventh Amendment restricts the judicial power under Article III, and Article I cannot be used to circumvent the constitutional limitations placed upon federal jurisdiction.<sup>98</sup>

Thus, *Seminole Tribe* eliminated the ability of Congress to abrogate state sovereign immunity from private suits when exercising its powers under Article I of the Constitution.

The current scope of state sovereign immunity under the Eleventh Amendment can be summarized as follows:

1. The Eleventh Amendment bars suits against states not only by citizens of other states or subjects of a foreign state, but also by the state's own citizens. A state can waive its sovereign immunity by consenting to a suit by a private party. Alternatively, a state can be sued by a private entity if Congress successfully abrogates state immunity.

2. Congress cannot abrogate state immunity through its exercise of Article I powers.

3. Congress can abrogate state immunity under Section Five of the Fourteenth Amendment but only under two key limitations. First, it must unequivocally declare its intent to abrogate the immunity in the statute. Second, Congress can abrogate state immunity only to create a remedy for constitutional violations. The remedy thus created must be proportionate to the anticipated harm caused by the constitutional violation.

These principles have a profound impact on the availability of federal court jurisdiction to remedy state infringement of intellectual property rights.

#### *D. Impact of Eleventh Amendment Jurisprudence on Intellectual Property Litigation*

It is necessary to backtrack to the *Union Gas* decision to understand the impact of the Supreme Court's Eleventh Amendment jurisprudence on intellectual property litigation. *Union Gas* provided Congress with the authority to abrogate state sovereign immunity while exercising its Article I powers.<sup>99</sup> Like the Commerce Clause, Article I of the Constitution also grants Congress the power to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."<sup>100</sup> Thus,

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<sup>98</sup> *Id.* (footnote omitted).

<sup>99</sup> *Union Gas*, 491 U.S. at 19–20.

<sup>100</sup> U.S. CONST. art. 1, § 8, cl. 8.

under *Union Gas*, Congress could modify the intellectual property statutes to give intellectual property owners the right to sue a state.

Congress used its authority to enact the Patent and Plant Variety Protection Remedy Clarification Act (PRA) in which it abrogated state immunity and allowed private patent owners to sue states.<sup>101</sup> The unequivocal language in PRA declared:

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, 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 by any person, including any governmental or nongovernmental entity, for infringement of a patent under section 271, or for any other violation under this title.<sup>102</sup>

PRA also provided remedies against a state in both law and equity to the same extent as available in a suit against a private entity.<sup>103</sup> Congress included similar language in the Copyright Remedy Clarification Act (CRCA)<sup>104</sup> and the Trademark Remedy Clarification Act (TRCA).<sup>105</sup>

A specific goal of these revised statutes was to allow intellectual property owners to seek redress from state infringement in federal courts. However, in *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*,<sup>106</sup> the Supreme Court ruled that PRA provisions abrogating state immunity were invalid.<sup>107</sup> In that case, College Savings Bank of New Jersey marketed annuity contracts for financing future college expenses.<sup>108</sup> The bank obtained a patent on the financing method.<sup>109</sup> Florida Prepaid Post Secondary Expense Education Board was an entity created by the State of Florida to administer similar college financing contracts.<sup>110</sup> College Savings Bank sued Florida Prepaid for infringing its patent on the financing method.<sup>111</sup> College Savings Bank's appeal in the CAFC pre-dated the revised patent statute enacted by Congress.<sup>112</sup> Therefore, the CAFC held that suit against Florida Prepaid was barred by the Eleventh Amendment because Florida Prepaid was an

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<sup>101</sup> Patent and Plant Variety Protection Remedy Clarification Act of 1992 (PRA), Pub. L. No. 102-560, 106 Stat 4230 (codified as amended at 35 U.S.C. § 296 (2000)).

<sup>102</sup> PRA, 106 Stat. at § 296(a).

<sup>103</sup> PRA, 106 Stat. at § 296(b).

<sup>104</sup> Copyright Remedy Clarification Act of 1990 (CRCA), Pub. L. No. 101-553, 104 Stat. 2749 (codified as amended at 17 U.S.C. § 511 (2000)).

<sup>105</sup> Trademark Remedy Clarification Act of 1992 (TRCA), Pub. L. No. 102-542, 106 Stat. 3567 (codified as amended at 15 U.S.C. § 1121 (2000)).

<sup>106</sup> 527 U.S. 627 (1999).

<sup>107</sup> *Id.* at 630.

<sup>108</sup> *Id.*

<sup>109</sup> *Id.* at 631.

<sup>110</sup> *Id.*

<sup>111</sup> *Id.* at 631.

<sup>112</sup> *Id.* at 632.

agency of the State of Florida.<sup>113</sup> College Savings Bank appealed to the Supreme Court after Congress enacted PRA.<sup>114</sup>

The Supreme Court first reiterated its *Seminole Tribe* decision that Congress did not have the authority to abrogate the sovereign immunity of a state through its Article I powers.<sup>115</sup> The Court went on to evaluate whether Congress could abrogate state immunity in patent infringement cases under Section Five of the Fourteenth Amendment.<sup>116</sup> The Supreme Court applied the two-pronged *Seminole Tribe* test.<sup>117</sup> The Court ruled that Congress met the first prong of the test by unequivocally stating its intention to abrogate state immunity through the clear language of section 296(a) of the PRA.<sup>118</sup> However, the Court concluded that Congress had failed to meet the second prong of the test because there was insufficient evidence of a Fourteenth Amendment violation.<sup>119</sup>

Additionally, the Court held that “for Congress to invoke Section Five, it must identify conduct transgressing the Fourteenth Amendment’s substantive provisions, and must tailor its legislative scheme to remedying or preventing such conduct.”<sup>120</sup> The Court found only two cases of state infringement mentioned in the legislative record and only eight cases of state infringement identified by the Federal Circuit between 1880 and 1990.<sup>121</sup> As a result, the Court concluded that there was insufficient evidence to show that Congress was acting to remedy widespread patent infringement by states.<sup>122</sup> Interestingly, one commentator has speculated that the Court engaged in circular reasoning because the lack of evidence could be a result of the real or perceived existence of state immunity.<sup>123</sup> Nevertheless, the Court declared that:

[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. Instead, only where the State provides no remedy, or only inadequate remedies, to injured patent owners for its infringement of their patent could a deprivation of property without due process result. “[I]n challenging a property deprivation, the claimant must either avail himself of the remedies guaranteed by state law or prove that the available remedies are inadequate.”<sup>124</sup>

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<sup>113</sup> *Id.*

<sup>114</sup> *Id.* at 632–633.

<sup>115</sup> *Id.* at 636.

<sup>116</sup> *Id.* at 639.

<sup>117</sup> *Id.*

<sup>118</sup> *Id.* at 640.

<sup>119</sup> *Id.* at 647.

<sup>120</sup> *Id.* at 639.

<sup>121</sup> *Id.* at 640.

<sup>122</sup> *Id.*

<sup>123</sup> Valentine, *supra* note 1, at 180.

<sup>124</sup> *Fla. Prepaid*, 527 U.S. at 643 (citations omitted).

The Court found no evidence in the legislative record to show that the remedies provided by the states were so inadequate as to violate constitutional due process requirements.<sup>125</sup> The Court therefore concluded that Congress had failed to meet the second prong of the *Seminole Tribe* test, and declared invalid the provisions of the PRA abrogating state immunity.<sup>126</sup>

In the same session, the Supreme Court also struck down provisions in the TRCA which allowed a private entity to sue a state for false or misleading advertising.<sup>127</sup> The Court noted that unlike trademark rights, Lanham Act provisions against false advertising do not give a trademark owner the right to exclude others from using his mark.<sup>128</sup> Without the right to exclude, the provisions against false advertising could not be treated as property rights.<sup>129</sup> Thus, no constitutional due process violation could result even if states did not provide any remedy against false advertising.<sup>130</sup> The Court did not explicitly conclude that congressional attempts to remedy false advertising issues would fail the second prong of the *Seminole Tribe* test. However, its ruling implied that such a result was likely because false advertising did not deprive a trademark owner of property interests.<sup>131</sup> Unlike *Florida Prepaid*, the Court did not strike down congressional abrogation of state immunity in trademark infringement cases under the TRCA.<sup>132</sup>

The Supreme Court has not yet ruled on the provisions abrogating state sovereign immunity in the CRCA. However, *Florida Prepaid* provides a strong indication that provisions allowing private suits against state infringement of a copyright may also be struck down as unconstitutional. In fact, the *Hairston* court has already declared the CRCA provisions abrogating state immunity invalid in light of *Florida Prepaid*.<sup>133</sup>

#### *E. Alternative Remedies Against State Infringement of Intellectual Property Rights*

It is apparent from the recent Supreme Court decisions that congressional attempts to abrogate state immunity in the intellectual property arena will not survive constitutional scrutiny. Several commentators have explored the availability of alternative remedies

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<sup>125</sup> *Id.* at 640.

<sup>126</sup> *Id.* at 630.

<sup>127</sup> *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999).

<sup>128</sup> *Id.* at 673.

<sup>129</sup> *Id.*

<sup>130</sup> *Id.* at 673–676.

<sup>131</sup> *Id.*

<sup>132</sup> Bruce E. O'Connor & Emily C. Peyser, *Ex parte Young: A Mechanism for Enforcing Federal Intellectual Property Rights Against States*, 10 B.U. J. SCI. & TECH. L. 225, 242 (2004).

<sup>133</sup> *Hairston v. N.C. Agric. & Technical State Univ.*, No. 1:04 CV 1203, 2005 WL 2136923, at \* 8 (M.D.N.C. Aug. 5, 2005).

against state infringement of intellectual property following the Supreme Court's *Florida Prepaid* decision.<sup>134</sup>

Some of the proposed remedies include litigation under state tort or contract theory, suit by the federal government on behalf of the private plaintiff, or inverse condemnation.<sup>135</sup> A suit under state tort law would be possible only if the state waived its sovereign immunity against such suits.<sup>136</sup> A plaintiff could initiate suit under breach of contract theory if the intellectual property was licensed to the state under a contract.<sup>137</sup> A plaintiff could enlist the federal government to sue a state because the Eleventh Amendment does not bar suit by the United States against a state.<sup>138</sup> Note, however, that the plaintiff would have to rely on additional legislation to allow the federal government to disburse the money damages recovered from such a suit.<sup>139</sup> A plaintiff could also initiate a suit under the theory of inverse condemnation claiming that the state had taken property without due process.<sup>140</sup> Moreover, if the state did not provide an inverse condemnation proceeding, the intellectual property holder could then pursue action under the Fourteenth Amendment.<sup>141</sup>

These remedies may provide insufficient monetary relief and may involve other procedural obstacles.<sup>142</sup> For example, suits against state officials under tort law or for taking property without due compensation could be barred by qualified immunity provided by the state to its officers.<sup>143</sup> The insufficiency of monetary damages and the procedural obstacles could make it cost prohibitive for a plaintiff to seek a legal remedy against ongoing or prospective infringement. On the other hand, an equitable remedy could allow a plaintiff to prevent ongoing or future violations of intellectual property by a state without having to re-litigate each violation. Such a remedy is available by bringing suit against a state official under the *Ex parte Young* doctrine.<sup>144</sup>

<sup>134</sup> Jesse H. Choper & John C. Yoo, *Effective Alternatives to Causes of Action Barred by the Eleventh Amendment*, 50 N.Y.L. SCH. L. REV. 715 (2005–2006); See also Valentine, *supra* note 1, at 186–87 (“An IP owner may, however, be able to obtain at least partial relief in a number of ways. The alternative mechanisms of relief include: seeking an injunction under the *Ex parte Young* doctrine, suing for inverse condemnation, utilizing state tort law, suing on a breach of license/contract theory, suing a municipality rather than a State, suing State officers directly, and having the United States sue the State on the right holder’s behalf.”).

<sup>135</sup> Valentine, *supra* note 1, at 186.

<sup>136</sup> *Id.* at 188.

<sup>137</sup> *Id.* at 189.

<sup>138</sup> *Id.* at 192.

<sup>139</sup> *Id.* at 193.

<sup>140</sup> *Id.* at 188.

<sup>141</sup> *Id.*

<sup>142</sup> *Id.* at 189.

<sup>143</sup> *Id.* at 187.

<sup>144</sup> *Id.*

III. EVOLUTION OF THE *EX PARTE YOUNG* DOCTRINE

The *Ex parte Young* doctrine is a judicially created exception which allows a plaintiff to overcome state sovereign immunity to obtain prospective injunctive relief. However, recent Supreme Court decisions have placed significant limitations on the availability of this remedy.

A. *The Original Ex Parte Young Doctrine*

In *Ex parte Young*, the Minnesota railroad and warehouse commission fixed the rates for carriage of certain types of merchandise between stations in the State of Minnesota.<sup>145</sup> Violations of the commission's provisions were punishable with severe fines ranging from \$2,500 to \$10,000 for each offense.<sup>146</sup> The fines could be assessed against the railroad company officials or the railroad corporation.<sup>147</sup> The railroad companies adopted the rates even though they were lower than prevailing rates.<sup>148</sup> Subsequently, the Minnesota legislature enacted legislation to reduce passenger tariffs.<sup>149</sup> Violators of the passenger tariff reduction act could face fines up to \$5,000 or imprisonment for five years.<sup>150</sup> The railroad companies implemented the new passenger rates as well.<sup>151</sup> The Minnesota legislature went on to reduce the freight rates for certain commodities excluded from previous legislation. The railroad officials were required to publish and adhere to the new rates or face imprisonment for ninety days.<sup>152</sup>

The third rate reduction was the last straw. The railroad companies filed suit against the Attorney General of Minnesota in federal court seeking an injunction against state enforcement of all rate reductions.<sup>153</sup> The district court agreed that the rate reductions enacted by the state legislature provided insufficient compensation for the services performed by the railroad.<sup>154</sup> However, it noted that the railroad companies had already accepted the first two rate reductions.<sup>155</sup> Consequently, the court granted a preliminary injunction prohibiting the state Attorney General from enforcing the third rate reduction.<sup>156</sup> The Attorney General disregarded the district court injunction and obtained a state court order against the railroad company to enforce the new

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<sup>145</sup> *Ex parte Young*, 209 U.S. 123, 127 (1908).

<sup>146</sup> *Id.*

<sup>147</sup> *Id.*

<sup>148</sup> *Id.*

<sup>149</sup> *Id.*

<sup>150</sup> *Id.* at 128.

<sup>151</sup> *Id.* at 127-28.

<sup>152</sup> *Id.* at 128.

<sup>153</sup> *Id.* at 129.

<sup>154</sup> *Id.* at 133.

<sup>155</sup> *Id.*

<sup>156</sup> *Id.*



rates.<sup>157</sup> The district court then issued an order holding the Attorney General in contempt.<sup>158</sup> In response, the Attorney General petitioned the Supreme Court claiming that he was not subject to the district court's jurisdiction because of state sovereign immunity under the Eleventh Amendment.<sup>159</sup>

There were two questions before the Supreme Court:

1. Did the rate reduction acts of the Minnesota legislature violate the constitutional due process requirements?<sup>160</sup>
2. Did the Eleventh Amendment prevent the railroad companies from seeking a federal court injunction against the state Attorney General?<sup>161</sup>

On the first question, the Supreme Court held that the acts of the Minnesota legislature were invalid on their face.<sup>162</sup> The Court found that the penalties for violation of the rate acts were so severe that the railroad companies could face financial ruin if they challenged the act in court and lost.<sup>163</sup> The Court declared that the unavailability of practical means to challenge the rate reductions enacted by the state legislature rendered these acts unconstitutional.<sup>164</sup>

In response to the Eleventh Amendment inquiry, the Court relied on its precedent which stated that "the Circuit Courts of the United States will restrain a state officer from executing an unconstitutional statute of the State, when to execute it would violate rights and privileges of the complainant which had been guaranteed by the Constitution, and would work irreparable damage and injury to him."<sup>165</sup> The Court held that the Eleventh Amendment could not be used to shield state actors whose official acts violated the Constitution.<sup>166</sup> However, the opinion made clear that the state officer named in the suit must have some connection with the enforcement of the unconstitutional state act.<sup>167</sup> Such a connection was required to avoid subjecting a state to suit in federal court by proxy simply by naming any state official as party to the suit.<sup>168</sup> The Court also indicated that it was irrelevant whether the connection of the state official "[arose] out of the general law, or [was] specially created by the [state] act itself."<sup>169</sup>

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<sup>157</sup> *Id.*

<sup>158</sup> *Id.*

<sup>159</sup> *Id.* at 141.

<sup>160</sup> *Id.* at 144.

<sup>161</sup> *Id.* at 149.

<sup>162</sup> *Id.* at 148.

<sup>163</sup> *Id.* at 130.

<sup>164</sup> *Id.* at 148.

<sup>165</sup> *Id.* at 152 (citing *Osborn v. Bank of U.S.*, 22 U.S. (9 Wheat.) 738 (1824)).

<sup>166</sup> *Id.* at 150–157.

<sup>167</sup> *Id.* at 157.

<sup>168</sup> *Id.*

<sup>169</sup> *Id.*

*B. Limitations On the Ex Parte Young Doctrine*

The evolution of the Supreme Court's Eleventh Amendment jurisprudence has limited the scope of the *Ex parte Young* doctrine. *Seminole Tribe* provided the first major limitation. That case involved a suit by the Seminole Tribe of Florida against the governor of Florida.<sup>170</sup> The tribe requested an injunction to force the state to negotiate with it.<sup>171</sup> However, the Supreme Court held that the *Ex parte Young* doctrine was not available to the tribe.<sup>172</sup> Congress had provided for a "carefully crafted and intricate remedial scheme" under section 2710(d)(7) of the IGRA statute.<sup>173</sup> The statutory remedy consisted of a court order directing the state and the tribe to negotiate a compact within sixty days.<sup>174</sup> If the parties failed to do so, the only further remedy was for both parties to submit their proposals to a mediator who would select one of the proposals.<sup>175</sup> The Court noted that the *Ex parte Young* injunction provided many options including holding the state official in contempt.<sup>176</sup> In contrast, the remedy provided by Congress under IGRA was much more limited.<sup>177</sup> Consequently, the Court declared that the *Ex parte Young* remedy was unavailable where Congress had provided a detailed remedial scheme to enforce statutorily created rights.<sup>178</sup>

The *Ex parte Young* doctrine was further limited by the Court's decision in *Idaho v. Coeur d'Alene Tribe of Idaho*.<sup>179</sup> The Coeur d'Alene Tribe of Idaho sued the State of Idaho, state officials and agencies in a dispute over ownership of land surrounding and submerged under Lake Coeur d'Alene.<sup>180</sup> The tribe challenged the validity of Idaho laws which regulated the use and occupancy of the disputed land.<sup>181</sup> They asked for a declaratory judgment awarding them its exclusive use, occupancy and quiet enjoyment.<sup>182</sup> The tribe also asked for an injunction against the state officials to prevent further regulation of the disputed land.<sup>183</sup> The State of Idaho claimed sovereign immunity under the Eleventh Amendment.<sup>184</sup>

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<sup>170</sup> *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44, 51 (1996).

<sup>171</sup> *Id.* at 73.

<sup>172</sup> *Id.* at 47.

<sup>173</sup> *Id.* at 73–74. See *supra* notes 88–98 and accompanying text.

<sup>174</sup> *Id.* at 74.

<sup>175</sup> *Id.*

<sup>176</sup> *Id.* at 75.

<sup>177</sup> *Id.*

<sup>178</sup> *Id.*

<sup>179</sup> 521 U.S. 261 (1997).

<sup>180</sup> *Id.* at 265.

<sup>181</sup> *Id.*

<sup>182</sup> *Id.*

<sup>183</sup> *Id.*

<sup>184</sup> *Id.*

The Supreme Court first reiterated its longstanding holding that the Eleventh Amendment barred the tribe's suits in law and equity against a state in federal court.<sup>185</sup> The Court also upheld "the continuing validity of the *Ex parte Young* doctrine."<sup>186</sup> However, the plurality opinion narrowed the availability of the doctrine by requiring a case-by-case balancing of state and federal interests.<sup>187</sup> The Court held that the Coeur d'Alene Tribe's claim on the disputed land was akin to a quiet title action prohibited by the Eleventh Amendment.<sup>188</sup> Moreover, the Court concluded that the affront to state sovereignty and political authority far exceeded the federal interest served by applying the *Ex parte Young* doctrine.<sup>189</sup> Therefore, the Court held that the tribe could not use the *Ex parte Young* doctrine to quiet title to the submerged lands.<sup>190</sup>

Only two justices supported the case-by-case balancing articulated in *Coeur d'Alene* although five justices joined to affirm the Court's decision.<sup>191</sup> The Supreme Court appears to have retreated from this case-by-case balancing approach. In a 2002 decision, *Verizon Maryland, Inc. v. Public Service Commission*,<sup>192</sup> a plurality of the Court declared that only a "straightforward inquiry into whether [the] complaint alleges an ongoing violation of federal law and seeks relief properly characterized as prospective" is needed.<sup>193</sup>

A majority of the circuit courts of appeal have adopted the *Verizon Maryland* inquiry. There do not appear to be any cases on point in the First Circuit and the D.C. Circuit. The Second Circuit has adopted the "straightforward inquiry" test from *Verizon Maryland* but has continued to assess whether any state sovereignty interests are affected under *Coeur d'Alene*.<sup>194</sup> The Fourth Circuit had adopted the case-by-case balancing approach immediately after *Coeur d'Alene* was decided.<sup>195</sup> However, more recently the Fourth Circuit has also adopted the "straightforward inquiry" approach from *Verizon Maryland*.<sup>196</sup> All other circuit courts of appeal have adopted the "straightforward inquiry" of *Verizon Maryland* over the case-by-case balancing approach of *Coeur d'Alene*.<sup>197</sup>

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<sup>185</sup> *Id.* at 269.

<sup>186</sup> *Id.*

<sup>187</sup> *Id.* at 280.

<sup>188</sup> *Id.* at 281.

<sup>189</sup> *Id.* at 281–87.

<sup>190</sup> *Id.* at 287.

<sup>191</sup> *Id.* at 288.

<sup>192</sup> 535 U.S. 635 (2002).

<sup>193</sup> *Id.* at 645 (quoting *Coeur d'Alene*, 521 U.S. at 296).

<sup>194</sup> *In re Dairy Mart Convenience Stores, Inc.*, 411 F.3d 367, 372 (2nd Cir. 2005).

<sup>195</sup> *CSX Transp. Inc. v. Bd. of Pub. Works*, 40 F. App'x. 800, 803–05 (4th Cir. 2002).

<sup>196</sup> *Constantine v. Rectors & Visitors of George Mason Univ.*, 411 F.3d 474, 496 (4th Cir. 2005).

<sup>197</sup> *See Pennington Seed, Inc. v. Produce Exch. No. 299*, 457 F.3d 1334, 1341 (Fed. Cir. 2006); *Koslow v. Pennsylvania*, 302 F.3d 161, 178 (3d Cir. 2002); *McCarthy ex rel.*

C. *Current State of the Ex Parte Young Doctrine*

The decisions in *Seminole Tribe*, *Coeur d'Alene*, and *Verizon Maryland* lead to the following summary of the Supreme Court's *Ex parte Young* jurisprudence:

1. The *Ex parte Young* doctrine continues to be available to plaintiffs who want to obtain prospective injunctive relief when a state or its agencies violate a federal law or the Constitution. The plaintiffs must show that the named state official has some connection with the enforcement of the state law which led to the violation of plaintiff's rights.

2. The *Ex parte Young* remedy is not available where Congress has created a detailed remedial scheme to compensate plaintiffs for violations of a federal law by a state.

3. A straightforward inquiry is needed to determine whether the plaintiff is seeking prospective injunctive relief in invoking the *Ex parte Young* doctrine. A case-by-case balancing of state and federal interests is not required. However, the *Ex parte Young* remedy cannot be used to quiet title to land in a suit against a state.

It is noteworthy that the Supreme Court has not clearly defined the scope of the connection between a state official and the alleged violation required for an *Ex parte Young* injunction. This has led to an inconsistent application of the doctrine in federal courts. It is instructive to evaluate the standards used by different federal courts to assess plaintiff's *Ex parte Young* claims.

IV. FEDERAL COURT STANDARDS TO ASSESS *EX PARTE YOUNG* CLAIMS

A. *The Tenth Circuit's Four-Factor Test*

The Tenth Circuit articulated a four-factor test to determine whether private irrigation districts were entitled to an *Ex parte Young* injunction against officials of the State of New Mexico.<sup>198</sup> The State of New Mexico entered into a contract with irrigation districts to provide water for agriculture under a federal land reclamation statute.<sup>199</sup> In the contract, the state assigned all profits from the reclaimed land to the irrigation

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Travis v. Hawkins, 381 F.3d 407, 416 (5th Cir. 2004); Dubuc v. Mich. Bd. of Law Exam'rs, 342 F.3d 610, 616–17 (6th Cir. 2003); Entm't Software Ass'n v. Blagojevich, 469 F.3d 641, 645 (7th Cir. 2006); Dakota, Minn. & E. R.R Corp. v. South Dakota, 362 F.3d 512, 517 (8th Cir. 2004); Miranda B. v. Kitzhaber, 328 F.3d 1181, 1189 (9th Cir. 2003); Hill v. Kemp, 478 F.3d 1236, 1258–59 (10th Cir. 2007); MCI Telecomms. Corp. v. BellSouth Telecomms. Inc., 298 F.3d 1269, 1272 (11th Cir. 2002).

<sup>198</sup> Elephant Butte Irrigation Dist. v. Dep't of the Interior, 160 F.3d 602, 609 (10th Cir. 1998).

<sup>199</sup> *Id.* at 605.

districts.<sup>200</sup> Subsequently, the federal government entered into a lease agreement with the State of New Mexico to establish public recreation facilities on parts of the irrigated land.<sup>201</sup> In this lease, the federal government assigned all profits from the recreation facilities to the State of New Mexico.<sup>202</sup> The lease agreement violated the state's prior contract with the irrigation districts and created a dispute about the disbursement of profits.<sup>203</sup> The irrigation districts sued state officials under the *Ex parte Young* doctrine to enjoin them from appropriating future profits from the recreation facilities.<sup>204</sup> The Tenth Circuit used the following four factors to assess the validity of the *Ex parte Young* claim:<sup>205</sup>

1. Was plaintiff's action against state officials or the state?
2. Did the alleged conduct of the state officials constitute a violation of federal law, or was it merely tortious interference with plaintiff's property rights?
3. Was the relief requested by the plaintiff permissible prospective relief or was it analogous to a retroactive award of damages impacting the state treasury?
4. Did the plaintiff's suit implicate special sovereignty interests and was the requested remedy otherwise barred by the Eleventh Amendment?

The first inquiry assessed whether plaintiff's suit was initiated against state officials whose state authorized conduct had violated federal law.<sup>206</sup> In the instant suit, the named officials had signed the subsequent lease agreement with the federal government on behalf of the State of New Mexico.<sup>207</sup> These official actions violated the prior contract allocating all profits to the irrigation districts under the federal land reclamation act.<sup>208</sup> Thus, the plaintiff's claim for an injunction was correctly directed at the state officials to enjoin them from appropriating future profits.<sup>209</sup>

The second inquiry assessed whether the plaintiffs had alleged a non-frivolous, substantial claim for relief from infringement of federal rights by state officials.<sup>210</sup> In this case, the irrigation districts had alleged that the lease agreement between the federal government and the state violated existing federal law.<sup>211</sup> The federal land reclamation act was violated not only when the subsequent lease was signed but also every

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<sup>200</sup> *Id.*

<sup>201</sup> *Id.* at 606.

<sup>202</sup> *Id.*

<sup>203</sup> *Id.*

<sup>204</sup> *Id.*

<sup>205</sup> *Id.* at 609.

<sup>206</sup> *Id.*

<sup>207</sup> *Id.*

<sup>208</sup> *Id.*

<sup>209</sup> *Id.* at 610.

<sup>210</sup> *Id.*

<sup>211</sup> *Id.*

time the state appropriated profits under the terms of the lease.<sup>212</sup> Thus, this inquiry was satisfied because the plaintiff's allegation contained a substantive question about the validity of the subsequent lease agreement.<sup>213</sup>

The third inquiry assessed whether the requested relief was against future, rather than past, harm.<sup>214</sup> The court held that the injunction requested by the plaintiff was prospective because it only prevented the state from collecting profits in the future.<sup>215</sup> The court deemed it irrelevant that a prospective injunction could impact future revenues collected by the state treasury.<sup>216</sup> Thus the third inquiry was also satisfied in this case.<sup>217</sup>

The Tenth Circuit articulated three sub-factors to clarify the balancing test required by the fourth element.<sup>218</sup> The first sub-factor evaluated the degree to which the relief sought by the plaintiff was intrusive on state sovereignty.<sup>219</sup> The court pointed out that New Mexico's interest in future profits was significantly less intrusive on state sovereignty than the quiet title claim in *Coeur d'Alene*.<sup>220</sup> The second sub-factor assessed the degree to which the remedy sought by the plaintiff created an affront to the state political authority.<sup>221</sup> Only a remedy which had minimal effect on the sovereignty and autonomy of the state was permissible.<sup>222</sup> The court held that the irrigation districts' claims for future profits had a minimal effect on the sovereignty and autonomy of the State of New Mexico.<sup>223</sup> The court reasoned that depriving the state of profits affected state sovereignty to a much smaller degree than divesting the state of possession of submerged lands as in *Coeur d'Alene*.<sup>224</sup> The third sub-factor evaluated whether the interest in vindicating federal rights substantially outweighed the imposition on the dignity and status of the state as a sovereign government.<sup>225</sup> The court held that preserving the federal rights of the irrigation districts did not outweigh the status of New Mexico as a sovereign government.<sup>226</sup>

The first three factors captured the essence of the *Ex parte Young* doctrine prior to the *Coeur d'Alene* decision. The Tenth Circuit's fourth

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<sup>212</sup> *Id.*

<sup>213</sup> *Id.* at 611.

<sup>214</sup> *Id.*

<sup>215</sup> *Id.*

<sup>216</sup> *Id.*

<sup>217</sup> *Id.*

<sup>218</sup> *Id.* at 612.

<sup>219</sup> *Id.*

<sup>220</sup> *Id.*

<sup>221</sup> *Id.* at 613.

<sup>222</sup> *Id.*

<sup>223</sup> *Id.*

<sup>224</sup> *Id.*

<sup>225</sup> *Id.*

<sup>226</sup> *Id.*

factor was based on the case-by-case balancing approach articulated in the Supreme Court's plurality opinion on *Coeur d'Alene*. The Supreme Court's subsequent decision in *Verizon Maryland* suggests that this factor should no longer apply to *Ex parte Young* assessments.

#### B. *The Fifth Circuit's Test*

The Fifth Circuit has articulated the following factors to assess the validity of a plaintiff's *Ex parte Young* claims:

1. Was the state official named in the suit responsible for enforcing the state law which violated federally guaranteed rights?<sup>227</sup>
2. Did the named state official threaten to enforce the state law?<sup>228</sup>
3. Did the complaint allege an ongoing violation of federal law and seek relief properly characterized as prospective?<sup>229</sup>

The first two factors are based on *Ex parte Young* in which the Supreme Court stated that:

[I]ndividuals, who, as officers of the State, are clothed with some duty in regard to the enforcement of the laws of the State, and who threaten and are about to commence proceedings, either of a civil or criminal nature, to enforce against parties affected an unconstitutional act, violating the Federal Constitution, may be enjoined by a Federal court of equity from such action.<sup>230</sup>

The first two factors require a very specific connection between the named state official and the violation of federal law. They require that the named officials must be responsible for their state sanctioned conduct and also be willing to exercise their authority. The Tenth Circuit, in contrast, required only that the state officials be directly connected with the alleged violation. It did not require an impending threat of prospective violation by the state officials. The Fifth Circuit's second inquiry is a combination of the second and third factors articulated by the Tenth Circuit. The Fifth Circuit rejected the case-by-case analysis of *Coeur d'Alene* noting that a majority of the Supreme Court justices had rejected it.<sup>231</sup>

#### C. *The Test Approved by the Sixth Circuit*

The United States District Court of the Southern District of Ohio articulated a two-factor test to assess plaintiff's claims under the *Ex parte*

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<sup>227</sup> Okpalobi v. Foster, 244 F.3d 405, 415 (2001).

<sup>228</sup> *Id.*

<sup>229</sup> MCI Telecomm. Corp. v. Bell Atlantic-Pennsylvania, 271 F.3d 491, 507–08 (3d Cir. 2001) (citing AT&T Commc'ns. v. BellSouth Telecomms. Inc., 238 F.3d 636, 648–49 (5th Cir. 2001)).

<sup>230</sup> *Ex parte Young*, 209 U.S. at 155–56.

<sup>231</sup> *AT&T Commc'ns.*, 238 F.3d at 648–49.

*Young* doctrine.<sup>232</sup> Like the Fifth Circuit, the district court required likelihood that the state officer will enforce the state law.<sup>233</sup> However, unlike the Fifth Circuit, the district court embraced the Supreme Court's case-by-case analysis in *Coeur d'Alene*.<sup>234</sup> The two factors enunciated by the district court are:

1. Did the state official named in plaintiff's suit have a connection with the enforcement of the challenged statute?<sup>235</sup> Was there a real, not ephemeral, likelihood that the enforcement will be employed against plaintiff's interests?<sup>236</sup>

2. Did plaintiff's claim strike "[a] proper balance between the *Ex parte Young* sword and the Eleventh Amendment shield," accounting for the relationship between the challenged state statute, state officials, and the plaintiff?<sup>237</sup>

The *Ex parte Young* issue was not raised by the litigants in their appeal to the Sixth Circuit. However, the Sixth Circuit approved the district court's analysis without comment in a footnote in its opinion.<sup>238</sup> Note that the district court's first inquiry was similar to that of the Fifth Circuit. However, the court's inquiry was more nuanced in that it only asked whether it was likely that the state official would enforce the state law.<sup>239</sup> In contrast, the Fifth Circuit required a demonstrated willingness by the state official to enforce the state law.<sup>240</sup>

The district court's second inquiry was based on the case-by-case balancing approach of *Coeur d'Alene*. The district court's second inquiry envisioned a continuum bounded by two extremes.<sup>241</sup> One extreme consisted of the plaintiff's challenge to the constitutionality of a state statute governing the interaction between two private parties.<sup>242</sup> The other end of the continuum was bounded by suits where the plaintiff challenged a state statute which directly controlled plaintiff's rights.<sup>243</sup> The district court held that an *Ex parte Young* claim would be valid in cases which lay closer to this latter bound of the continuum.<sup>244</sup> Note that the district court decision predated the Supreme Court's rejection of the case-by-case balancing in *Verizon Maryland*.

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<sup>232</sup> *Allied Artists Pictures Corp. v. Rhodes*, 473 F. Supp. 560, 568 (S.D. Ohio 1979).

<sup>233</sup> *Id.*

<sup>234</sup> *Id.*

<sup>235</sup> *Id.*

<sup>236</sup> *Id.*

<sup>237</sup> *Id.*

<sup>238</sup> *Allied Artists Pictures Corp. v. Rhodes*, 679 F.2d 656, 665 (1982).

<sup>239</sup> *Allied Artists*, 473 F. Supp. at 565.

<sup>240</sup> *Okpalobi*, 244 F.3d at 416.

<sup>241</sup> *Allied Artists*, 473 F. Supp. at 568.

<sup>242</sup> *Id.*

<sup>243</sup> *Id.*

<sup>244</sup> *Id.*



*D. Generic Test Used by Other Circuit Courts of Appeal*

None of the other circuit courts of appeal have developed specific tests to determine whether a suit by a private party can be initiated against state officials in their official capacities. They have simply adopted the *Verizon Maryland* test, which requires “a straightforward inquiry into whether the complaint alleges an ongoing violation of federal law and seeks relief properly characterized as prospective.”<sup>245</sup> They have also not articulated any guidelines to assess the connection between the named state official and the alleged violation of federal law.

## V. NEW TEST TO ASSESS EX PARTE YOUNG CLAIMS

A structured approach for analyzing plaintiff’s claims for prospective injunctive relief can be fashioned out of the tests articulated by the federal courts. The factors articulated by the Fifth, Sixth, and Tenth Circuit courts of appeal were derived from cases where a state law violated a federal law or the Constitution. The application of *Ex parte Young* to intellectual property suits is different, because it is premised on a state official’s violation of rights guaranteed by the federal patent, copyright or trademark statutes.

I propose a new three-element test to determine whether a plaintiff may obtain equitable relief from state infringement of intellectual property under the *Ex parte Young* doctrine. The test is based on the factors articulated by the Fifth and Tenth Circuit courts of appeal. The three elements of the test are:

1. Does the alleged conduct of the defendant state official constitute a violation of federal intellectual property statutes, or is it merely a tortious interference with the plaintiff’s property rights?
2. Is the relief sought by the plaintiff permissible prospective relief or is it analogous to a retroactive award of damages impacting the state treasury?
3. Is there sufficient connection between the defendant state official and the alleged violation of plaintiff’s intellectual property rights? The two sub-elements which must be met to establish a sufficient connection are:
  - a. Did the defendant state official violate plaintiff’s intellectual property rights as part of his state-sanctioned duties?
  - b. Did the state official threaten conduct which would infringe plaintiff’s intellectual property rights?

The test encompasses the current scope of the *Ex parte Young* doctrine as articulated by the Supreme Court. The test also provides a structured approach for assessing the availability of an injunction against state infringement of a patent, copyright or trademark. The first two

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<sup>245</sup> *Verizon Md., Inc. v. Public Service Comm’n*, 535 U.S. 635, 645 (2002).

elements of the proposed test capture the essence of the original *Ex parte Young* doctrine that a state official who violates a federal law may be enjoined in federal court. The third element of the test addresses the connection requirement inherent in the *Ex parte Young* doctrine. The Supreme Court required in *Ex parte Young* that the connection must be such that a plaintiff cannot subject a state to suit by proxy simply by naming any state official as party to the suit.<sup>246</sup> The inclusion of an explicit connection requirement in the test achieves this purpose.

Both the Fifth and the Sixth Circuit courts of appeal had articulated ways to assess the connection between the state official and the alleged violation of federal law. I rejected the Sixth Circuit's more nuanced formulation requiring a mere likelihood of infringement. I selected the more stringent Fifth Circuit requirement for two reasons. First, an *Ex parte Young* remedy can only be invoked to obtain an injunction against ongoing or prospective violations. Merely requiring a "likelihood of infringement" does not address the possibility of ongoing infringement. Second, it is much more difficult to show that a state official is likely to infringe plaintiff's rights than showing that the violation is ongoing or that there is an imminent threat of infringement. Therefore, I selected the two sub-elements articulated by the Fifth Circuit because they provide the most structured method of establishing the requisite connection.

I applied the proposed test to the facts of two cases to demonstrate its application and evaluate its effectiveness. The two cases selected are *Pennington Seed*, which is a patent infringement suit, and *Hairston*, which is a copyright infringement suit. In the patent infringement case, the court had dismissed plaintiff's *Ex parte Young* claim during a pre-trial motion by the defendant. However, in the copyright infringement case, the plaintiff's *Ex parte Young* claims survived defendant's motion to dismiss and were allowed to go to trial. Application of the test to these cases with opposite outcomes demonstrates the effectiveness of the test. An analysis of the two cases using the new test also illustrates how plaintiffs should draft their *Ex parte Young* complaints to survive pre-trial judicial scrutiny.

#### A. Application of the New Test to a Patent Infringement Suit

I applied the new test to the *Pennington Seed* case to demonstrate its application to a situation where a state infringes plaintiff's patent. The facts of this case were described earlier in this Comment but are repeated here for clarity. Pennington Seed markets AgResearch's patented fescue grass seed under a license agreement.<sup>247</sup> Pennington Seed alleged that the university and its officials were "actively growing, marketing, offering for sale, promoting and selling a product containing" its patented

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<sup>246</sup> *Ex parte Young*, 209 U.S. at 157.

<sup>247</sup> *Pennington Seed*, 457 F.3d at 1338.

seeds.<sup>248</sup> Pennington Seed also sought an *Ex parte Young* injunction against the president, the chairman of the board, and a professor of the university to prevent future violations of the patent.<sup>249</sup> The district court granted the university's motion to dismiss holding that Pennington Seed had failed to allege a causal connection between the officials and the alleged patent infringement.<sup>250</sup> The CAFC affirmed the district court's decision. The new three-element test is applied to the facts of this case to determine if these decisions correctly denied Pennington Seed an *Ex parte Young* injunction.

Pennington Seed's complaint satisfied the first element of my test. The first element evaluates whether the defendant state officials violated a federal law or the Constitution. The Supreme Court stated in the *Florida Prepaid* decision that a state's infringement of a patent was not per se unconstitutional.<sup>251</sup> However, section 271 of Title 35 of the United States Code holds that anyone who uses or sells a patented invention infringes the patent.<sup>252</sup> Thus, Pennington Seed's complaint that the university officials used or sold its patented seeds was sufficient to allege a violation of the patent statute.

Pennington Seed's complaint satisfied the second element of my test. The second element evaluates whether the remedy sought by the plaintiff is prospective or retrospective. The remedy sought by Pennington Seed was an injunction against future infringement of the patent on the fescue grass seed.<sup>253</sup> If the injunction was granted, the university would be unable to sell and profit from the patented seeds. The Supreme Court has allowed an *Ex parte Young* injunction even if it impacts the state treasury by denying future profits.<sup>254</sup> Thus, Pennington Seed's request for a prospective injunction satisfied the second element of the new test.

Pennington Seed's complaint did not satisfy the third element of my test. The third element assesses the connection between the defendant state officials and the alleged patent infringement. The first sub-element inquires whether the named state officials were responsible for conduct which infringed the plaintiff's patent. The facts of this case merely allege that the university officials were "actively growing, marketing, offering for sale, promoting and selling a product containing" the patented seeds.<sup>255</sup> There is nothing in the record to show that the official duties of the president, chairman of the board, and the professor included growing, selling and marketing the patented seeds. Thus, Pennington Seed's complaint failed to satisfy the first sub-element. The second sub-element

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<sup>248</sup> *Id.*

<sup>249</sup> *Id.* at 1337–1338.

<sup>250</sup> *Id.* at 1338.

<sup>251</sup> *Fla. Prepaid*, 527 U.S. at 643.

<sup>252</sup> 35 U.S.C. § 271 (2000).

<sup>253</sup> *Pennington Seed*, 457 F.3d at 1337.

<sup>254</sup> *Edelman*, 415 U.S. at 667–68.

<sup>255</sup> *Pennington Seed*, 457 F.3d at 1338.

inquires whether the named officials had demonstrated a willingness to continue violating the patent. Pennington Seed's complaint may satisfy this sub-element because the complaint alleges that the infringement activity was ongoing. However, because Pennington's complaint did not satisfy the first sub-element, it failed to satisfy the third element of my test.

Pennington Seed could not prevail on its *Ex parte Young* claim because it failed to show that the official duties of the defendant actors required them to infringe its patent. The lack of connection between the named officials and the alleged infringement was precisely the reason cited by the CAFC when it dismissed Pennington Seed's complaint.<sup>256</sup> The analysis under the third element of the new test provides guidance on how Pennington Seed could have drafted its complaint to survive defendant's motion to dismiss. Pennington Seed should have clearly identified the duties of the named university officials which allowed them to grow or sell the patented seed. Alternatively, Pennington Seed should have named university officials who were directly responsible for authorizing the use and sale of the patented seeds.

*B. Application of the New Test to a Copyright Infringement Suit*

I applied the new test to the *Hairston* case to demonstrate its application to a situation where a state infringes plaintiff's copyright. The facts of the case are repeated here for clarity. In this case, Hairston had taken a photograph titled "The Greensboro Four."<sup>257</sup> The photograph was reproduced on football program literature sold by the North Carolina Agricultural & Technical State University at its football games.<sup>258</sup> The district court held that the university enjoyed sovereign immunity under the Eleventh Amendment because it was an agency of the State of North Carolina.<sup>259</sup> Therefore, the court dismissed Hairston's claims of copyright infringement.<sup>260</sup> However, the court upheld Hairston's *Ex parte Young* actions against the chancellor, vice chancellor and the associate chancellor for development and university relations.<sup>261</sup> The court did not address whether these officials were sufficiently connected with the alleged copyright infringement.<sup>262</sup> Nevertheless, the court allowed the *Ex parte Young* action to proceed, citing the *Salerno* decision.<sup>263</sup> The new three-element test is applied to the facts of this case to determine if the

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<sup>256</sup> *Id.* at 1343.

<sup>257</sup> *Hairston v. N. C. Agric. & Technical State Univ.*, No. 1:04 CV 1203, 2005 WL 2136923 at \*2 (M.D.N.C. Aug. 5, 2005).

<sup>258</sup> *Id.*

<sup>259</sup> *Id.* at \*3.

<sup>260</sup> *Id.*

<sup>261</sup> *Id.* at \*8.

<sup>262</sup> *Id.*

<sup>263</sup> *Id.*

court correctly allowed Hairston's *Ex parte Young* claims to proceed to trial.

Hairston's complaint against the associate chancellor satisfied the first element of my test. The first element inquires whether the actions of the state officials violated a federal law or the Constitution. Section 501(a) of title 17 of the United States Code holds that anyone who violates the exclusive rights of a copyright owner infringes the copyright.<sup>264</sup> Hairston's complaint alleged that the associate chancellor used his copyrighted photograph in the school's printed football programs without his permission.<sup>265</sup> Thus, his complaint satisfies the first element because it alleges a violation of the federal copyright statute.

Hairston's complaint against the associate chancellor satisfied the second element of my test. The second element evaluates whether the remedy sought by the plaintiff was prospective or retrospective. Hairston's complaint prayed for an injunction against "publishing, selling, marketing or otherwise disposing of any copies of [his copyrighted] photograph."<sup>266</sup> His complaint did not seek money damages for past violations of his copyright. Thus, Hairston's complaint for injunctive relief was prospective and satisfied the second element of the test.

Hairston's complaint against the associate chancellor satisfied the third element of my test. The third element assesses the connection between the defendant state officials and the alleged copyright infringement. Hairston's complaint alleged that the associate chancellor sought his permission to use the photograph and used the photograph even though Hairston denied permission.<sup>267</sup> Moreover, decisions on the content of promotional literature may reasonably be expected to be part of the duties of an official responsible for university relations. Thus, Hairston's complaint alleging that the associate chancellor violated the federal copyright statute was sufficient to satisfy the first sub-element. The associate chancellor sought permission from Hairston to use his photograph. This indicates that she may have been aware that Hairston owned the copyright on the photograph. Her use of the photograph without Hairston's permission demonstrated her willingness to infringe his copyright. There is nothing in the record to show that the university took any steps to stop future use of the photograph. Thus, Hairston's complaint was sufficient to satisfy the second sub-element. Hairston's complaint alleged an ongoing infringement and sufficiently connected the associate chancellor with the infringement. Therefore, the *Ex parte Young* claim against the associate chancellor satisfied the third element of the proposed test. Thus, the district court correctly allowed Hairston's *Ex parte Young* claim against the associate chancellor to proceed to trial.

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<sup>264</sup> 17 U.S.C. § 501(a) (2000).

<sup>265</sup> Complaint at 3–4, Hairston, 2004 WL 3123499 (No. 1:04CV01203).

<sup>266</sup> *Id.* at 5.

<sup>267</sup> *Id.* at 3–4.

Hairston's complaint, however, did not contain sufficient evidence to similarly connect the chancellor and the vice chancellor to the alleged copyright infringement. There is nothing in the record to show that the chancellor and the vice chancellor knew about Hairston's copyright. There is also nothing in the complaint to show that they used the photograph or authorized its use even though they knew that it was copyrighted. Therefore, the district court should have dismissed Hairston's *Ex parte Young* claims against the chancellor and the vice chancellor.

It is apparent from the two examples discussed above that the first two elements of the proposed test may be relatively easy to satisfy in a case where a state infringes intellectual property. However, the third element requires showing a specific connection between the defendant state official and the alleged intellectual property infringement. A comparison of the two applications highlights the importance of drafting complaints with the *Ex parte Young* test in mind. The plaintiff in *Pennington Seed* did not show how the university officials were connected with growing and selling the patented seeds. The CAFC therefore properly dismissed Pennington Seed's *Ex parte Young* claims. On the other hand, the plaintiff in *Hairston* specifically showed how the associate chancellor was connected to the copyright infringement. Application of the proposed test demonstrates that Hairston was likely to prevail on his *Ex parte Young* claim against the associate chancellor. It also shows that Hairston was not likely to prevail on his *Ex parte Young* claims against the chancellor and the vice chancellor.

## VI. CONCLUSION

The *Seminole Tribe* and *Florida Prepaid* decisions have dealt a mortal blow to congressional ability to abrogate state sovereign immunity against intellectual property infringement actions. Legislation to overcome the constitutional hurdles erected by the Supreme Court has been proposed but is yet to be enacted into law.<sup>268</sup> Moreover, there is significant commentary which indicates that the proposed legislation, if enacted, may not survive constitutional scrutiny by the Supreme Court.<sup>269</sup> In the interim, the *Ex parte Young* doctrine can provide relief from prospective state infringement of a plaintiff's intellectual property rights. Decisions by the CAFC, circuit courts of appeal and district courts have applied unclear standards in assessing the validity of plaintiff's *Ex parte Young*

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<sup>268</sup> Brandon White, Comment, *Protecting Patent Owners From Infringement By the States: Will the Intellectual Property Rights Restoration Act of 1999 Finally Satisfy the Court?*, 35 AKRON L. REV. 531, 534 (2001–2002); Jeffrey W. Childers, Comment, *State Sovereign Immunity and the Protection of Intellectual Property: Do Recent Congressional Attempts to "Level the Playing Field" Run Afoul of Current Eleventh Amendment Jurisprudence and Other Constitutional Doctrines?*, 82 N.C.L. REV. 1067, 1072–1073 (2004).

<sup>269</sup> *Id.*

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claims. The three-element test proposed in this Comment remedies this by providing a structured and consistent analytical methodology. It also provides a framework to guide plaintiffs when drafting *Ex parte Young* complaints to make them more likely to survive pre-trial judicial scrutiny in federal courts.