NOTES

Copy-*Katz*: Sovereign Immunity, the Intellectual Property Clause, and *Central Virginia Community College v. Katz*

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In January 2006, the Supreme Court decided the relatively unheralded case of Central Virginia Community College v. Katz. *Dividing 5–4, the Court held that the history and structure of the Bankruptcy Clause of the United States Constitution indicate that it contains an implicit waiver of state sovereign immunity—that is, when states ratified the Constitution, they agreed that they would be subject to suits arising out of legislation Congress passed pursuant to the bankruptcy power. The decision was particularly intriguing because Justice O'Connor—in one of the final cases decided before her retirement—broke with the block of Justices she had traditionally voted with in sovereign immunity cases and provided the decisive vote to a new majority. The Court did not disturb its previous precedents which established (or recognized) that the several states enjoy broad, near absolute immunity from all sorts of suits. Justice Stevens's majority opinion also did not speculate as to whether the logic underlying the Court's finding of a waiver embedded in the Bankruptcy Clause might similarly apply to other constitutional clauses.*

This Note takes up that question. First, it traces the history of the broad regime of state sovereign immunity in the United States—a regime which served as a backdrop to the Katz *decision and against which any consideration of extending the Court's reasoning must be considered. Second, the Note surveys the jurisprudence of sovereign immunity waiver and abrogation and examines how and where the* Katz *decision fits. Finally, this Note takes up the logical next question that the Court left unanswered—that is, does the reasoning of* Katz, *which supports a finding of waiver embedded in the Bankruptcy Clause, apply to any other constitutional powers—and concludes that* Katz *indeed might apply to the Intellectual Property Clause. Specifically, this Note culls the elusive history of the Clause and frames an argument that a* Katz-*style sovereign immunity waiver is embedded in the Constitution's Intellectual Property Clause.*

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INTRODUCTION

Since the earliest days of the republic, the suability of states within our constitutional framework has been a hotly debated issue. Some legal minds of the Framing generation believed that any notion of state sovereign immunity—that is, that states retained a portion of their sovereignty despite joining the Union and are entitled to complete immunity from suit absent their express consent—was inconsistent with the federal system crafted by the constitutional Framers.[1] Others, however, felt that even though the Constitution does not address the issue explicitly, the notion of state sovereign immunity was an inherent principle of the constitutional plan.[2] The first constitutional amendment adopted after the Bill of Rights recognized that states enjoyed at least some

1. *See* Chisholm v. Georgia, 2 U.S. (2 Dall.) 419, 451 (1793) (Blair, J., concurring); *id.* at 465–66 (Wilson, J., concurring).

2. *See id.* at 435–37 (Iredell, J., dissenting).

degree of immunity from suit.[3] By 1890, the Supreme Court recognized that states enjoy even broader immunity than this constitutionally memorialized definition seems to provide.[4] And in the modern era, the Court has consistently held fast to the notion of states' immunity from a broad spectrum of categories of suits.[5]

Despite the fairly consistent tack that the Court's opinions have historically taken regarding state sovereign immunity, a notable feature of Supreme Court jurisprudence in this area has been the sharp division among the Justices in many of the landmark cases. Over and over, important state sovereign immunity precedent has been established by a narrow margin.[6] The 2006 decision in *Central Virginia Community College v. Katz* was no different—a narrow majority recognized that when the Framers wrote the Bankruptcy Clause into the federal Constitution, they understood it to include an implicit waiver of state sovereign immunity in suits arising under the laws that Congress would eventually enact pursuant to that power.[7]

The *Katz* decision represents a new direction in Supreme Court state sovereign immunity jurisprudence. Although the Court did not speculate as to the scope of its opinion, the reasoning of *Katz* might be equally applicable to other constitutional areas and might open a new avenue to overcoming state sovereign immunity in certain types of suits. In particular, the reasoning underlying the *Katz* decision might support an argument that a similar implicit waiver of immunity is present in the Intellectual Property Clause.[8] If so, *Katz* could prove to be a particularly important case, for the Supreme Court has blocked other attempts by patent and copyright holders to sue state parties for infringement.[9] Justice O'Connor's surprising vote with the majority in one of the last cases decided before her retirement makes the answer to this question especially uncertain.

This Note examines the history of state sovereign immunity in the United States, the role that the *Katz* decision plays in helping aggrieved parties force state parties to submit to suit, and the possibility that the reasoning of *Katz* might be applied to other Article I enumerated powers—specifically, the patent and copyright power. Part I traces the development of the modern conception of

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

4. *See* Hans v. Louisiana, 134 U.S. 1, 20–21 (1890) (holding that states enjoy immunity from suits brought by their own citizens, the language of the Eleventh Amendment notwithstanding).

5. *See, e.g.*, Alden v. Maine, 527 U.S. 706, 754 (1999); Seminole Tribe v. Florida, 517 U.S. 44, 72 (1996).

6. *See, e.g.*, *Alden*, 527 U.S. at 754 (5–4 decision); Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 647 (1999) (5–4 decision); *Seminole Tribe*, 517 U.S. at 72 (5–4 decision).

7. 546 U.S. 356 (2006).

8. U.S. CONST. art. I, § 8, cl. 8.

9. *See Fla. Prepaid*, 527 U.S. at 647; *see also* Erwin Chemerinsky, Commentary, *High Court Wrongly Lets States Off Hook; In Its Zeal To Impose New Rights, the Justices Leave Individuals Without Legal Recourse*, L.A. TIMES, June 25, 1999, at B9.

state sovereign immunity, examining its theoretical foundations and the key legislative and legal precedents that fueled its evolution. Part II then surveys the different methods of circumventing or avoiding immunity and forcing a state party to submit to suit. Part III examines the *Katz* decision and attempts to place it within the history of sovereign immunity jurisprudence. Part IV then explores whether *Katz* may be a more important decision than initially appears. Specifically, this Part examines whether the Court's reasoning might apply to other constitutional powers granted to Congress, and then discusses how to frame the argument that it does, indeed, apply to the Intellectual Property Clause. Finally, in acknowledgment of the fact that so much sovereign immunity jurisprudence has been shaped by narrowly divided Courts, this Note concludes with an examination of how an argument for the extension of *Katz* might be received by the current Court members.

I. THE SOVEREIGN IMMUNITY OF THE SEVERAL STATES

The concept of sovereign immunity in the United States was inherited from English common law, where the king was considered immune from suit in his own courts absent his consent.[10] Although jurists have long debated the precise rationale underlying the immunity of the British sovereign, the immunity of the United States from suit absent its consent has been recognized throughout the history of the republic.[11] The several states, however, also enjoy immunity from suit in federal courts owing to the sovereignty they retained in the constitutional plan. This immunity, while often more hotly debated than the immunity of the United States,[12] nonetheless has been officially recognized for most of the nation's history.[13] Although the Supreme Court members often disagreed about the existence of state sovereign immunity or the scope of the immunity that states might enjoy,[14] the Court established a line of precedent over the course of more than two centuries that rigidly protected the states' immunity from suit

10. Chisholm v. Georgia, 2 U.S. (2 Dall.) 419, 437–42, 445 (1793) (Iredell, J., dissenting).

11. *See, e.g.*, United States v. Lee, 106 U.S. 196, 207 (1882).

12. *See, e.g.*, Alden v. Maine, 527 U.S. 706, 762–64 (1999) (Souter, J., dissenting); Atascadero State Hosp. v. Scanlon, 473 U.S. 234, 258–59 (1985) (Brennan, J., dissenting).

13. *See* U.S. CONST. amend. XI; *see also* Monaco v. Mississippi, 292 U.S. 313 (1934); Hans v. Lousiana, 134 U.S. 1, 20–21 (1890). *But see Chisholm*, 2 U.S. (2 Dall.) at 420–21 (refusing to recognize state sovereign immunity). This decision was soon overruled by the adoption of the Eleventh Amendment.

The Court has consistently held, however, that sovereign immunity does *not* extend to counties, cities, or other smaller governmental entities. *See, e.g.*, Lincoln County v. Luning, 133 U.S. 529, 530 (1890). The one narrow exception that the Court has recognized is when state involvement with a municipality's actions is so pervasive that any relief will, for all practical purposes, come from the state. *See* Pennhurst State Sch. & Hosp. v. Halderman, 465 U.S. 89, 123–24 (1979). Some commentators find the Court's position regarding immunity of states versus immunity of counties and municipalities inconsistent. *See* Melvyn R. Durchslag, *Should Political Subdivisions Be Accorded Eleventh Amendment Immunity?*, 43 DEPAUL L. REV. 577, 617–18 (1994).

14. *Compare Scanlon*, 473 U.S. at 238–40, *with id.* at 258–59 (Brennan, J., dissenting), *and id.* at 304 (Stevens, J., dissenting).

absent their consent.[15]

A. THEORIES OF IMMUNITY

Sovereign immunity—whether of the United States or the several states—is a tricky concept to rationalize. For some, the best explanation is merely that sovereign immunity exists because that is the way it has always been.[16] At common law, the English king could not be haled into his own courts and made to answer for his actions. Similarly, American sovereign entities are immune from being dragged into American courts.[17] Critics of American-style sovereign immunity point to these historical roots when attacking the concept of immunity in American law. The king's immunity, the argument goes, was an acknowledgment of his divine right to plenary authority over his subjects, and because American governments derive their authority from the consent of the governed, there is no place for immunity in a republican nation.[18]

American theorists, however, have grounded their support for sovereign immunity on other grounds. Justice Holmes, for example, believed immunity from suit flowed from a logical syllogism: If legal rights only have meaning within a particular system of laws, the lawgiver alone can decide if and when it can be held to account for alleged violations of those legal rights.[19] "A sovereign is exempt from suit," he wrote, "not because of any formal conception or obsolete theory, but on the logical and practical ground that there can be no legal right as against the authority that makes the law on which the right depends."[20] By way of illustration, Justice Holmes contended that absent consent to suit, the government cannot be guilty of a violation of tort law because "a tort is a tort in a legal sense only because the law has made it so."[21]

Alexander Hamilton likewise argued that immunity was "inherent in the nature of sovereignty."[22] Any claim an individual might have against a sovereign government, including state governments, stemmed not from law but merely from "obligations of good faith"; responsibilities of the government "bind[] the conscience of the sovereign, [but] have no pretensions to a compulsive force."[23] Put another way, courts are merely creations of the government and possess only that power which they are granted; they wield no compulsive power over the sovereign except when it expressly consents.

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15. *See* Seminole Tribe v. Florida, 517 U.S. 44, 72–73 (1996); *Hans*, 134 U.S. at 21.

16. *See Lee*, 106 U.S. at 207 ("[W]hile the exemption of the United States and of the several states from being subjected as defendants to ordinary actions in the courts has . . . been repeatedly asserted here, the principle has never been discussed or the reasons for it given, but it has always been treated as an established doctrine.").

17. *See Alden*, 527 U.S. at 749.

18. *See, e.g.*, Chisholm v. Georgia, 2 U.S. (2 Dall.) 419, 457–58 (1793) (Wilson, J., concurring).

19. *See* Kawananakoa v. Polyblank, 205 U.S. 349, 353 (1907).

20. *Id.*

21. The Western Maid, 257 U.S. 419, 433 (1922).

22. THE FEDERALIST No. 81, at 487 (Alexander Hamilton) (Clinton Rossiter ed., 1961).

23. *Id.* at 488.

The development of state sovereign immunity jurisprudence in America was slow, deliberate, and nearly uninterrupted. From the very start, the Supreme Court was at the center of the sovereign immunity debate, and over more than two centuries, the Court gradually developed a broad conception of states' immunity from suit. In the earlier stages, Hamilton's writings in *The Federalist No. 81* were often cited to justify broad, rigid immunity of the United States and state governments.[24] In the modern era, the emphasis has shifted. Today, the Court protects the immunity of sovereign entities from suit "to accord [them] the dignity that is consistent with their status as sovereign entities."[25]

B. *CHISHOLM V. GEORGIA* AND THE ELEVENTH AMENDMENT

The constitutional support for the sovereign immunity of states comes from the Eleventh Amendment, which states: "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."[26] This Amendment was adopted in response to the "shocking" result handed down by the Supreme Court in *Chisholm v. Georgia*.[27] The debate over the exact meaning of this language and its effect on the doctrine of sovereign immunity shaped the modern sovereign immunity jurisprudence in the Supreme Court.[28]

1. *Chisholm* and the Early Court's Division on the Suability of States

In one of the earliest cases brought under the Supreme Court's original jurisdiction over cases between states and citizens of another state, an executor of the estate of a South Carolinian sued Georgia for recovery of Revolutionary War debts.[29] Georgia declined to appear, apparently believing that it was immune from suit in any federal court without its consent.[30] Writing individually, four of the five Justices agreed that Article III of the Constitution permitted citizens of one state to sue another state in federal court.[31] The Court entered an

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24. *See, e.g.*, Hans v. Louisiana, 134 U.S. 1, 13–14 (1890).
25. Fed. Mar. Comm'n v. S.C. State Ports Auth., 535 U.S. 743, 760 (2002).
26. U.S. CONST. amend. XI.
27. 2 U.S. (2 Dall.) 419 (1793); *see also* Monaco v. Mississippi, 292 U.S. 313, 325 (1934) (describing the "shock of surprise" that followed the Supreme Court's decision in *Chisholm* which led to the adoption of the Eleventh Amendment).
28. *See, e.g.*, Seminole Tribe v. Florida, 517 U.S. 44, 54 (1996); *id.* at 100 (Souter, J., dissenting). *See generally* Vicki C. Jackson, *The Supreme Court, the Eleventh Amendment, and State Sovereign Immunity*, 98 YALE L.J. 1 (1988) (arguing that sovereign immunity properly prevents reallocations of judicial power between state and federal courts and leads to appropriate remedies for governmental wrongdoing); Carlos Manuel Vásquez, *What is Eleventh Amendment Immunity?*, 106 YALE L.J. 1683 (1997) (attempting to reconcile the tension between "forum allocation" and "immunity-from-liability" interpretations of the Eleventh Amendment).
29. *Chisholm*, 2 U.S. (2 Dall.) at 419.
30. *Id.* at 469 (Jay, C.J., concurring).
31. *See id.* at 451 (Blair, J., concurring); *id.* at 464 (Wilson, J., concurring); *id.* at 468 (Cushing, J., concurring); *id.* at 479 (Jay, C.J., concurring).

order allowing the plaintiff to effect service on the attorney general of Georgia and provided that the State's failure to appear would be grounds for a default judgment.[32]

Justice Iredell was the lone dissenter.[33] After examining ancient authorities on the scope of immunity of the English government, he concluded that "even in case of a private debt contracted by the King, in his own person, there is no remedy but by petition, which must receive his express sanction, otherwise there can be no proceeding upon it."[34] Thus, in Justice Iredell's view, the only recourse a citizen had against the crown was an appeal to the king's sense of fairness, imploring "*soit droit fait al partie* (let right be done to the party)"; there was no mechanism at law or equity for compelling the king to answer a claim by a subject.[35] Additionally, Justice Iredell noted that even debts incurred for public uses did not, as a practical matter, give rise to a cause of action because even if a judgment was rendered against the government, "it remain[ed] afterwards in the power of Parliament to provide for it or not among the current supplies of the year."[36]

After analogizing the power of the British sovereign to that of American governments, Justice Iredell concluded that not only the United States, but also state governments enjoyed the same inherent immunity from suit that attended the English government:

> A State does not owe its origin to the Government of the United States, in the highest or in any of its branches. It was in existence before [the United States]. It derives its authority from the same pure and sacred source as [the federal government does]: The voluntary and deliberate choice of the people.[37]

As an alternative ground for his decision, he declared that even if Article III of the Constitution abrogated traditional notions of sovereign immunity, Congress had never authorized federal jurisdiction over suits against state governments, but instead had left the issue to traditional common law principles—principles which supported the complete immunity of states from suit absent their consent.[38]

2. The Eleventh Amendment and the Immunity of the Several States

The *Chisholm* decision created considerable consternation. Georgia, the defendant that the Supreme Court had held amenable to suit, went so far as to initiate a bill decreeing that any person who attempted to enforce the ruling was "guilty

32. *Id.* at 479 (order of the Court).
33. *See id.* at 429 (Iredell, J., dissenting).
34. *Id.* at 445.
35. *Id.* at 442.
36. *Id.* at 445.
37. *Id.* at 448.
38. *Id.* at 449.

of felony and shall suffer death, without benefit of clergy, by being hanged."[39] Backlash around the nation was immediate and responsive action was swift—within three weeks of the *Chisholm* decision, the Senate and the House of Representatives approved the Eleventh Amendment, and the required three-fourths of the states ratified it within a year.[40] By its terms, its scope seems clear—federal courts do not have jurisdiction to hear suits in law or equity commenced against a state by out-of-state citizens or foreigners.[41] However, though the Eleventh Amendment remains an element of sovereign immunity analysis, a series of hotly contested Supreme Court rulings spanning more than two centuries has established a much broader conception of the states' immunity.

The modern understanding of sovereign immunity is now premised on protecting states from the indignity of being haled into court to answer for their actions.[42] This modern understanding expands the scope of immunity far beyond the language of the Eleventh Amendment. Due to this apparent inconsistency, the Supreme Court majorities who have enunciated this expansive scope have often been accused of misreading or unfaithfully applying the history of the Constitution's framing and the Eleventh Amendment.[43] However, this accusation misapprehends the Court's understanding of the Eleventh Amendment. In the Court's view, the Amendment is a specific response to an unpopular Supreme Court decision and not a definition of the entire breadth of state immunity; that is, these Court majorities view the Eleventh Amendment as an example of the broader concept of immunity inherent in the constitutional plan.[44]

This notion—that the Eleventh Amendment does not literally describe the complete scope of state sovereign immunity—goes back at least as far as 1890, when the Supreme Court decided *Hans v. Louisiana*.[45] A unanimous Court agreed with the proposition that a state was not subject to a suit arising under United States law brought by its *own* citizen, notwithstanding the Eleventh Amendment's mention only of suits brought by citizens of other states or foreign nations.[46] This proposition has since been reaffirmed as an important

39. 1 CHARLES WARREN, THE SUPREME COURT IN UNITED STATES HISTORY 100 (2d ed. 1926).

40. JOHN V. ORTH, THE JUDICIAL POWER OF THE UNITED STATES: THE ELEVENTH AMENDMENT IN AMERICAN HISTORY 19–20 (1987).

41. U.S. CONST. amend. XI.

42. *See* Fed. Mar. Comm'n v. S.C. State Ports Auth., 535 U.S. 743, 760 (2002); Alden v. Maine, 527 U.S. 706, 749 (1999).

43. *See, e.g.*, *Fed. Mar. Comm'n*, 535 U.S. at 777–78 (Breyer, J., dissenting).

44. *See Alden*, 527 U.S. at 728 ("[I]mmunity derives not from the Eleventh Amendment but from the structure of the original Constitution itself."); *see also Ex parte* New York, 256 U.S. 490, 497 (1921) (explaining that states enjoy immunity in some situations not explicitly covered by the Eleventh Amendment "because of the fundamental rule [of immunity] of which the Amendment is but an exemplification").

45. 134 U.S. 1 (1890).

46. *See id.* at 15; *id.* at 21 (Harlan, J., concurring).

part of state immunity.[47] Moreover, the Supreme Court has consistently held that states are immune from more than the narrow category of suits described in the Eleventh Amendment; for example, states are immune from suits in admiralty[48] and suits brought by foreign countries.[49] A state's sovereign immunity extends to state agencies that are named as defendants.[50] Finally, states are immune from suits brought in *state* courts[51] or in federal administrative proceedings which have a judicial character.[52] To be sure, several Justices in recent decades have asserted that the Eleventh Amendment is merely a jurisdictional enactment barring federal jurisdiction in diversity cases where a state is the defendant.[53] However, the Court has consistently held that the Amendment is about immunity and that the immunity states enjoy is, in fact, broader than what the Amendment describes.[54]

II. SUING THE STATES

The notion of absolute immunity from suit absent consent is not the end of the story. There are significant policy concerns in direct conflict with the idea of state immunity. Most notably, a bedrock principle of the American legal system is that courts have broad powers to fashion remedies, for a right without a remedy is meaningless to the aggrieved citizen.[55] Thus, although courts have consistently recognized the immunity of states from suit, they have also recognized the potential unfairness of a regime where citizens who have the misfortune to be injured by state actors are left without a remedy whereas a claim would exist had the same harm been caused by a private citizen. To this end, American courts have long recognized exceptions to state sovereign immunity as well as alternative remedies to a direct suit against a state, which serve to alleviate this inherent unfairness of absolute state immunity.

A. ALTERNATIVE REMEDIES

The most notable alternative remedy to a direct suit against a state is a suit against the state officer who carried out the unlawful action in his official capacity. The Supreme Court most fully articulated this remedy in *Ex parte*

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47. *See, e.g.*, Employees of the Dep't of Pub. Health & Welfare v. Dep't of Pub. Health & Welfare, 411 U.S. 279, 280 (1973).

48. *Ex parte New York*, 256 U.S. at 497.

49. Monaco v. Mississippi, 292 U.S. 313, 330 (1934).

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

51. Alden v. Maine, 527 U.S. 706, 712 (1999).

52. Fed. Mar. Comm'n v. S.C. State Ports Auth., 535 U.S. 743, 760 (2002).

53. *See, e.g.*, Welch v. Tex. Dep't of Highways & Pub. Transp., 483 U.S. 468, 509 (1987) (Brennan, J., with Marshall, Blackmun, and Stevens, JJ., dissenting); Atascadero State Hosp. v. Scanlon, 473 U.S. 234, 258–59 (1985) (Brennan, J., with Marshall, Blackmun, and Stevens, JJ., dissenting).

54. *See, e.g.*, *Alden*, 527 U.S. at 713 ("[T]he sovereign immunity of the States neither derives from nor is limited by the terms of the Eleventh Amendment.").

55. *See* Marbury v. Madison, 5 U.S. (1 Cranch) 137, 163 (1803) ("[I]t is a general and indisputable rule, that where there is a legal right, there is also a legal remedy. . . .").

Young.[56] In *Young*, the Court allowed an action against the *state officer* in his official capacity, holding that principles of sovereign immunity were not implicated because the state itself was not a party to the suit.[57] Although this idea is admittedly a legal "fiction,"[58] the Court has consistently permitted suits of this nature, perhaps in recognition of the inherent unfairness of leaving a victim without a remedy merely because he had the misfortune to be harmed by a state, rather than private, actor.[59]

In the century since *Ex parte Young* was decided, the Court has shaped the confines of this remedy. Most notably, a plaintiff is limited to suing for prospective, injunctive relief.[60] Moreover, the violation must be ongoing[61] and the plaintiff must claim a violation of a federal, rather than purely state, right.[62] Congress is permitted to expressly preclude the availability of an *Ex parte Young* remedy for claims based on a violation of a federal statutory right.[63] Finally, the Court has held that an *Ex parte Young* action might not lie in particular situations that "implicate special sovereignty interests" of the state.[64]

B. EXCEPTIONS TO SOVEREIGN IMMUNITY

In addition to recognizing the availability of alternative remedies, the Court has recognized exceptions to state sovereign immunity. In certain narrow circumstances, the Court has allowed Congress to nullify state sovereign immunity in suits arising out of the legislation Congress enacts. Additionally, on occasion, the Court has recognized that states waived their immunity and therefore must submit to a particular suit or category of suits.

1. Congressional Abrogation

While the Court has developed a framework of state sovereign immunity that is nearly absolute, Congress has occasionally enacted legislation that purported to abrogate, or overcome, the immunity of the states from suit.[65] This is usually

56. 209 U.S. 123 (1908). Although this aspect of sovereign immunity law is largely beyond the scope of this Note, it is worthwhile to note in order to better understand other kinds of relief that the Court has allowed.

57. *Id.* at 159.

58. *See* Idaho v. Coeur d'Alene Tribe, 521 U.S. 261, 280 (1997).

59. *See Young*, 209 U.S. at 164–65.

60. *See* Edelman v. Jordan, 415 U.S. 651, 664 (1974). However, a plaintiff seeking money damages for a past violation may not be out of luck. For example, she can bring suit against the official in his or her *personal* capacity for money damages if the violation was of a clearly established constitutional right. *See* Bivens v. Six Unknown Named Agents of the Fed. Bureau of Narcotics, 403 U.S. 388, 390–91 (1971).

61. Green v. Mansour, 474 U.S. 64, 73 (1985).

62. *See* Pennhurst State Sch. & Hosp. v. Halderman, 465 U.S. 89, 106 (1984).

63. Seminole Tribe v. Florida, 517 U.S. 44, 55–56 (1996).

64. *See* Idaho v. Coeur d'Alene Tribe, 521 U.S. 261, 281–83 (1997) (refusing to permit an action that was the "functional equivalent of a quiet title action" that would extinguish the State's control over land it long deemed to be part of its territory).

65. *See, e.g.*, *Seminole Tribe*, 517 U.S. 44, 47 (detailing Congress's attempt to abrogate state sovereign immunity by statute).

done by enacting legislation that explicitly creates a private right of action against a state in federal court.[66] The legitimacy of such measures, according to the Supreme Court, depends on the constitutional power upon which Congress bases its action.

In *Fitzpatrick v. Bitzer*, the Court recognized Congress's ability to abrogate state sovereign immunity in narrow instances where Congress enacts legislation pursuant to its powers under Section 5 of the Fourteenth Amendment.[67] At first blush, this appeared to give Congress broad powers to abrogate immunity and force states to submit to suits through legislation implemented to enforce the Fourteenth Amendment's many provisions, including the Due Process Clause, the Privileges and Immunities Clause, or the Equal Protection Clause.[68] The Court has since limited this seemingly broad power, however. In *Quern v. Jordan*, a decision handed down just three years after the Court first recognized the congressional power of abrogation through the Section 5 power, the Court intimated that abrogation could only be accomplished through a "clear[] showing" of congressional intent.[69] This seemingly innocuous statement indicated that the Court would not probe statutes to find congressional abrogation wherever possible, a practice that would have represented a move away from a strong regime of sovereign immunity toward one that would force states to face many more suits. Instead, a majority of the Court remained committed to the rule of state sovereign immunity, which was only trumped in the few, narrow instances when Congress expressly stated a desire to abrogate it.

Since *Quern*, a majority of the Court has continued to limit the congressional abrogation power first recognized in *Fitzpatrick*. Most notably, the Court has emphasized that Congress's ability to abrogate state sovereign immunity does not include statutes, which, although facially enacted pursuant to Section 5, in fact alter substantive rights.[70] Congress's Section 5 power is limited to "enforcing"—not expanding the scope of—the Fourteenth Amendment's provisions, and the Court decreed that there must be "congruence and proportionality" between the congressional action and the constitutional violation it purports to remedy.[71] Absent this congruence and proportionality, it will be considered an improper expansion of substantive constitutional rights.[72] The Court further limited Congress's ability to abrogate state immunity through its Section 5 powers in *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*.[73] In striking down a congressional attempt to abrogate state

66. *See* Pennsylvania v. Union Gas Co., 491 U.S. 1, 12–14 (1989).
67. *See* Fitzpatrick v. Bitzer, 427 U.S. 445 (1976). The relevant constitutional provision reads: "The Congress shall have power to enforce, by appropriate legislation, the provisions of this article." U.S. CONST. amend. XIV, § 5.
68. *See Fitzpatrick*, 427 U.S. at 453.
69. 440 U.S. 332, 343–44 (1979) (dictum).
70. City of Boerne v. Flores, 521 U.S. 507, 519–20 (1997).
71. *See id.*
72. *See id.* at 520; Kimel v. Fla. Bd. of Regents, 528 U.S. 62, 80–82 (2000).
73. 527 U.S. 627 (1999).

sovereign immunity in certain patent infringement cases, the Court held that Congress may only legitimately use its Section 5 power to abrogate when it identifies a pattern of conduct that transgresses the Fourteenth Amendment's substantive provisions and tailors the remedy to what is necessary to prevent that conduct.[74]

For a short period of time, the Court acknowledged that Congress had the power to abrogate state sovereign immunity in legislation enacted pursuant to its Article I Commerce Clause power. In *Pennsylvania v. Union Gas Company*, a 1989 decision, a narrow majority of the Court upheld an act of Congress, enacted under its Commerce Clause power, which subjected states to suit in federal court regardless of their consent.[75] However, this additional avenue of abrogation was short-lived. In 1996, the Court in *Seminole Tribe of Florida v. Florida* overruled *Union Gas* in another close vote and stated that Congress generally did not possess the ability to abrogate state immunity pursuant to its Article I powers.[76] This included situations where Congress gave states new power to regulate in a field that the federal government could have reserved as its exclusive province; even a discretionary grant of authority to states could not be accompanied by abrogation of immunity in that area.[77]

2. Waiver of Immunity by the States

In addition to abrogation, which removes states' immunity by force of congressional act, courts have recognized that a state can waive its immunity by a variety of methods.[78] Waiver of sovereign immunity by a state is much more common than congressional abrogation. First, states may expressly waive immunity and submit themselves to suit.[79] States are accorded flexibility and discretion by federal courts when deciding whether to waive immunity—a state may waive immunity as to some categories of suits but not others, or it may waive immunity from suit in its own courts while retaining its immunity in federal courts.[80]

Second, a state may be held to have waived its immunity as a result of conduct during litigation that voluntarily invoked a federal court's jurisdiction.

74. *See id.* at 646–47.

75. 491 U.S. 1, 13–23 (1989) (plurality opinion which also announced the opinion of the Court).

76. Seminole Tribe v. Florida, 517 U.S. 44 (1996) (5–4 decision).

77. *Id.* at 58–59.

78. The principle of waiver also exists as to the sovereign immunity of the United States. Congress has waived the United States' immunity as to several categories of suits. *E.g.*, Federal Tort Claims Act, 28 U.S.C. § 1346(b) (2000) (waiving immunity as to tort suits). Note that if sovereign immunity is properly understood as a limit on the subject matter of Article III courts, *see, e.g.*, *supra* note 53 and accompanying text, then waiver should not be possible, for waiver cannot solve subject matter jurisdiction defects.

79. *See, e.g.*, Clark v. Barnard, 108 U.S. 436, 447 (1883) ("[I]n a suit, otherwise well brought, in which a state had sufficient interest to entitle it to become a party defendant, its appearance in a court of the United States would be a voluntary submission to its jurisdiction . . . .").

80. *See* Alden v. Maine, 527 U.S. 706, 757–58 (1999); *see also* Smith v. Reeves, 178 U.S. 436, 445 (1900) (upholding a state's right to waive immunity only as to suit for tax refunds in its own courts).

Specifically, if a state defendant removes a suit brought in state court under state law, it may not then assert a defense of sovereign immunity to the federal court and ask for dismissal.[81] The Court has been clear that the issue of what kinds of litigation conduct qualify as waiver is a question of federal law.[82]

For a time, the Supreme Court recognized a doctrine of "constructive waiver."[83] Under this principle, Congress could make waiver of sovereign immunity a precondition of state operation in some field.[84] For example, Congress might grant states the authority to operate an interstate railroad on condition that they waive immunity as to suits arising out of that activity; by virtue of then operating the railroad, the theory went, the states had effectively waived their immunity despite never expressly doing so.[85] However, the Court expressly disavowed the idea of constructive waiver in *College Savings Bank v. Florida Prepaid Postsecondary Education Expense Board*, holding that Congress may not induce waiver by making it a prerequisite for a state to operate in some otherwise legal area.[86] The abandonment of a broad constructive waiver theory notwithstanding, Congress *may* effectuate a waiver pursuant to its Spending Clause and Compact Clause powers.[87] Thus, while Congress may not declare that operation in some legal area indicates a state's consent to suit, it may condition a "gift" of funds to a state on waiver of immunity to suits arising in some area.[88]

Finally, the Court has found waiver in certain areas by what it calls "the plan of the Constitutional Convention"—that is, the states waived immunity to certain kinds of suits merely by ratifying the Constitution and joining the Union. The theory is that by examining the founding history, analyzing the actions of early Congresses, and injecting some common sense, the Supreme Court can recognize certain areas where it was *assumed* that states would be susceptible to suit (despite the absence of an explicit statement to that effect in the Constitution), even though the broad background of state sovereign immunity was retained in the constitutional plan.[89]

One area in which states are held to have waived their immunity through the plan of the Convention is for suits brought by the United States. When they joined the Union, states are presumed to have submitted themselves to congres-

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81. Lapides v. Bd. of Regents, 535 U.S. 613, 620 (2002). An open question, however, is whether removal of a federal question suit results in waiver of sovereign immunity.

82. *Id.* at 623.

83. *See* Parden v. Terminal Ry. Co., 377 U.S. 184, 192 (1964), *overruled by* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 680 (1999).

84. *Parden*, 377 U.S. at 192.

85. *Id.*

86. 527 U.S. at 680.

87. *Id.* at 686–87 (dicta).

88. *See id.*

89. *See* Monaco v. Mississippi, 292 U.S. 313, 328–29 (1934).

sionally authorized suits brought by the federal government.[90] Similarly, states waived their immunity from suits brought in federal court by another state when they ratified the Constitution.[91] Finally, the Court applied somewhat surprising and new reasoning in their recent holding that states had waived immunity to some suits arising under congressional enactments passed pursuant to the Bankruptcy power[92]—a result that has potentially far-reaching consequences for the future of sovereign immunity jurisprudence.

III. *KATZ* AND A NEW THEORY OF WAIVER

Until very recently, the Court has been closely divided on the scope of state sovereign immunity and the ability of Congress to overcome it, with a slim majority composed of Chief Justice Rehnquist and Justices Kennedy, O'Connor, Scalia, and Thomas resisting any significant erosion of state immunity by congressional action.[93] However, in *Central Virginia Community College v. Katz*, one of the last cases decided before she left the Court, Justice O'Connor broke with these Justices and joined Justices Breyer, Ginsburg, Souter, and Stevens, finding that an action by a bankruptcy trustee to set aside preferential transfers that had been made to a state agency was not barred by sovereign immunity.[94] This decision, coupled with Justice O'Connor's retirement from the bench, has created new uncertainty in the field of sovereign immunity and potential new avenues to subject states to suit.

Katz involved a bankruptcy trustee who sought to recover certain preferential payments the insolvent debtor made to Virginia state agencies.[95] Although the agencies claimed that sovereign immunity barred the suit, the Court held that a statute that made states amenable to suits to recover preferential transfers was a legitimate exercise of congressional authority under the Article I bankruptcy power.[96] The Court, in an opinion written by Justice Stevens, declined to follow an earlier assumption stated in dicta in *Seminole Tribe* that the Bankruptcy Clause did not provide Congress with authority to overcome state sovereign immunity.[97] Instead, the majority argued that abrogation—the issue in *Seminole*

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90. *See id.* at 329 (declaring that the submission of states to suits brought by the United States is "inherent in the constitutional plan"). A related question is whether *qui tam* actions, brought by private citizens in the name of the United States, also fall under this exception. The Court has, to this point, avoided answering this question when faced with it. *See* Vt. Agency of Natural Res. v. United States *ex rel.* Stevens, 529 U.S. 765 (2000).

91. Rhode Island v. Massachusetts, 37 U.S. (12 Pet.) 657, 720 (1838) ("[The] states, in their highest sovereign capacity, in the convention of the people thereof . . . adopted the constitution, by which they respectively made to the United States a grant of judicial power over controversies between two or more states.").

92. Cent. Va. Cmty. Coll. v. Katz, 546 U.S. 356, 359 (2006).

93. *See* Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666, 667 (1999) (5–4 decision); Seminole Tribe v. Florida, 517 U.S. 44, 46 (1996) (5–4 decision).

94. 546 U.S. at 359.

95. *Id.*

96. *See id.* at 379.

97. *Id.* at 363.

Tribe—was not pertinent to this case; the Bankruptcy Clause involved a waiver, or "subordination," of a state's immunity.[98]

The *Katz* majority was convinced (after "careful study and reflection" of the history of the Bankruptcy Clause at the Constitutional Convention and the legislation enacted by the early Congresses) that the Framers' vesting of sole power over bankruptcies in Congress included an understanding that the states would not enjoy immunity in suits arising under the bankruptcy laws.[99] As the Court saw it, the Framers intended the Bankruptcy Clause "to prevent competing sovereigns' interference with . . . discharge"—interference which resulted in colonial debtors being granted a discharge in one jurisdiction while remaining subject to imprisonment for the same debts in another jurisdiction.[100] Additionally, the majority pointed to the Bankruptcy Act of 1800, which granted federal courts habeas jurisdiction over debtors in state prison, as evidence of broad understanding among the Framing generation that the bankruptcy power included a waiver of state immunity.[101] The fact that this law, coming at a time "when state sovereign immunity could hardly have been more prominent among the Nation's concerns," prompted no recorded objections is a strong indicator that the federal bankruptcy power included a waiver of state immunity.[102]

Finally, the majority noted that bankruptcy jurisdiction is primarily *in rem*, and thus does not implicate sovereignty to the same extent as other types of jurisdiction.[103] While admitting that the proceeding at issue—a suit to recover past payments—might not itself be considered an *in rem* action, the Court nonetheless concluded that proceedings ancillary to *in rem* jurisdiction similarly do not implicate state sovereignty to any great extent.[104] Justice Stevens wrote that "[t]he Framers would have understood [that the Bankruptcy Clause's grant of power to enact laws on the entire] 'subject of Bankruptcies' included laws providing, in certain limited respects, for more than simple adjudications of rights in the res."[105] And whatever sovereignty interests implicated by orders of a bankruptcy court ancillary to its *in rem* jurisdiction had been waived by the states, according to the Court, in agreeing to the plan of the Convention.[106] Thus, although the *Seminole Tribe* Court had stated that Congress could not *abrogate* state sovereign immunity pursuant to any of its Article I powers,[107] the Court in *Katz* decided that the Bankruptcy Clause of Article I itself involved a

98. *Id.* at 363–64.
99. *See id.*
100. *See id.* at 373. *But see id.* at 390–91 (Thomas, J., dissenting) (arguing that the Framers felt that the application of full faith and credit would solve this problem and that state immunity was not implicated by the Bankruptcy Clause).
101. *Id.* at 373–75 (majority opinion).
102. *Id.* at 375.
103. *Id.* at 369–70.
104. *Id.* at 371.
105. *Id.* at 370.
106. *See id.* at 373.
107. Seminole Tribe v. Florida, 517 U.S. 44, 73 (1996).

waiver of immunity on the part of the states when they agreed to the Constitution.[108]

IV. *KATZ*'S IMPLICATIONS FOR STATE IMMUNITY

Prior to *Katz*, Congress appeared to have little or no authority under any of its Article I powers to overcome state sovereign immunity and subject states to suits pertaining to legislation arising out of these powers.[109] Although Supreme Court precedent relating to abrogation pursuant to Article I powers remains good law, the Court in *Katz* recognized that at least one Article I power—the power to establish uniform bankruptcy laws—includes a tacit waiver of states' sovereign immunity relating to legislation passed pursuant to that power.[110] While the Court did not examine whether its reasoning would apply to other Article I powers, the *Katz* opinion certainly raises the possibility that other powers delegated to Congress under the constitutional plan also include a tacit waiver of state sovereign immunity in suits arising under laws enacted via those grants of authority. The question of whether additional sources of waiver exist is further complicated by the retirement of Justice O'Connor and the uncertain alignment of the new Court on the broad question of state sovereign immunity.

A. OTHER WAIVERS EMBEDDED IN ARTICLE I POWERS

Though the *Katz* opinion does not speculate as to potential waivers of immunity embedded in other Article I grants of power to Congress, colorable arguments exist that the reasoning of *Katz* applies equally as strong elsewhere. In general, the Court would first look to the history that led to the inclusion of the particular power within Article I, including debates among the Framers, and it would attempt to identify particular problems that led the Framers to assign the power to Congress rather than reserve it for the States.[111] Second, the Court would examine whether the legislation passed by early Congresses (who, in theory, had particularly reliable insight into the intentions of the Framers) pursuant to the particular Article I power indicated that they understood the power to include a waiver of state sovereign immunity.[112] Finally, the Court would examine the nature of suits that arise under laws passed pursuant to the Article I power in question. If the suits are of an *in rem* nature, then the Court would likely be more amenable to recognizing waiver because *in rem* suits implicate sovereign immunity to a lesser extent than other kinds of suits.[113]

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108. *Katz*, 546 U.S. at 377–78.

109. *See Seminole Tribe*, 517 U.S. at 73 (declaring that Congress generally may not abrogate state sovereign immunity pursuant to its Article I powers).

110. *Katz*, 546 U.S. at 377–78. *But see id.* at 393 (Thomas, J., dissenting) (implying that the majority's decision was inconsistent in that it upheld waiver under the bankruptcy power while leaving *Seminole Tribe*'s precedent unaltered).

111. *See id.* at 362–69.

112. *See id.* at 373–77.

113. *See id.* at 369–70.

Even if the particular suit in question was not itself *in rem*, if it could properly be classified as "ancillary" to *in rem* proceedings, the Court might still be inclined to recognize waiver; after all, the suit at issue in *Katz*—an action by a bankruptcy trustee to recover funds from state agencies—was arguably not an *in rem* action.[114]

At first glance, several Article I powers might seem to be candidates for a *Katz*-style argument for waiver of immunity through "plan of the Convention."[115] This Note focuses on the patent and copyright powers and examines whether the Court's reasoning might offer a new avenue to subject states to suit for patent and copyright infringement—areas that the Supreme Court has previously closed off to the notion of congressional abrogation of state immunity.[116] *Florida Prepaid* re-affirmed the holding of *Seminole Tribe*: Congress may not abrogate state sovereign immunity pursuant to Article I powers.[117] Additionally, that case held that Congress's attempts to abrogate state immunity in patent infringement cases was not a proper exercise of its narrow authority to abrogate pursuant to Section 5 of the Fourteenth Amendment.[118] Thus, since 1999, it has seemed that there are few available means of asserting claims of copyright or patent violation against states absent their express consent to such suits.[119] Those cases did not, however, address the potential argument that this

114. *See id.* at 371–72. *See also supra* text accompanying notes 103–04.

115. One potential example is the power of Congress to "make Rules Concerning Capture on Land and Water." U.S. CONST. art. I, § 8, cl. 11. The Supreme Court has held that this clause grants Congress the power to determine the rightful owners of prizes of war, including captured enemy ships or territory. *See* The Siren, 80 U.S. 389, 393 (1871). At common law, the Crown had the sole authority to make war; thus, all acquisitions of war belonged to the king to dispose of as he saw fit. *Id.* at 392; *see also* 3 REEVES' HISTORY OF THE ENGLISH LAW 197 (W.F. Finlason ed., 1880). In the United States, the federal government holds all captured property in public trust, *see* The Joseph, 13 F. Cas. 1126, 1130 (C.C.D. Mass. 1813) (No. 7,533) (Story, Circuit Judge), and the Framers vested the sole power to make rules regarding capture in Congress. Early Congresses exercised this grant of authority in two Prize Acts. *See* 1 Stat. 715 (1799); 2 Stat. 52 (1800).

The *Katz* issue of waiver might hypothetically arise if a state came into possession of some property captured in war, but a private citizen claimed that an act of Congress entitled him to ownership of that property. If the state asserted immunity from suit, the citizen might try to argue that the Captures of War Clause contains an implicit waiver of immunity. The citizen would cull any available evidence regarding the framing of the Clause that tended to show that the Framers understood it to contain an implicit waiver of state immunity, look to the early Prize Acts for clues that the early Congresses understood the Clause to contain such a waiver, and argue to a court that any suits arising out of legislation passed pursuant to this Article I power would be of an *in rem* nature or ancillary to an *in rem* proceeding.

In actuality, this claim would likely not get far, for there is a paucity of recorded framing history of the Captures of War Clause or legislative history of the early Prize Acts. Moreover, the practice of congressionally authorized privateering—the only likely source of a private claim of war prize ownership—was abandoned more than a century ago, so this question is probably merely academic.

116. *See* Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627 (1999).

117. *See id.* at 635–36.

118. *Id.* at 646–48.

119. *See* Brandon White, Comment, *Protecting Patent Owners From Infringement by the States*, 35 AKRON L. REV. 531, 545–46 (2002) (describing the legal difficulties of sustaining a patent infringement suit against a state party after the *Florida Prepaid* decision).

Note suggests—namely, that the Intellectual Property Clause[120] might contain a tacit waiver of state immunity by "plan of the Convention" similar to the waiver the *Katz* Court recognized in the Bankruptcy Clause.

1. The Difficulty in Discerning Framers' Intent Regarding the Intellectual Property Clause

An argument that a *Katz*-style theory of waiver is implicit in the Intellectual Property Clause would run into immediate obstacles because the evidence of Framers' intent regarding the meaning and scope of this clause is so murky. There is little direct evidence from either the Framers themselves or the early Congresses about what, exactly, this clause means. As a result, historians are divided about the nature and scope of Article I's patent and copyright power, and any viable argument for implicit state sovereign immunity waiver pursuant to patent or copyright laws must be based upon circumstantial evidence of Framers' intent.

The delegates to the Constitutional Convention had a diverse body of precedent to look to when deciding to give intellectual property constitutional protection. Britain had a patent system in place by the end of the eighteenth century,[121] and authors' copyrights had been protected in Great Britain since 1710 by the Statute of Anne.[122] Additionally, there was a long (albeit spotty) history of patent and copyright protection in the colonies and states.[123] For example, Massachusetts Bay colony started issuing formal "patents" in the 1640s,[124] and South Carolina's colonial government developed an extensive patent system in the period leading up to the Revolution.[125] The Articles of Confederation made no grant of power to the federal government for protection of intellectual property,[126] but during the period that the new nation was governed by the Articles, creation of patent and copyright regimes by states was widespread.[127] Thus, the background experiences of the delegates that shaped

120. U.S. CONST. art I, § 8, cl. 8. ("Congress shall have the power . . . [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."). This clause is alternatively referred to in modern legal parlance as the Patent Clause, Copyright Clause, or Intellectual Property Clause, depending upon the focus of the particular author. I will refer to it as the Intellectual Property Clause, the most frequently used term in modern writing, even though the term "intellectual property" came into usage long after the Framing generation was dead.

121. *See* H.I. DUTTON, THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION, 1750–1852, at 1–2 (1984).

122. *See* BRUCE W. BUGBEE, GENESIS OF AMERICAN PATENT & COPYRIGHT LAW 53 (1967).

123. *See id.* at 57–83.

124. *Id.* at 60.

125. *Id.* at 75–83.

126. *See* Irah Donner, *The Copyright Clause of the U.S. Constitution: Why Did the Framers Include It with Unanimous Approval?*, 36 AM. J. LEGAL HIST. 361, 361 (1992).

127. *See* BUGBEE, *supra* note 122, at 2 (describing how twelve of the thirteen states enacted some type of copyright protection laws during the period that the Articles of Confederation were in effect); *see also id.* at 84–85 (recounting the broad practice of state patents under the Articles of Confederation).

the framing of the Intellectual Property Clause are well documented. However, in the search for the Framers' meaning, this is where the trail goes cold.

The Intellectual Property Clause was introduced late in the convention and put to a vote with no recorded debate.[128] James Madison, the most diligent chronicler of the proceedings, reported that the proposed clause was accepted for inclusion in Article I unanimously.[129] Aside from his brief notes, however, there is little direct evidence of what the Framers thought the clause actually meant, either from Madison (who played a role in the origination of the clause[130]), or from other delegates.[131] Madison also briefly mentions the Intellectual Property Clause in *The Federalist Papers*,[132] but historians have discounted the value of these brief comments as not necessarily an accurate indication of the Framers' intent.[133] Additionally, scant evidence exists that this enumerated power caused any significant disputes during the individual state ratification debates.[134] Thus, few clues from the framing history are useful in crafting a *Katz*-style argument supporting implicit waiver in the Intellectual Property Clause.

Moreover, the actions of early Congresses—which the Court in *Katz* deemed competent evidence of Framers' intent[135]—also supply few useful clues. The First Congress did not immediately decide what to do with the power granted by the Intellectual Property Clause. Initially, inventors and authors submitted requests for private bills of protection for their inventions and writings, but in 1790, after prodding from President Washington, Congress decided to enact general intellectual property regimes, and it passed separate copyright and patent bills that year.[136] Congress significantly revised the patent system with a new Patent Act in 1793.[137] None of these bills, however, provide any clues that Congress understood the intellectual property power to include a tacit waiver of state sovereign immunity.[138] Finally, early court decisions are no more helpful;

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128. EDWARD C. WALTERSCHEID, TO PROMOTE THE PROGRESS OF USEFUL ARTS: AMERICAN PATENT LAW & ADMINISTRATION, 1787–1836, at 31 (1998).

129. *See* JAMES MADISON, NOTES OF DEBATES IN THE FEDERAL CONVENTION OF 1787, at 580 (W.W. Norton & Co. 1987) (1840). Madison specifically noted that the clause was accepted "nem:con:"—this was shorthand for *nemine contradicente*, or "no one dissenting." *See* WALTERSCHEID, *supra* note 128, at 31 n.29.

130. *See* WALTERSCHEID, *supra* note 128, at 48.

131. *See id.* at 59.

132. THE FEDERALIST No. 43, at 271–72 (James Madison) (Clinton Rossiter ed., 1961).

133. *See infra* text accompanying notes 154–56.

134. Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTELL. PROP. L. 1, 56 (1994).

135. *See* Cent. Va. Cmty. Coll. v. Katz, 546 U.S. 356, 375 n.12, 376–77 (2006).

136. BUGBEE, *supra* note 122, at 137–39.

137. Patent Act of 1793, ch. 11, 1 Stat. 318 (1793) (amended 1836).

138. Section 4 of the 1790 Patent Act, for example, lays out remedies available to patentees who suffer infringement by "any person or persons." This language hardly supports a *Katz*-style argument for implicit state sovereign immunity waiver. *See* Patent Act of 1790, ch. 7, 1 Stat. 109 (1790) (repealed 1793).

reported cases from the nation's early years concerning copyright or patent infringement are virtually non-existent.[139]

Thus, a *Katz*-style argument for implicit state sovereign immunity waiver in the Intellectual Property Clause cannot be supported by direct evidence of framing intent. Neither the history of the Convention nor the actions of early Congresses—which the *Katz* Court deemed reliable indications of the Framing generation's meaning of constitutional clauses—provides explicit clues that the Framers understood the Clause to include a tacit waiver of state immunity in suits brought under laws passed pursuant to that power. If such an argument is to be made, it must rest upon circumstantial evidence that the Framers understood the Clause to include just such a waiver.

2. Constructing an Argument for Waiver Embedded in the Intellectual Property Clause[140]

The paucity of direct evidence notwithstanding, there is some indication that the Framers understood the Intellectual Property Clause to embody a tacit waiver of state sovereign immunity similar to the one the *Katz* Court found in the Bankruptcy Clause.[141] The case is in no way clear-cut; there is less definitive evidence concerning the Intellectual Property Clause than there was concerning the Bankruptcy Clause, and *Katz*, after all, was decided by a sharply divided Court. A nontrivial argument can be made, however, that the very nature of the copyright and patent powers as the Framers conceived them, when viewed in light of the constitutional plan as a whole, indicates that they understood that the States would not enjoy immunity in suits brought by private citizens for infringement of patents or copyrights that Congress might eventually issue. Specifically, the argument is this: if the Framers' justification for patents and copyrights was based on an "exchange-for-ideas" theory (rooted in contract principles), then the general constitutional plan supports the notion that states do not enjoy immunity from suits brought by private citizens for patent or copyright infringement. Neither part of this argument is evident; each needs independent support.

First, the Framers' understanding of the nature of intellectual property is hotly debated. British legal commentators in the eighteenth and early nineteenth centuries, for example, proffered several theoretical justifications for governmen-

139. *See, e.g.*, WALTERSCHEID, *supra* note 128, at 362 (stating that the first reported federal patent case appeared fourteen years after passage of the first Patent Act).

140. This argument might be useful, for example, if a patentee wanted to bring an infringement suit against a state university that she thought was violating her patent rights. Upon filing suit in federal court, the patentee might find herself faced with a claim of sovereign immunity by the state actor, and unless the particular state had expressly waived its immunity from this type of suit, she would be facing immediate dismissal. For a general exposition of how research universities can engage in conduct that deprives patent or copyright holders of their intellectual property, see *Madey v. Duke University*, 307 F.3d 1351, 1362–63 (Fed. Cir. 2002).

141. *See* Cent. Va. Cmty. Coll. v. Katz, 546 U.S. 356 (2006).

tal intellectual property regimes.[142] The first was rooted in natural law theory, and argued that writers and inventors had a natural property right in their creations that the government was duty-bound to protect.[143] The other broad justification had its foundation in contract principles—that is, the government, acting on behalf of society at large, entered into an agreement whereby the citizen would disclose his creation to the public in exchange for a temporary, government-enforced monopoly.[144] There is no clear, direct evidence from the Convention about how the American Framers understood the intellectual property power they granted to Congress,[145] but the argument put forth in this Note succeeds only if the intellectual property power is based on a theory of contract between the federal government, on behalf of society at large, and creators of writings and inventions.

Significant circumstantial evidence exists for the contrary position. James Madison's brief comments about the Intellectual Property Clause in *The Federalist Papers* suggest that the Framers included the intellectual property power in the Constitution based on a recognition of some inherent property interest in an author's or inventor's work.[146] Madison wrote: "The copyright of authors has been solemnly adjudged in Great Britain to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors."[147] If this is an accurate description of the Framers' justification for the Intellectual Property Clause, it seems that they espoused a natural law justification for copyright and patents.[148] At least one historian has noted that some prominent Americans who pressed the states to adopt copyright laws during the era of the Articles of Confederation stressed individual property rights.[149] Additionally, Chief Justice John Marshall (who was not a Framer but who certainly was a prominent member of the Framing generation) wrote in an 1832 Supreme Court

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142. *See, e.g.*, DUTTON, *supra* note 121, at 17–23 (describing several different justifications for patents offered during this period).

143. *Id.* at 17. Although this theoretical justification enjoyed fairly wide acceptance on the European continent, particularly in France, it was not widely accepted in Britain after the earliest days of the Industrial Revolution. *See id.* at 17–18.

144. *See id.* at 22 (describing and discussing the "exchange-for-secrets" justification). Dutton also discusses other theoretical justifications for British intellectual property protection, but these can be viewed under the broad categorization of "contract" theories. For example, he discusses the "reward-by-monopoly" theory, which argued that the government should offer patent protection because it was a more efficient reward system than a one-time payment to the inventor from the treasury. With a patent monopoly, the market determined the "value" of an invention *ex post*, rather than Parliament trying to discern an invention's value *ex ante*. *See id.* at 18–20. For purposes of this Note, this kind of theory can still be broadly categorized as "contract-based," for the offer of patent protection is meant to spur innovation by offering a limited monopoly to inventors in exchange for disclosure of their creations to society. *See id.*

145. *See supra* notes 128–34 and accompanying text.

146. THE FEDERALIST No. 43, at 271–72 (James Madison) (Clinton Rossiter ed., 1961).

147. *Id.*

148. But see *infra* notes 154–56 and accompanying text for an analysis of whether this actually was an accurate account of the Framers' understanding.

149. *See* Donner, *supra* note 126, at 372–73.

opinion that the government officer who issues patents is merely a ministerial officer—he must issue a patent to all inventors who satisfy the prerequisites.[150] This lack of discretion perhaps indicates that patents were not viewed as a "contract" between society and the inventor—the government could not exercise discretion about which inventions it felt were valuable enough to merit a patent, but rather was obliged to acknowledge the inherent right to a patent in each inventor who met the qualifications. Some historians who have examined the scant framing history surrounding this issue declare that the history, combined with the phrasing of the Clause, indicates that the Framers felt an author's or inventor's right to his work was inherent.[151]

However, significant circumstantial evidence also exists for the proposition that the Framers understood intellectual property not as a recognition of natural rights in property, but as a form of contract between the government and authors and inventors. First, most or all of the early state copyright laws enacted during the period the nation was governed by the Articles of Confederation (which certainly influenced the Framers' creation of federal copyright protection) were modeled on England's Statute of Anne.[152] Many historians argue that the English understanding of copyright was that although an author might have *some* inherent common law right to a property interest in his work, a statute could alter the scope of any such right.[153] Indeed, modern historians note that Madison's perfunctory statements in *The Federalist No. 43* regarding the inherent, common law nature of copyright in England failed to mention that an important decision by the House of Lords in 1774 had specifically held that any proprietary interest in copyright is statutory, not a matter of common law.[154] On this point, one historian goes so far as to call Madison's comments "more than a bit disingenuous."[155] Viewing Madison's words in context with the general political atmosphere of the time, this commentator argues that the use of "secure" in the Intellectual Property Clause meant that Congress had the power to *create or provide*, rather than *preserve*, intellectual property protection.[156] The United States Supreme Court endorsed this meaning in a seminal 1834 copyright case, *Wheaton v. Peters*.[157] All this evidence indicates that the

150. *See* Grant v. Raymond, 31 U.S. (6 Pet.) 218, 241 (1832).

151. *See* BUGBEE, *supra* note 122, at 129; *see also* Frank D. Prager, *Historic Background and Foundation of American Patent Law*, 5 AM. J. LEGAL HIST. 309, 318–19 (1961). Prager bases his claim almost exclusively on Madison's short explanation in *The Federalist No. 43*. *See* Prager, *supra* at 318. The accuracy of these comments, however, has been questioned by modern historians. *See infra* notes 154–56 and accompanying text.

152. *See* Donner, *supra* note 126, at 373–74.

153. *See id.* at 368.

154. *See id.* at 377 n.97; Kevin D. Galbraith, Note, *Forever on the Installment Plan? An Examination of the Constitutional History of the Copyright Clause and Whether the Copyright Term Extension Act of 1998 Squares with the Founders' Intent*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 1119, 1142 (2002).

155. WALTERSCHEID, *supra* note 128, at 60.

156. *See id.* at 67–69.

157. 33 U.S. (8 Pet.) 591, 661 (1834).

Intellectual Property Clause is grounded in a notion of an agreement between the public and authors or inventors, rather than on a concept of an inherent property right springing into being at the moment of creation.

Second, there is circumstantial evidence that colonial and state patent regimes—which were likely very influential precedents for the Framers' granting of patent power to Congress[158]—were based on an understanding that patents were justifiable according to an "exchange-for-ideas" theory. For example, South Carolina, which developed perhaps the most substantial patent regime in the colonial era,[159] often imposed a compulsory license system in its patent grants allowing anyone to copy the invention after payment to the patentee of a fixed fee.[160] This practice indicates an understanding that a patent was a form of contract, with terms to be negotiated between the parties, rather than a dutiful exercise of government protection of an absolute, inherent right of the inventor.

Third, the language of the Clause itself contains some clues that the Framers understood the intellectual property grant as supported by an "exchange-for-ideas" theory, rather than as a necessary, mandatory protection of an author's or inventor's natural right. The Clause makes no mention of "property" at all, and this omission recurs in the early Patent and Copyright Acts passed by Congress.[161] Also noteworthy is the fact that the Clause merely *empowers* Congress to grant protections to authors or inventors; it does not *mandate* protection, as would be expected if the Framers viewed rights for authors and inventors as inherent.[162]

Fourth, some actions of early legislators—which the *Katz* Court declared to be competent evidence of the Framers' intent[163]—evince an understanding of intellectual property protection as justified by a contract theory. One historian reports that some Framers—most notably George Washington—as well as early congressmen understood the Intellectual Property Clause to permit Congress to grant "importation patents."[164] An importation patent was a monopoly on sale in the United States of some invention or technology that the patentee imported (that is, pirated) from another country.[165] Certainly, this view of the Intellectual Property Clause would not rest on any notion of inherent rights of inventors—President Washington and many early legislators believed that the Clause empowered Congress to grant protection to importers who had not invented anything. This evidence indicates that at least some understood the Clause as

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158. BUGBEE, *supra* note 122, at 2–3.

159. *See id.* at 75–82.

160. *Id.* at 94.

161. *See id.* at 129.

162. *See* WALTERSCHEID, *supra* note 128, at 70 ("If there was some inherent right in invention [or authorship] as understood by the Framers, then it is difficult to understand why they would not have perceived themselves as obligated to require the Congress to protect [those] right[s]. Yet they did not.").

163. *See* Cent. Va. Cmty. Coll. v. Katz, 546 U.S. 356, 373–77 (2006).

164. WALTERSCHEID, *supra* note 128, at 110–15. *But see id.* at 126 (noting that some members of Congress questioned the constitutionality of importation patents).

165. BUGBEE, *supra* note 122, at 9.

rooted in contract principles—namely, an exchange of a limited, governmentally-protected monopoly for disclosure of secrets heretofore unknown to the American public.[166]

Thomas Jefferson, who was not a Framer but who certainly influenced the political thinking of the Framing generation,[167] was a staunch believer in limited terms of patent protection,[168] indicating an understanding of intellectual property protection as contract rather than as inherent, absolute right. Also, when Chief Justice Marshall held that the government has no discretion in issuing patents when the applicant has satisfied the prerequisites,[169] he declared that a patent is a "reward . . . for the advantages derived by the public for the exertions of the individual," and he intoned that when the government enforces a patent, "[t]he public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive."[170] Additionally, a proposed combined copyright and patent bill in 1803 would have given the Secretary of State the authority to refuse to issue a patent even when all the requirements were met.[171] There is no further history concerning this bill after its introduction,[172] so it certainly is not strong evidence of framing intent. However, the bill was comprehensive and there is no evidence that this provision is what doomed it;[173] if nothing else, this provides further circumstantial evidence that at least some early congressmen believed that the intellectual property power was grounded in a notion of contract rather than in protection of intractable rights. Several years later, Congress vetoed attempts by the Superintendent of Patents to keep details of patented inventions secret during the term of the grant; Congress decided that the details were to be publicly available.[174] Once again, this indicates an understanding of the intellectual property power as a bargain between the public and the author or inventor for disclosure of his ideas.

Certainly, the proposition that the intellectual property power embodies authority for the government to contract with authors and inventors for the disclosure of their ideas is not obvious. But even though most evidence is

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166. *See* JOSEPH BARNES, TREATISE ON THE JUSTICE, POLICY, AND UTILITY OF ESTABLISHING AN EFFECTUAL SYSTEM OF PROMOTING THE PROGRESS OF USEFUL ARTS, BY ASSURING PROPERTY IN THE PRODUCTS OF GENIUS 25 (1792), *quoted in* WALTERSCHEID, *supra* note 128, at 212 (describing the patent as a contract between an inventor and the public).

167. In addition, as Secretary of State, Jefferson was responsible for managing the issuance of patents under the first Patent Act. He also frequently suggested patent revisions and amendments to Congress, so he no doubt had expended much careful thought and contemplation on the Intellectual Property Clause and its ramifications. *See* WALTERSCHEID, *supra* note 128, at 167.

168. Letter from Thomas Jefferson to Oliver Evans (May 2, 1807), *quoted in* WALTERSCHEID, *supra* note 128, at 311.

169. *See supra* text accompanying note 150.

170. Grant v. Raymond, 31 U.S. (6 Pet.) 218, 242 (1832).

171. *See* WALTERSCHEID, *supra* note 128, at 337.

172. *Id.*

173. *See id.* A similar provision appeared in a proposed revised patent bill in 1810, but again the proposed bill died at the end of the congressional session. *See id.* at 338.

174. *See id.* at 302–03.

circumstantial, there is a colorable argument that the Framers indeed had that understanding of the clause they drafted. If that is the case, the argument for an extension of *Katz*'s reasoning to the Intellectual Property power turns on the merits of a second proposition: that the general constitutional plan supports the notion that states do not enjoy immunity from suits brought by private citizens for patent or copyright infringement.

The general plan of the Constitution provides several arguments that the Intellectual Property Clause contains an implicit waiver of state sovereign immunity similar to the one the Supreme Court recognized in the Bankruptcy Clause in *Katz*. This implicit waiver would mean that when states ratified the Constitution, they agreed that they would be amenable to suit in cases arising under laws Congress passed pursuant to this clause[175] (in this case, patents and copyrights). The general notions of supremacy that permeate the entire constitutional plan ought to be enough to support an implicit waiver. The Supremacy Clause[176] declares the supremacy of federal law; it would be counterintuitive to think that states did not have to honor agreements the federal government made on behalf of the United States public. The Impairment of Contracts Clause[177] also provides support for the proposition that states waived immunity in intellectual property infringement suits when they ratified the Constitution. If we view protections granted by Congress pursuant to the Intellectual Property Clause as based on contract principles, this clause provides evidence that states are not immune from infringement suits. Admittedly, the Impairment of Contracts Clause prohibits a state from *passing* a law that impairs a contractual obligation[178] and that is not what happens when a state asserts immunity from an infringement suit. However, the general *plan of the convention* is the important factor;[179] the inclusion of the Impairment of Contracts Clause indicates that states are subject to contractual agreements the federal government makes. If that is true, then the Intellectual Property Clause (assuming that it is understood according to a contract-based rationale) likely includes a tacit waiver of state sovereign immunity for suits arising out of laws passed pursuant to the patent and copyright power.

A final consideration when crafting an argument for an extension of *Katz*'s reasoning to intellectual property cases is whether there is an *in rem* quality to infringement suits. The majority in *Katz* was unworried about the implications its holding had on state sovereign immunity in part because *in rem* proceedings, which bankruptcy proceedings inherently are, do not seriously implicate state sovereign immunity.[180] At first glance, this aspect of *Katz* appears particularly

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175. *See* Cent. Va. Cmty. Coll. v. Katz, 546 U.S. 356 (2006).

176. U.S. CONST. art. VI, cl. 2.

177. U.S. CONST. art. I, § 10, cl. 1 ("No State shall . . . pass any . . . Law impairing the Obligation of Contracts . . . .").

178. *See id.*

179. *See Katz*, 546 U.S. at 373–77.

180. *See id.* at 369–70.

inapplicable to proceedings relating to laws passed pursuant to the Intellectual Property Clause.[181] Infringement suits will naturally involve an individual asserting a right against the defendant. Regardless of the nature of the right—property, contract, etc.—when a state is the defendant, an infringement suit is exactly the type of "indignity" that sovereign immunity is meant to prevent a state from suffering.

There are two possible ways to approach this problem; for the reasons developed *infra*, the second of the two approaches is superior. First, a proponent might try to fit the argument squarely within the *Katz* framework and argue that proceedings pertaining to the intellectual property power have an *in rem* characteristic similar to the proceedings the Court was faced with in *Katz*. At first glance, this appears to destroy the argument made *supra* that there is significant evidence that the Framers viewed the intellectual property power as justified on a theory of contract between the public and the author or inventor.[182] In other words, if an argument is to be made that the Framers understood a waiver of immunity to be implicit in the Intellectual Property Clause because the grant of power was justified by a contract theory and not a property theory, then it seems inconsistent to then argue that a court need not be worried about recognizing a waiver in the Clause because of the *in rem* nature of infringement proceedings. This paradox, however, may only be superficial and perhaps does not doom the argument.

The potential resolution of the contradiction appears if the Framers understood the *justification* for a federal patent and copyright regime to be based in contract theory—which possibly would allow a modern court to recognize an implicit waiver of immunity in the Intellectual Property Clause—while they simultaneously recognized that the nature of proceedings that would *result* from Congress's exercise of the power they granted would be *in rem*. In other words, Congress's exercise of the intellectual property power (the granting of patents and copyrights) would be quasi-contractual acts, but once granted, the patent or copyright became a kind of *res* in which one had absolute rights against the whole world, and the judicial proceedings that would likely result (challenges to the validity of patents or copyrights and infringement suits) had an *in rem* nature. This understanding of the nature of proceedings is not necessarily far-fetched. Justice Jackson illustrated as much in a 1944 opinion when he cited writings of Justice Holmes: "A patent . . . is property carried to the highest degree of abstraction—a right *in rem* to exclude, without a physical object or content."[183] In simple terms, the argument would be that the Framers understood that proceedings arising out of Congress's exercise of the intellectual property power would have *in rem* characteristics. That is, either an inventor or

181. *See, e.g.*, Werckmeister v. Am. Tobacco Co., 207 U.S. 375, 381 (1907) (stating that the Copyright Act "[o]bviously . . . does not provide a proceeding *in rem*" because the act provides for penalties to be exacted from an infringing person).

182. *See supra* text accompanying notes 153–74.

183. Mercoid Corp. v. Mid-Continent Inv. Co., 320 U.S. 661, 678 (1944) (Jackson, J., dissenting).

author or a challenger would be asking a court to adjudicate the rights of the patentee or copyright holder in this hypothetical *res* as to the entire world.

There is evidence that members of the founding generation understood how the intellectual property power would be exercised by Congress and that at least some of them appreciated what the nature of those rights granted would be.[184] The Framers told Congress how to carry out their charge to "promote the Progress of Science and useful Arts," something they did not do with most other enumerated powers.[185] They considered other methods of promoting what we would today call arts and sciences—for example, a system of bounties or "premiums" paid from the treasury to authors and inventors based on the usefulness of their work—but decided on patents and copyrights.[186] Thus, it is not far-fetched to argue that just as the Framers understood the *in rem* nature of proceedings that would result from Congress's exercise of the bankruptcy power,[187] so too did they recognize that proceedings resulting from Congress's granting of patents and copyrights would have an *in rem* character.

In the end, however, this argument seems untenable. It runs counter to the basic understanding of infringement suits—namely, that they concern broad issues that transcend mere adjudication of rights in some *res*.

The second, sounder approach is to argue for the existence of a *Katz*-style implicit waiver in the Intellectual Property Clause despite it not having the *in rem* character that the Court found in the Bankruptcy Clause. It is possible to view the *in rem* discussion in *Katz* as supplemental or alternative support for the existence of an implicit waiver rather than as a necessary component to the Court's decision. For example, the Court comments that the exercise of bankruptcy jurisdiction "does not, in the usual case, interfere with state sovereignty even when States' interests are affected."[188] The Court later continues: "Insofar as [certain actions relating to bankruptcy proceedings] implicate States' sovereign immunity from suit, the States agreed in the plan of the Convention not to assert that immunity."[189] Thus, it appears that the *in rem* discussion is a supplemental or alternative basis to establish that states do not enjoy sovereign immunity in the proceedings at issue in the case rather than a necessary component of the Court's recognition of a waiver implicit in the Bankruptcy Clause. After all, state *waiver* is exactly that—an agreement not to assert a

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184. *See, e.g.*, Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), *quoted in* WALTERSCHEID, *supra* note 128, at 73 (describing how the government-issued patent, not the invention itself, is the source of the property right of inventors).

185. *Compare* U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have 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*") (emphasis added), *with, e.g.*, U.S. CONST. art. I, § 8, cl. 3 ("The Congress shall have Power . . . To regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes").

186. *See* WALTERSCHEID, *supra* note 128, at 35 n.42.

187. *See* Cent. Va. Cmty. College v. Katz, 546 U.S. 356, 369–70 (2006).

188. *Id.* at 370.

189. *Id.* at 373.

privilege that would otherwise be available. Thus, the best answer to the "*in rem*" problem is that it is immaterial—the Supreme Court's discussion of the *in rem* nature of bankruptcy proceedings was merely supplementary or alternative evidence to support its holding of no immunity, and the evidence that the Framers understood the Intellectual Property Clause to contain an implicit wavier of immunity is enough.

CONCLUSION

From *Chisholm v. Georgia* and the Eleventh Amendment through modern Supreme Court decisions such as *Alden v. Maine*, the issue of state sovereign immunity has continued to divide the Supreme Court and the country's legal commentators in general. Though many question whether recognition of states' immunity from suit is consistent with constitutional principles, the Court has developed a doctrine of immunity whereby states are almost always shielded from suffering the "indignity" of being subjected to suit. A plaintiff may hale a state party into court absent its consent only in a few sets of circumstances.

The Supreme Court recognized a new such set of circumstances in *Central Virginia Community College v. Katz*, declaring that the history and nature of the Bankruptcy Clause indicate that the Framers understood it to contain an implicit waiver of sovereign immunity to which the states tacitly agreed upon ratification of the Constitution. The majority did not speculate as to whether its reasoning might apply with equal strength to other powers the Framers granted to Congress. There is a colorable argument that it should—specifically, there is evidence that the Framers might have understood a similar waiver to exist in the intellectual property power that they granted to Congress in Article I of the Constitution. If so, *Katz* might prove to be the source of a new way to circumvent state sovereign immunity and force states to submit to suits for patent or copyright infringement.

Notwithstanding the majority's reasoning in *Katz*, the potential for future waiver-by-plan-of-the-Convention arguments, such as the one proffered *supra* regarding the Intellectual Property Clause, depends considerably on the composition of the Supreme Court. Historically, state sovereign immunity has been a particularly divisive issue, with different Justices holding fundamentally different opinions about the scope of immunity and the meaning of the Eleventh Amendment,[190] and with important precedents established by narrowly divided Courts.[191] Assuming the Court members with established records continue to vote as they have in the past, the viability of *Katz* and its potential extension to other circumstances will likely depend on the votes of the new Justices. Chief Justice Roberts took part in the consideration of *Katz* and joined Justice Thomas's dissenting opinion. If he was unwilling to recognize an implicit

190. *See, e.g.*, *supra* note 53 and accompanying text.

191. *See supra* note 6.

waiver of immunity embedded in the Bankruptcy Clause, it is unlikely that he will be convinced to recognize an implicit waiver in another Article I enumerated power.[192]

How receptive Justice Alito might be to such an argument, however, is more difficult to divine. His prior decisions as a Circuit Judge and his testimony before the Senate Judiciary Committee during his confirmation process offer few clues as to how he might decide such a question. Soon after he joined the Supreme Court, he signed on to a unanimous opinion which refused to recognize a residual, common law theory of sovereign immunity protecting counties from suit pertaining to certain activities.[193] While this case did not raise the question of extending *Katz*, it is an example of Justice Alito (and, of course, Chief Justice Roberts) declining to take an expansive view of sovereign immunity, and it might indicate that he would be amenable to arguments that recognize other limiting factors, such as implicit waiver. It is telling, however, that *all* Justices signed Justice Thomas's opinion for the Court;[194] this case is likely not an accurate barometer of which "camp" Justice Alito might side with on the close question of implicit waivers. Similarly, the opinions in state sovereign immunity cases that Justice Alito authored when he was a member of the Court of Appeals for the Third Circuit offer few insights into how he would decide the question of implicit wavier in, say, the Intellectual Property Clause.[195] Finally, his testimony before the Senate Judiciary Committee during the confirmation process provides few clues about how he would resolve this question. First, the subject of sovereign immunity was never discussed. Second, while he expressed a general respect for precedent, he also emphasized that it is important for judges to consider fully all issues raised in a case.[196] Thus, little can be gleaned from Justice Alito's past judicial opinions or from his testimony before

192. It is certainly possible, of course, that though he was unwilling to recognize implicit waivers by plan of the Convention in Article I powers when it came before the Court as a matter of first impression in *Katz*, he *now* recognizes *Katz* as legitimate precedent and will be willing to apply its reasoning to future cases. Such a change of tack, however, would be surprising. *See, e.g.*, Van Orden v. Perry, 545 U.S. 677, 692–93 (2005) (Thomas, J., concurring) (restating his belief, contrary to what the Court has consistently held, that the Establishment Clause ought not to have been incorporated against the states); Butler v. McKeller, 494 U.S. 407, 432 (1990) (Brennan, J., with Marshall, J., dissenting) ("Even if I did not believe [that the majority's reasoning supported applying the death penalty], I would vacate [the defendant's] death sentence. I adhere to my view that the death penalty is in all circumstances cruel and unusual punishment.").

193. *See* N. Ins. Co. v. Chatham County, 547 U.S. 189 (2006).

194. *See id.*

195. *See In re* Hechinger Inv. Co. of Del., 335 F.3d 243 (3d Cir. 2003); Pa. Dep't of Envtl. Res. v. U.S. Postal Serv., 13 F.3d 62 (3d Cir. 1993); Bolden v. Se. Pa. Transp. Auth., 953 F.2d 807 (3d Cir. 1991) (en banc).

196. *See Confirmation Hearing on the Nomination of Samuel A. Alito, Jr. To Be an Associate Justice of the Supreme Court of the United States: Hearing Before the S. Judiciary Comm.*, 109th Cong. 318–19 (2006) (statement of Samuel A. Alito) ("[The doctrine of stare decisis is] important because it reflect[s] the view that courts should respect the judgments and the wisdom that are embedded in prior judicial decisions. It's not an inexorable command, but it is a general presumption that courts are going to follow prior precedents . . . .").

Congress about whether he would be amenable to an argument for extension of *Katz*'s reasoning to other enumerated powers.[197]

Regardless, the scope of sovereign immunity going forward will likely be shaped by narrow decisions which result from close votes and sharply divided Supreme Courts. Whether the arguments discussed *supra* will find purchase in the Supreme Court—and thus whether *Katz* will be a springboard to further erosion of state sovereign immunity or if it will be merely an outlying opinion in the long American tradition of state immunity—is a question that only the passage of time can answer.

197. For a thorough discussion about the future of sovereign immunity in general under the Roberts Court, see William E. Thro, *The Future of Sovereign Immunity*, 215 ED. LAW REP. 1 (2007).