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The author suggests that the issue of sovereign immunity should have played a much larger role in the recent fair use ruling in *Cambridge University Press v. Patton*.

Fair Use, Meet *Ex parte Young*



BY PETER J. KAROL

The most significant—and difficult—aspect of the Eleventh Circuit's recent opinion in the electronic course pack fair use fight known as *Cambridge University Press v. Patton*¹ might be the one that received its shortest treatment.

It took the district court just one paragraph to dispose of defendants' contention that, as state actors sued in their official capacities as board members and officials of a state university, they were shielded from suit by Eleventh Amendment sovereign immunity. Through their failure to cross-appeal the issue, defendants waived the right to have the court of appeals consider that issue at all.²

The problem with this back-of-the-hand treatment, though, is not simply that the district court might have erred in its analysis of a hard issue. Plaintiffs had at

¹ 769 F.3d 1232, 112 U.S.P.Q.2d 1697 (11th Cir. 2014)(88 PTCJ 1623, 10/24/14).

² *Cambridge Univ. Press*, 769 F.3d. at 1255.

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least a decent argument, accepted by the district court, that the *Ex parte Young* exception to that constitutional bar allowed it to hear a case against state actors accused of violating federal law on a continuing basis.

The trouble, rather, is that such a cursory disposition of the issue obscures the dramatic role that the *Ex parte Young* posture should be (and, quietly, is) playing in the litigation. Namely, *Ex parte Young* slants every aspect of a case towards the future. Its entire reason for being is to alter future conduct by state actors, and avoid future violations of federal law (especially, but not necessarily, the federal constitution).

Prospective, Retrospective Conflict. Yet the analytic fair use framework adopted by the court of appeals in its recent decision in *Cambridge Univ. Press* is purposefully retrospective. Through its insistence on work-by-work, particularized fair use inquiries, it focuses the litigation on a series of discreet, unique events (forty-eight infringements; each alleged to be a fair use) in the past, by specific people far-removed from the state apparatus (academic professors and librarians) at a few moments in time (namely, in 2009).

This deep and undiscussed conflict—between *Ex parte Young*'s prospective, and fair use's retrospective, vantages—places the otherwise leading case on disconcertingly weak ground as general precedent.

To step back, in *Cambridge Univ. Press v. Patton* a group of academic publishing houses sued officials and board members of Georgia State University in a challenge to that university's institutional practices regarding so-called electronic or digital course packs. (Electronic course packs are the digital analog to paper course packs—usually collections of articles and book excerpts selected by professors for students to read in their courses. The selections are generally uploaded to password-protected electronic reserve systems maintained by university libraries for student access.)

The particular allegations in *Cambridge Univ. Press* shifted somewhat throughout the litigation. By the time

of trial, however, the district court primarily understood plaintiffs to allege that GSU's 2009 Copyright Policy, because of its misapplication of fair use principles, caused professors and librarians (non-parties) to commit widespread copyright infringement as they, among other things, selected, scanned, and electronically posted unlicensed materials for students to read for their GSU courses.³ The named defendants, in turn, were alleged to be responsible for that infringement (a theory sometimes considered an allegation of direct, and sometimes indirect, infringement).⁴ Plaintiffs urged the district court to sharply limit the practice going forward.⁵

After some back and forth regarding the number of alleged infringements, all occurring in 2009, the district court found that of the seventy-four claimed infringements, plaintiffs had established a prima facie case in forty-eight infringements.⁶ It then proceeded to perform a fair use analysis on each of the forty-eight instances, concluding that fair use applied as a defense to infringement in all but five instances.⁷

Most of the court of appeals' majority opinion focuses on these fair use analyses, and the district court's overarching fair use methodology. It affirmed some choices by the district court (such as its holding that fair use factor one favors defendants because the use was for non-profit educational purposes) and rejected others (such as its decision to give each of the four statutory fair use factors equal weight, and treat them mechanically).⁸ In the end, it effectively sent the case back to the district court to redo its analysis based on the revised appellate fair use guidance.⁹

As evidenced by the plaintiffs' recent request that the entire Eleventh Circuit Court of Appeals reconsider the opinion *en banc*, defendants more or less prevailed with regards to the overall fair use battle.¹⁰ The court of appeals' holding that under fair use factor four (the effect of defendants' use on the market for the original) a district court may consider the lack of available electronic licenses for a work seems particularly helpful to defendants making fair use assertions.¹¹

Sovereign Immunity's 'Narrow Exception.' The entire suit just described, however, was and is still predicated on a critical "narrow exception" to sovereign immunity. Ordinarily copyright claims against states (such as Georgia) and its arms (such as Georgia State University) are categorically barred by the Eleventh Amendment absent consent by that state.¹² Under the narrow

exception, known as the *Ex parte Young* doctrine, when a state actor seeks to enforce an act which violates federal constitutional guarantees, later extended to federal laws generally, the Eleventh Amendment does not bar suit seeking a forward-looking injunction.¹³

As this language suggests, the exception is highly and intentionally circumscribed. Retrospective remedies—whether in equity or in law—are barred.¹⁴ Instead, the *Ex parte Young* exception only applies where the complaint alleges an "ongoing violation of federal law and seeks relief properly characterized as prospective,"¹⁵ and where defendant state actors themselves are connected to the violation federal law.¹⁶ For this reason, it is commonly invoked to protect federally created rights, such as those created by the Civil War Amendments, where federal courts have a strong interest in preventing state actors from repeat violations of federal constitutional and statutory guarantees.¹⁷

Thus *Ex parte Young* might allow a federal court to prevent a state actor, such as a president of a state university, from actively continuing (in the future) to infringe the exclusive rights of a copyright owner if that state actor will continue (in the future) to improperly rely on an on overbroad reading of the statutory fair use exception to do so. Or, it might allow that federal court to enjoin that same president from implementing an intellectual property policy that itself somehow violates federal law (if, perhaps, it facially violates equal protection principals). Or, to use a variation closest to the one argued by plaintiffs below in this case, it might allow a federal court to enjoin that same president from implementing an intellectual property policy if that policy causes other actors (such as professors and librarians) to violate federal copyright law even if the policy itself (or the president) doesn't do so.¹⁸

This framework presents many problems. Taking just one, it is not at all clear that *Ex parte Young* should apply to the last formulation (tracking plaintiffs' in this case) even if it applies to the others. Indeed, the Federal

such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.") That attempt was later held unconstitutional under the U.S. Supreme Court's *Florida Prepaid* line of cases, which deny Congress the authority to abrogate state sovereign immunity except pursuant to the 14th Amendment (which was not relied on by Congress in amending the Copyright Act). See *Chavez v. Arte Publico Press*, 204 F.3d 601, 607, 53 U.S.P.Q.2d 2009 (5th Cir. 2000) (59 PTCJ 637, 3/10/00) (citing *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Savings Bank*, 527 U.S. 627, 51 U.S.P.Q.2d 1081 (1999)).

¹³ *Cambridge Univ. Press v. Patton*, 863 F. Supp. 2d 1190, 1206, 2012 BL 119127 (N.D. Ga. 2012) (citing *Ex Parte Young*, 209 U.S. 123, 159 (1908) and *Verizon Md. Inc. v. Pub. Serv. Comm'n of Md.*, 535 U.S. 635, 645 (2002)).

¹⁴ *Edelman v. Jordan*, 415 U.S. 651, 665-67 (1974).

¹⁵ *Verizon*, 535 U.S. at 645 (quoting *Idaho v. Coeur d'Alene Tribe of Idaho*, 521 U.S. 261, 296 (1997)).

¹⁶ *Pennington Seed, Inc. v. Produce Exchange No. 299*, 457 F.3d 1334, 79 U.S.P.Q.2d 1777 (Fed. Cir. 2006) (72 PTCJ 705, 10/27/06)).

¹⁷ *Pennhurst State School & Hosp. v. Halderman*, 465 U.S. 89, 105 (1984)

¹⁸ As interpreted by the lower court, plaintiffs alleged that GSU's "2009 [Copyright] Policy as applied to plaintiffs' works has led to continuing abuse of the fair use privilege." *Cambridge Univ. Press*, 769 F.3d at 1244 (internal quotations omitted).

³ Id. at 1242-1246.

⁴ Id. at 1245 n. 11.

⁵ Id. at 1245.

⁶ Id. at 1251. In defendants' recently-filed and largely technical petition for rehearing by the Eleventh Circuit, they assert that the seventy-four number was cited in error by the appellate court, and that it should actually be one hundred individual instances of infringement.

⁷ Id. at 1252.

⁸ Id. at 1283.

⁹ Id. at 1284.

¹⁰ On Jan. 2, 2015, the Eleventh Circuit denied both the plaintiffs' and the defendants' petitions for rehearing and for rehearing *en banc*.

¹¹ Id. at 1278-79.

¹² In 1990, Congress amended the Copyright Act in an attempt to abrogate state sovereign immunity and thereby subject states and their instrumentalities to claims of copyright infringement. See 17 U.S.C. § 501(a), 511 ("Any State, and any

Circuit rejected application of the exception to a very close case in the patent realm. “Allegations,” the court held, “that a state official directs a University’s patent policy are insufficient to causally connect that state official to a violation of federal patent law—i.e., patent infringement. A nexus between the violation of federal law and the individual accused of violating that law requires more than simply a broad general obligation to prevent a violation; it requires an actual violation of federal law by that individual.”¹⁹

Should ‘Narrow Exception’ Have Applied? The application of *Ex parte Young* appears particularly weak here in light of its primary purpose. Namely, the exception is designed to provide a federal forum where there is “no state forum available to vindicate federal interests, thereby placing upon Article III courts the special obligation to ensure the supremacy of federal statutory and constitutional law.”²⁰ Because this case involves a copyright policy being used, more or less, by many universities (GSU modeled its own on that of Columbia University),²¹ the publishers had many opportunities to challenge it without invoking one of the most problematic doctrines in constitutional federalism.

Namely, even if the Georgia courts offered no forum to stop implementation of this specific problematic copyright policy (which is not at all clear from the case), the publishers had myriad ways of ending the practice as a practical matter. Most obviously, they could have sued a non-state university, such as Columbia, in federal court with respect to a highly analogous policy. There is every reason to think that GSU would have complied with a federal court’s determination as to the legality of the Columbia policy. Here (unlike in *Ex parte Young* itself)²² no recalcitrant state actor is openly flouting a federal court ruling on the same issue. Rather, with its policy GSU took a defensible position on a difficult and unsettled question of law: namely, the scope of the fair use defense as applied to electronic course packs.

But even if one accepts that *Ex parte Young* can be made to apply to a mere university policy (without any force of law) promulgated with the “tacit approval” of a Board of Trustees,²³ where analogous policies at private schools could have been attacked first, *Ex parte Young* presents extensive doctrinal challenges to the court of appeals’ treatment of fair use in this case.

Under *Ex parte Young*, one still needs to connect the institutional copyright policy promulgated in 2009 with future violations of the statutory fair use exception by state actors on a prospective basis. The easiest way to do this would be to take a “big picture” view of the policy and fair use, and focus not on “a single course, a

single professor” or even the “specific instances of infringement that were the focus during trial.” Rather, it would be to focus on the propriety “of a university-wide practice to substitute ‘paper-coursepacks’ . . . with ‘digital coursepacks.’ ”²⁴ This language, however, comes from the concurrence in the *Cambridge Univ. Press* opinion, and was used to critique the majority’s consistent refusal to allow departures from work-by-work fair use analyses.

The *Cambridge Univ. Press* majority opinion, to the contrary, specifically and repeatedly precludes the “big picture” view of fair use that would be most easy to align with *Ex parte Young* principles. For instance, it squarely rejected plaintiffs’ argument that the district court “erred by performing a work-by-work analysis that focused on whether the use of each individual work was fair use rather than on the broader context of on-going practices at GSU.” Later, it criticized the district court’s fair use factor three analysis because it had found that factor to favor fair use where defendants copied no more than 10 percent of a work, or one chapter in the case of a book with ten or more chapters. Instead fair use analysis should be “performed on a case-by-case/work-by-work basis.”²⁵ In particularly strong language, it went so far as to find the district court to have “abdicated its duty to analyze the third factor for each instance of alleged infringement individually.”²⁶ Many other examples run throughout the opinion.

The majority opinion certainly cites to venerable precedent, namely the Supreme Court’s *Campbell v. Acuff-Rose* case, in support of its view that fair use inquiries must remain particularized.²⁷ Because, though, it was able to dispose of the *Ex parte Young* issue on a technicality of appellate pleading, it never made any effort to harmonize this work-by-work, necessarily retrospective, fair use framework, with *Ex parte Young*’s laser-focus on future violations of federal law.

This, then, may be the lasting question of *Cambridge Univ. Press*: How can a federal district court in 2015 determine anything about future fair use violations by university officials and board members when it is being forced to analyze, on a strictly work-by-work basis, a cherry-picked assortment of five-year-old acts of infringement committed, in 2009, by librarians at the university (who scanned book excerpts and posted them to a university-wide digital platform) at the behest of (non-lawyer) professors trying (presumably with varying levels of attention and degrees of legal ignorance) to follow a copyright policy while preparing course syllabi?

Posture Undercuts Fair Use Precedent. Assuming, moreover, that GSU is much like any other university, those professors likely made their own day-to-day decisions about what books to include, and omit, from any given course reading list (surely without any direct review from university board members or officials). All

¹⁹ *Pennington Seed*, 457 F.3d at 1341-42. The district court here distinguished the Federal Circuit’s *Pennington Seed* holding by “infer[ing] and find[ing] that the 2009 Copyright Policy had at least the tacit approval of the Board of Regents” and that “some of the defendants were responsible for the creation and implementation of” it. *Cambridge Univ. Press*, 863 F. Supp. 2d. at 1209.

²⁰ *Coeur d’Alene Tribe of Idaho*, 521 U.S. at 270-71.

²¹ *Cambridge Univ. Press*, 769 F.3d. at 1242 n. 9.

²² *Ex parte Young*, 209 U.S. 123 (1908). In *Ex parte Young*, the attorney general for the state of Minnesota refused to comply with a federal court-ordered injunction, and was found guilty of contempt. Id. at 132-34.

²³ *Cambridge Univ. Press*, 863 F. Supp. 2d. at 1209.

²⁴ *Cambridge Univ. Press*, 769 F.3d. at 1284-85 (J. Vinson, concurring)

²⁵ Id. at 1271.

²⁶ Id. at 1272. This criticism is particularly striking considering that well over one hundred pages of the district court’s voluminous opinion included a painstaking, work-by-work, fair use analysis. See *Cambridge Univ. Press*, 863 F. Supp. 2d. at Section IV (pp. 1243-1364).

²⁷ See, e.g., *Cambridge Univ. Press*, 769 F.3d. at 1259; 1271-1275 (citing extensively to *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 29 U.S.P.Q.2d 1961 (1994)).

this in order to predict and prevent what the named state actors (board members, president, etc.) might do in 2015 and beyond with respect to a changed faculty assigning a new selection of copyrighted works.

If your answer to this set of questions is that the fair use violation inheres in the GSU 2009 copyright policy itself, and therefore is likely to be repeated so long as that copyright policy remains in place, that seems reasonable. It also, however, runs up once more against the appellate court's rejection of "big picture" approaches to fair use, and mandate that all such inquiries remain strictly particularized.

This quagmire perhaps raises, then, one final additional question. Namely, why would the publishers force such an important litigation through the narrow, restrictive and potentially inapplicable funnel of *Ex*

parte Young? Perhaps there was something about the sheer enormity of GSU as an institution, and the alleged scale of the infringement? Or maybe the very fact that state actors are tangentially involved at GSU (but not, say, Columbia) was an attraction to these plaintiffs. After all, those actors are supposed to be enforcing copyright law, not violating it. One might, then, see some litigation edge in accusing state actors of abetting copyright infringement.

Whatever the reason, to this author, it is unfortunate that this very important and closely-watched case was constructed on the highly distorting foundation of *Ex parte Young*. Such a posture undercuts, and places an important limit on, any fair use precedent coming out of the litigation.