

STEVENS, J., dissenting

SUPREME COURT OF THE UNITED STATES

No. 98–531

**FLORIDA PREPAID POSTSECONDARY EDUCATION
EXPENSE BOARD, PETITIONER v. COLLEGE
SAVINGS BANK AND UNITED STATES**

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE FEDERAL CIRCUIT

[June 23, 1999]

JUSTICE STEVENS, with whom JUSTICE SOUTER, JUSTICE
GINSBURG, and JUSTICE BREYER join, dissenting.

The Constitution vests Congress with plenary authority
over patents and copyrights. U. S. Const., Art. I, §8, cl. 8.
Nearly 200 years ago, Congress provided for exclusive
jurisdiction of patent infringement litigation in the federal
courts.¹ See *Campbell v. Haverhill*, 155 U. S. 610, 620
(1895). In 1992 Congress clarified that jurisdictional grant
by an amendment to the patent law that unambiguously
authorizes patent infringement actions against States,

¹See Act of Apr. 17, 1800, ch. 25, 2 Stat. 37; Act of February 19, 1819,
ch. 19, 3 Stat. 481. There is some dispute over whether federal jurisdic-
tion over patent cases become exclusive in 1800 or in 1836. See 7
D. Chisum, Patents §20.02[1][a], n. 9 (1998). In any event, 28 U. S. C.
§1338(a) now provides: “(a) The district courts shall have original
jurisdiction of any civil action arising under any Act of Congress relat-
ing to patents, plant variety protection, copyrights and trade-marks.
Such jurisdiction shall be exclusive of the courts of the states in patent,
plant variety protection and copyright cases.” The second sentence of
§1338(a) (excluding the reference to plant variety protection cases) has
been worded in essentially the same way since 1878. See Rev. Stat.
§711 (1878). This Court has used various criteria for determining when
an action “arises under” the patent law, see, e.g., *Dale Tile Mfg. Co. v.
Hyatt*, 125 U. S. 46, 52–53 (1888), but it is well established that a patent
infringement claim is “the paradigm of an action ‘arising under’ the
patent laws.” 8 Chisum, §21.02[1][b].

state instrumentalities, and any officer or employee of a State acting in his official capacity. Pub. L. 102–560, 106 Stat. 4230, 35 U. S. C. §271(h). Given the absence of effective state remedies for patent infringement by States and the statutory pre-emption of such state remedies, the 1992 Patent and Plant Variety Protection Remedy Clarification Act (Patent Remedy Act) was an appropriate exercise of Congress’ power under §5 of the Fourteenth Amendment to prevent state deprivations of property without due process of law.

This Court’s recent decision in *City of Boerne v. Flores*, 521 U. S. 507 (1997), amply supports congressional authority to enact the Patent Remedy Act, whether one assumes that States seldom infringe patents, see *ante*, at 11–13, 17, or that patent infringements potentially permeate an “unlimited range of state conduct,” see *ante*, at 18. Before discussing *City of Boerne*, however, I shall comment briefly on the principle that undergirds all aspects of our patent system: national uniformity.

I

In his commentaries on the Federal Constitution, Justice Story said of the Patent and Copyright Clauses:

“It is beneficial to all parties, that the national government should possess this power; to authors and inventors, because, otherwise, they would be subjected to the varying laws and systems of the different states on this subject, which would impair, and might even destroy the value of their rights; to the public, as it will promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint.” J. Story, *Commentaries on the Constitution of the United States* §502, p. 402 (R. Rotunda & J. Nowak eds. 1987).

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James Madison said of the same Clause, “The utility of this power will scarcely be questioned The States cannot separately make effectual provision for either [copyrights or patents], and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.” The Federalist No. 43, p. 267 (H. Lodge ed. 1908) (J. Madison).

Sound reasons support both Congress’ authority over patents and its subsequent decision in 1800 to vest exclusive jurisdiction over patent infringement litigation in the federal courts. The substantive rules of law that are applied in patent infringement cases are entirely federal. From the beginning, Congress has given the patentee the right to bring an action for patent infringement. §4, 1 Stat. 111. There is, accordingly, a strong federal interest in an interpretation of the patent statutes that is both uniform and faithful to the constitutional goals of stimulating invention and rewarding the disclosure of novel and useful advances in technology. See *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1, 9 (1966). Federal interests are threatened, not only by inadequate protection for patentees, but also when overprotection may have an adverse impact on a competitive economy. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U. S. 141, 162–163 (1989). Therefore, consistency, uniformity, and familiarity with the extensive and relevant body of patent jurisprudence are matters of overriding significance in this area of the law.

Patent infringement litigation often raises difficult technical issues that are unfamiliar to the average trial judge.²

²The Advisory Commission on Patent Law Reform recommended in 1992 that patent jurisdiction be restricted to a single district court per circuit and that district courts designate and use judges with special expertise in patent litigation. “With this increased expertise, courts would be able to more effectively control litigation proceedings, and ensure consistency in the application of substantive patent law Of

That consideration, as well as the divergence among the federal circuits in their interpretation of patent issues, provided support for the congressional decision in 1982 to consolidate appellate jurisdiction of patent appeals in the Court of Appeals for the Federal Circuit.³ Although that court has jurisdiction over all appeals from federal trial courts in patent infringement cases, it has no power to review state court decisions on questions of patent law. See 28 U. S. C. §1295. The reasons that motivated the creation of the Federal Circuit would be undermined by any exception that allowed patent infringement claims to be brought in state court.

Today the Court first acknowledges that the “need for uniformity in the construction of patent law is undoubt-

course, the restricted jurisdictional provision would reduce the flexibility currently available to parties to file actions pursuant to the general jurisdictional authority. Yet patent practice is an essentially national practice in the United States. The ‘costs’ in terms of lost flexibility associated with this change would appear to be relatively minor in comparison to the prospective benefits in uniformity of practice.” Advisory Commission on Patent Law Reform, D. Comer et al., Report to the Secretary of Commerce 99 (Aug. 1992).

³In its Report on the Federal Courts Improvement Act of 1982, the House stated, “Patent litigation long has been identified as a problem area, characterized by undue forum-shopping and unsettling inconsistency in adjudications. Based on the evidence it compiled during the course of thorough hearings on the subject, the Commission on Revision of the Federal Court Appellate System— created by Act of Congress— concluded that patent law is an area in which the application of the law to the facts of a case often produces different outcomes in different courtrooms in substantially similar cases. As a result, some circuit courts are regarded as ‘pro-patent’ and other ‘anti-patent,’ and much time and money is expended in ‘shopping’ for a favorable venue. In a Commission survey of practitioners, the patent bar reported that uncertainty created by the lack of national law precedent was a significant problem; the Commission found patent law to be an area in which widespread forum-shopping was particularly acute.” H. R. Rep. No. 97–312, pp. 20–21 (1981) (footnotes omitted); see also S. Rep. No. 97–275, p. 5 (1981).

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edly important,” *ante*, at 16, but then discounts its significance as merely “a factor which belongs to the Article I patent-power calculus, rather than to any determination of whether a state plea of sovereign immunity deprives a patentee of property without due process of law.” *Ibid.* But the “Article I patent-power calculus,” is directly relevant to this case because it establishes the constitutionality of the congressional decision to vest exclusive jurisdiction over patent infringement cases in the federal courts. That basic decision was unquestionably appropriate. It was equally appropriate for Congress to abrogate state sovereign immunity in patent infringement cases in order to close a potential loophole in the uniform federal scheme, which, if undermined, would necessarily decrease the efficacy of the process afforded to patent holders.

II

Our recent decision in *City of Boerne v. Flores*, 521 U. S. 507 (1997), sets out the general test for determining whether Congress has enacted “appropriate” legislation pursuant to §5 of the Fourteenth Amendment. “There must be a congruence and proportionality between the injury to be prevented or remedied and the means adopted to that end.” *Id.*, at 520. The first step of the inquiry, then, is to determine what injury Congress sought to prevent or remedy with the relevant legislation.

As the Court recognizes, Congress’ authority under §5 of the Fourteenth Amendment extends to enforcing the Due Process Clause of that Amendment. *Ante*, at 9. Congress decided, and I agree, that the Patent Remedy Act was a proper exercise of this power.

The Court acknowledges, as it must, that patents are property. *Ante*, at 14; see also *Consolidated Fruit-Jar Co. v. Wright*, 94 U. S. 92, 96 (1877). Every valid patent “gives the patentee or his assignee the ‘exclusive right to make, use, and vend the invention or discovery’ for a limited

period.” *Transparent-Wrap Machine Corp. v. Stokes & Smith Co.*, 329 U. S. 637, 643 (1947). The Court suggests, however, that a State’s infringement of a patent does not necessarily constitute a “deprivation” within the meaning of the Due Process Clause, because the infringement may be done negligently. *Ante*, at 16–17.

As part of its attempt to stem the tide of prisoner litigation, and to avoid making “the Fourteenth Amendment a font of tort law to be superimposed upon whatever systems may already be administered by the States,” *Daniels v. Williams*, 474 U. S. 327, 332–334 (1986), this Court has drawn a constitutional distinction between negligent and intentional misconduct. Injuries caused by the mere negligence of state prison officials— in leaving a pillow on the stairs of the jail, for example— do not “deprive” anyone of liberty or property within the meaning of the Due Process Clause of that Amendment. *Ibid.* On the other hand, willful misconduct, and perhaps “recklessness or gross negligence,” may give rise to such a deprivation. *Id.*, at 334.

While I disagree with the Court’s assumption that this standard necessarily applies to deprivations of patent rights, the *Daniels* line of cases has only marginal relevance to this case: Respondent College Savings Bank has alleged that petitioner’s infringement was willful.⁴ The question presented by this case, then, is whether the Patent Remedy Act, which clarified Congress’ intent to subject state infringers to suit in federal court, may be applied to willful infringement.⁵

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⁴Paragraph 7 of College Savings’ complaint alleges that “[d]efendant Florida Prepaid with actual knowledge of the ’055 patent, with knowledge of its infringement, and without lawful justification, has willfully infringed the ’055 patent.” App. to Pet. for Cert. 30a.

⁵As a practical matter, infringement actions based on mere negligence rarely arise. Most patent infringers are put on notice that their conduct may be actionable before an infringement suit is filed. “The first step in enforcing a patent is usually to send a cease-and-desist or

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As I read the Court's opinion, its negative answer to that question has nothing to do with the facts of this case. Instead, it relies entirely on perceived deficiencies in the evidence reviewed by Congress before it enacted the clarifying amendment. "In enacting the Patent Remedy Act . . . Congress identified no pattern of patent infringement by the States, let alone a pattern of constitutional violations." *Ante*, at 11.

It is quite unfair for the Court to strike down Congress' Act based on an absence of findings supporting a requirement this Court had not yet articulated. The legislative history of the Patent Remedy Act makes it abundantly clear that Congress was attempting to hurdle the then-most-recent barrier this Court had erected in the Eleventh Amendment course— the "clear statement" rule of *Atascadero State Hospital v. Scanlon*, 473 U. S. 234 (1985).⁶

charge-of-infringement letter." Pokotilow & Siegal, *Cease and Desist Letters: The Legal Pitfalls for Patentees*, Intellectual Property Strategist, Dec. 1997, 1.

⁶The Chairman of the House Subcommittee considering the Patent Remedy Act, Representative Kastenmeier, engaged in the following dialogue with William Thompson, President of the American Intellectual Property Law Association, about whether States were definitively immune from suit under the Eleventh Amendment following the Federal Circuit's recent decision in *Chew v. California*, 893 F.2d 331 (1990):

Mr. KASTENMEIER. You mentioned that you do not see the likelihood of further cases in this area since the *Atascadero* and *Chew* cases seem to be fairly definitive on this question, unless there were in fact remedial legislation. Do you anticipate that remedial legislation, such as the bill before us, if passed into law, would be the subject of litigation?

Mr. THOMPSON. No, I think it would be very clear. Your legislation is very clearly drawn. It seems to match the tests set forth in *Atascadero* of making it very clear that the patent statute is one that would qualify as an abrogation area [*sic*] in the 11th amendment.

"I can never guarantee exactly how attorneys are going to read statutes, Mr. Chairman, but all of the sane ones would not bring an action." Hearing before the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on

Nevertheless, Congress did hear testimony about inadequate state remedies for patent infringement when considering the Patent Remedy Act. The leading case referred to in the congressional hearing was *Chew v. California*, 893 F. 2d 331 (CA Fed. 1990). In fact, *Chew* prompted Congress to consider the legislation that became the Patent Remedy Act. See H. R. Rep. No. 101-960, pt. 1, p. 7, and n. 20 (1990). The Federal Circuit held in that case that congressional intent to abrogate state sovereign immunity under the patent laws was not “unmistakably clear,” as this Court had required in *Atascadero*. *Chew*, 893 F. 2d, at 334.

The facts of *Chew* clearly support both Congress’ decision and authority to enact the Patent Remedy Act. Marian Chew had invented a method for testing automobile engine exhaust emissions and secured a patent on her discovery. Her invention was primarily used by States and other governmental entities. In 1987, Chew, an Ohio resident, sued the State of California in federal court for infringing her patent. California filed a motion to dismiss on Eleventh Amendment grounds, which the District Court granted. The Federal Circuit affirmed, *id.*, at 332, expressly stating that the question whether Chew had a remedy under California law “is a question not before us.” Nevertheless, it implied that its decision would have been the same even if Chew were left without any remedy. *Id.*, at 336. During its hearing on the Patent Remedy Act, Congress heard testimony about the *Chew* case. Professor Merges stated that Chew might not have been able to draft her infringement suit as a tort claim. “This might be impossible, o[r] at least difficult, under California law. Consequently, relief under [state statutes] may be not be a true alternative avenue of recovery.” House Hearing 33.⁷

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the Judiciary, 101st Cong., 2d Sess., 60 (1990) (House Hearing).

⁷Merges continued: “Another problem with this approach is that it

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Congress heard other general testimony that state remedies would likely be insufficient to compensate inventors whose patents had been infringed. The Acting Commissioner of Patents stated: “If States and their instrumentalities were immune from suit in federal court for patent infringement, patent holders would be forced to pursue uncertain, perhaps even non-existent, remedies under State law.” *Id.*, at 15. The legislative record references several cases of patent infringement involving States. See *Paperless Accounting, Inc. v. Mass Transit Administration*, Civil No. HAR 84–2922 (D. Md. 1985) (cited in House Hearing, at 56); *Hercules, Inc. v. Minnesota State Highway Dept.*, 337 F. Supp. 795 (Minn. 1972) (House Hearing at 51); *Lemelson v. Ampex Corp.*, 372 F. Supp. 708 (ND Ill. 1974) (same).

In addition, Congress found that state infringement of patents was likely to increase. H. R. Rep. No. 101–960, pt. 1, p. 38 (1990). The Court’s opinion today dismisses this rationale: “At most, Congress heard testimony that patent infringement by States might increase in the future and acted to head off this speculative harm.” *Ante*, at 13 (citations omitted). In fact, States and their instrumentalities, especially state universities, have been involved in many patent cases since 1992. See *Regents of Univ. of Minn. v. Glaxo Wellcome, Inc.*, ___ F. Supp. 2d ___, No. 98–2465 (Minn. 1999) (declaratory judgment action filed by the University of Minnesota); *University of Colo. Founda-*

assumes that such state law remedies will be available in every state in which the patentee’s product is sold. This may or may not be true. In any event, requiring a potential plaintiff (patentee) to ascertain the validity of her claims under the differing substantive and procedural laws of the fifty states may well prove a very substantial disincentive to the commencement of such suits. Moreover, it would vitiate a major goal of the federal intellectual property system: national uniformity. In short, these remedies are simply no substitute for patent infringement actions.” *Id.*, at 34.

tion, Inc. v. American Cyanamid Co., 974 F. Supp. 1339 (Colo. 1997) (patent infringement action filed by University of Colorado); *Gen-Probe, Inc. v. Amoco Corp., Inc.*, 926 F. Supp. 948 (SD Cal. 1996) (suit filed against various parties, alleging, *inter alia*, that Regents of the University of California induced patent infringement by Amoco); *Genentech v. Regents of Univ. of Cal.*, 143 F.3d 1446 (CA Fed. 1998) (declaratory judgment suit filed by Genentech); *Ciba-Geigy v. Alza Corp.*, 804 F. Supp. 614 (NJ 1992) (counterclaim brought by Alza against Regents of the University of California).

Furthermore, States and their instrumentalities are heavily involved in the federal patent system.⁸ The United States Patent and Trademark Office issued more than 2,000 patents to universities (both public and private) in 1986 alone. Chakansky, *Patent Profiles*, 13 *Computer Law Strategist*, No. 9, p. 8 (1997). Royalty earnings from licenses at United States universities totaled \$273.5 million in 1995, a 12% increase over the prior year. 2 *Eckstrom's Licensing in Foreign and Domestic Operations* §11.06 (D. Epstein ed. 1998). The State of Florida has obtained over 200 United States patents since the beginning of 1995. Brief for New York Intellectual Property Law Association as *Amicus Curiae* 2. All 50 States own or have obtained patents. Brief for United States 44.

It is true that, when considering the Patent Remedy Act, Congress did not review the remedies available in each State for patent infringements and surmise what kind of recovery a plaintiff might obtain in a tort suit in all 50

⁸See generally Dueker, *Biobusiness on Campus: Commercialization of University-Developed Biomedical Technologies*, 52 *Food & Drug L. J.* 453 (1997); Bertha, *Intellectual Property Activities in U. S. Research Universities*, 36 *IDEA: J. L. & Tech.* 513 (1996); Eisenberg, *Public Research and Private Development: Patents and Technology Transfer in Government-Sponsored Research*, 82 *Va. L. Rev.* 1663 (1996).

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jurisdictions.⁹ See *ante*, at 15. But, it is particularly ironic that the Court should view this fact as support for its holding. Given that Congress had long ago pre-empted state jurisdiction over patent infringement cases, it was surely reasonable for Congress to assume that such remedies simply did not exist.¹⁰ Furthermore, it is well known that not

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⁹To the extent that a majority of this Court finds this factor dispositive, there is hope that the Copyright Remedy Clarification Act of 1990 may be considered “appropriate” §5 legislation. The legislative history of that Act includes many examples of copyright infringements by States—especially state universities. See Hearings on H. R. 1131 before the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on the Judiciary 101st Cong., 1st Sess., 93, 148 (1989); Hearing on S. 497 before the Subcommittee on Patents, Copyrights, and Trademarks of the Senate Committee on the Judiciary on 101st Cong., 1st Sess. 148 (1989). Perhaps most importantly, the House requested that the Register of Copyrights prepare a study, which he described in his transmittal letter as, “a factual inquiry about enforcement of copyright against state governments and about unfair copyright licensing practices, if any, with respect to state government use of copyrighted works. I have also prepared an in-depth analysis of the current state of Eleventh Amendment law and the decisions relating to copyright liability of states, including an assessment of any constitutional limitations on Congressional action. Finally, as you requested, the American Law Division of the Congressional Research Service has conducted a 50 state survey of the statutes and case law concerning waiver of state sovereign immunity.” Register of Copyrights, R. Oman, Copyright Liability of States and the Eleventh Amendment (June 1988) (transmittal letter). This report contains comments from industry groups, statistics, and legal analysis relating to copyright violations, actual and potential, by States. See *id.*, at 5, 12, 14, 93–95.

¹⁰After the 1992 Act was passed, the Florida Supreme Court did hold that a patentee might bring some sort of “takings” claim in a state court, or might seek a legislative remedy. See *Jacobs Wind Electric Co. v. Florida Dept. of Transp.*, 626 So. 2d 1333 (1993). Given the unambiguous text of 28 U. S. C. §1338, there is (a) no reason why Congress could have anticipated that decision, and (b) good reason to believe a well-motivated court may have misinterpreted federal law. See *Jacobs Wind*, 626 So. 2d, at 1337–1338 (Harding, J., dissenting).

all States have waived their sovereign immunity from suit,¹¹ and among those States that have, the contours of this waiver vary widely.¹²

Even if such remedies might be available in theory, it would have been “appropriate” for Congress to conclude that they would not guarantee patentees due process in infringement actions against state defendants. State judges have never had the exposure to patent litigation that federal judges have experienced for decades, and, unlike infringement actions brought in federal district courts, their decisions would not be reviewable in the Court of Appeals for the Federal Circuit. Surely this Court would not undertake the task of reviewing every state court decision that arguably misapplied patent law.¹³ And even if 28 U. S. C. §1338 is amended or construed to permit state courts to entertain infringement actions when a State is named as a defendant, given the Court’s opinion in *Alden v. Maine*, it is by no means clear that state courts could be

¹¹See, e.g., Ala. Code §41-9-60 (1991) (claims may only be brought administratively); W. Va. Const., Art. VI §35 (“The State of West Virginia shall never be made a defendant in any court of law or equity . . .”).

¹²See, e.g., Colo. Rev. Stat. §24-10-106 (1998) (waiving immunity in tort claims only for injuries resulting from operation of a motor vehicle, operation of a public hospital or a correctional facility, the dangerous condition of public building, the dangerous condition of a public highway or road, a dangerous condition caused by snow or ice, or from the operation of any public utility facility); Minn. Stat. Ann. §3.736 (Supp. 1998-1999) (waiver of immunity invalid when loss arises from state employee who exercises due care or performance or failure to perform discretionary duty); Md. Cts. & Jud. Proc. Code Ann. §5-522(a)(5) (1998) (immunity not waived if a claim from a single occurrence exceeds \$100,000).

¹³In the House Report advocating the creation of the Federal Circuit, Congress noted, “The infrequency of Supreme Court review of patent cases leaves the present judicial system without any effective means of assuring even-handedness nationwide in the administration of the patent laws.” H. R. Rep. No. 97-312, p. 22 (1981).

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required to hear these cases at all. *Post*, at ____ (slip op., at 2).

Even if state courts elected to hear patent infringement cases against state entities, the entire category of such cases would raise questions of impartiality. This concern underlies both the constitutional authorization of diversity jurisdiction and the statutory provisions for removal of certain cases from state to federal courts, 28 U. S. C. §1441 et al. The same concern justified John Marshall's narrow construction of the Eleventh Amendment in *Cohens v. Virginia*, 6 Wheat. 264 (1821). As he there noted, when there is a conflict between a State's interest and a federal right, it "would be hazarding too much to assert, that the judicatures of the states will be exempt from the prejudices by which the legislatures and people are influenced, and will constitute perfectly impartial tribunals." *Id.*, at 386.

Finally, this Court has never mandated that Congress must find "'widespread and persisting deprivation of constitutional rights,'" *ante*, at 17, in order to employ its §5 authority. It is not surprising, therefore, that Congress did not compile an extensive legislative record analyzing the due process (or lack thereof) that each State might afford for a patent infringement suit retooled as an action in tort. In 1992, Congress had no reason to believe it needed to do such a thing; indeed, it should not have to do so today.

III

In my view, Congress had sufficient evidence of due process violations, whether actual or potential, to meet the requirement we expressed in *City of Boerne* that Congress can act under §5 only to "remedy or prevent unconstitutional actions." See 521 U. S., at 519. The Court's opinion today threatens to read Congress' power to pass prophylactic legislation out of §5 altogether; its holding is un-

supported by *City of Boerne* and in fact conflicts with our reasoning in that case.

In *City of Boerne* we affirmed the well-settled principle that the broad sweep of Congress' enforcement power encompasses legislation that deters or remedies constitutional violations, even if it prohibits conduct that is not itself unconstitutional, and even if it intrudes into spheres of autonomy previously reserved to the States. *Id.*, at 518. Nevertheless, we held that the enactment of the Religious Freedom Restoration Act of 1993 (RFRA) was not an "appropriate" exercise of Congress' enforcement power under §5 of the Fourteenth Amendment. *Id.*, at 536.

By enacting RFRA Congress sought to change the meaning of the Free Exercise Clause of the First Amendment as it had been interpreted by this Court, rather than to remedy or to prevent violations of the Clause as we had interpreted it. We held that RFRA had crossed "the line between measures that remedy or prevent unconstitutional actions and measures that make a substantive change in the governing law." *Id.*, at 519–520. Congress' §5 power is "corrective or preventive, not definitional." *Id.*, at 525. Our extensive review of the legislative history of RFRA made it clear that the statute could not be fairly characterized as a remedial measure, but rather was a legislative attempt "to interpret and elaborate on the meaning" of the Free Exercise Clause. By doing so, Congress had violated the principle that the "power to interpret the Constitution in a case or controversy remains in the Judiciary." *Id.*, at 524.

The difference between the harm targeted by RFRA and the harm that motivated the enactment of the Patent Remedy Act is striking. In RFRA Congress sought to overrule this Court's interpretation of the First Amendment. The Patent Remedy Act, however, was passed to

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prevent future violations of due process, based on the substantiated fear that States would be unable or unwilling to provide adequate remedies for their own violations of patent-holders' rights. Congress' "wide latitude" in determining remedial or preventive measures, see *id.*, at 520, has suddenly become very narrow indeed.

City of Boerne also identified a "proportionality" component to "appropriate" legislation under §5. Our opinion expressly recognized that "preventive rules are sometimes appropriate" if there is

"a congruence between the means used and the ends to be achieved. The appropriateness of remedial measures must be considered in light of the evil presented. See *South Carolina v. Katzenbach*, 383 U. S., at 308. Strong measures appropriate to address one harm may be an unwarranted response to another, lesser one. *Id.*, at 334." *Id.*, at 530.

In RFRA we found no such congruence, both because of the absence of evidence of widespread violations that were in need of redress, and because the sweeping coverage of the statute ensured "its intrusion at every level of government, displacing laws and prohibiting official actions of almost every description and regardless of subject matter." *Id.*, at 532.

Again, the contrast between RFRA and the Act at issue in this case could not be more stark. The sole purpose of this amendment is to abrogate the States' sovereign immunity as a defense to a charge of patent infringement. It has no impact whatsoever on any substantive rule of state law, but merely effectuates settled federal policy to confine patent infringement litigation to federal judges. There is precise congruence between "the means used" (abrogation of sovereign immunity in this narrow category of cases) and "the ends to be achieved" (elimination of the risk that

the defense of sovereign immunity will deprive some patentees of property without due process of law).

That congruence is equally precise whether infringement of patents by state actors is rare or frequent. If they are indeed unusual, the statute will operate only in those rare cases. But if such infringements are common, or should become common as state activities in the commercial arena increase, the impact of the statute will likewise expand in precise harmony with the growth of the problem that Congress anticipated and sought to prevent. In either event the statute will have no impact on the States' enforcement of their own laws. None of the concerns that underlay our decision in *City of Boerne* are even remotely implicated in this case.

The Patent Remedy Act merely puts States in the same position as all private users of the patent system,¹⁴ and in virtually the same posture as the United States.¹⁵ "When

¹⁴As the Senate said in its Report on the Act, "the current state of the law leaves the protection afforded to patent and trademark holders dependant on the status of the infringing party. A public school such as UCLA can sue a private school such as USC for patent infringement, yet USC cannot sue UCLA for the same act." S. Rep. No. 102-280, p. 9 (1992).

¹⁵The majority's assertion that "the Patent Remedy Act does not put States in the same position as the United States," *ante*, at 19, n. 11, is misleading. In the case of private infringement suits, treble damages are available only "where the infringer acted in wanton disregard of the patentee's patent rights, that is, where the infringement is willful." *Read Corp. v. Portec, Inc.*, 970 F. 2d 816, 826 (CA Fed. 1992) (reversing the District Court's award of enhanced damages). "On the other hand, a finding of willful infringement does not mandate that damages be enhanced, much less mandate treble damages." *Ibid.* Attorney's fees are available only in "exceptional" circumstances. 35 U. S. C. §285. Once it has determined that the case is "exceptional," the district court has discretion whether or not to award attorney's fees and the fees "must be reasonable." *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F. 3d 1473, 1480 (CA Fed. 1998). In addition, attorney's fees are available in limited circumstances in suits against the United States. *Ante*, at 20,

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Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach.” *Goldstein v. California*, 412 U. S. 546, 560 (1973) (analyzing Copyright Clause). Recognizing the injustice of sovereign immunity in this context, the United States has waived its immunity from suit for patent violations. In 1910, Congress enacted a statute entitled, “An Act to provide additional protection for owners of patents of the United States.” Ch. 423, 36 Stat. 851. The Act provided that owners of patents infringed by the United States “may recover reasonable compensation for such use by suit in the Court of Claims.” The United States has consistently maintained this policy for the last 90 years. See 28 U. S. C. §1498.

In my judgment, the 1992 Act is a paradigm of an appropriate exercise of Congress’ §5 power.¹⁶

IV

For these reasons, I am convinced that the 1992 Act

n. 11.

The remaining differences between the United States’ waiver of sovereign immunity and the Patent Remedy Act are supported by quintessentially federal concerns. This Court has found that “the procurement of equipment by the United States is an area of uniquely federal interest.” *Boyle v. United Technologies Corp.*, 487 U. S. 500, 507 (1988). Indeed, the importance of the federal interest in military procurement led this Court to fashion the doctrine of “Government contractors’ immunity” without waiting for Congress to consider the question. *Id.*, at 531 (STEVENS, J., dissenting). Injunctions are not available against the United States because of the Federal Government’s extensive investment in patented military inventions. “[T]he right to enjoin the officer of the United States . . . virtually asserts the existence of a judicial power to close every arsenal of the United States.” *Crozier v. Krupp A. G.*, 224 U. S. 290, 302 (1912).

¹⁶I am also persuaded that a State like Florida that has invoked the benefits of the federal patent system should be deemed to have waived any defense of sovereign immunity in patent litigation. The reasoning in JUSTICE BREYER’s dissent in *College Savings Bank v. Florida Prepaid Postsecondary Ed. Expense Bd.*, *post* at ____, applies with special force to this case.

should be upheld even if full respect is given to the Court's recent cases cloaking the States with increasing protection from congressional legislation. I do, however, note my continuing dissent from the Court's aggressive sovereign immunity jurisprudence; today, this Court once again demonstrates itself to be the champion of States' rights. In this case, it seeks to guarantee rights the States themselves did not express any particular desire in possessing: during Congress' hearings on the Patent Remedy Act, although invited to do so, the States chose not to testify in opposition to the abrogation of their immunity.¹⁷

The statute that the Court invalidates today was only one of several "clear statements" that Congress enacted in response to the decision in *Atascadero State Hospital v. Scanlon*, 473 U. S. 234 (1985).¹⁸ In each of those clarifications Congress was fully justified in assuming that it had ample authority to abrogate sovereign immunity defenses to federal claims, an authority that the Court squarely upheld in *Pennsylvania v. Union Gas Co.*, 491 U. S. 1 (1989). It was that *holding*— not just the "plurality opinion," see *ante*, at 7— that was overruled in *Seminole Tribe of Fla. v. Florida*, 517 U. S. 44 (1996). The full reach of that case's dramatic expansion of the judge-made doctrine of sovereign immunity is unpredictable; its dimensions are defined only by the present majority's perception of constitutional penumbras rather than constitutional text. See *id.*, at 54 (acknowledging "we have understood the Eleventh Amend-

¹⁷H. R. Rep. No. 101-960, p. 7 (1990) ("The Subcommittee invited State attorneys general and representatives of State universities to testify, but none made themselves available for the hearing").

¹⁸See, e.g., 42 U. S. C. §12202 (Americans with Disabilities Act of 1990); 11 U. S. C. §106(a) (Bankruptcy Reform Act of 1994); 29 U. S. C. §2617(a)(2) (Family and Medical leave Act of 1993); 15 U. S. C. §1125(a) (Trademark Remedy Clarification Act); 20 U. S. C. §1403(a) (Individuals with Disabilities Education Act); 17 U. S. C. §511 (Copyright Remedy Clarification Act).

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ment to stand not so much for what it says” (citation omitted). Until this expansive and judicially crafted protection of States’ rights runs its course, I shall continue to register my agreement with the views expressed in the *Seminole* dissents and in the scholarly commentary on that case.

I respectfully dissent.