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Texas Supreme Court Vacates Denial of Summary Judgment

Trial Judge Took Bribe to Rule Against Newspaper

The Texas Supreme Court this month vacated denial of summary judgment to a newspaper following disclosure that the trial judge took a bribe in the case to rule against the newspaper. Freedom Communications, Inc., D/B/A The Brownsville Herald et al. v. Coronado, et al., (Tex. June 22, 2012) (per curium).

The Court took judicial notice of a plea agreement entered into by the now-convicted trial judge Abel Limas in which he admitted taking \$8,000 to make rulings favorable to plaintiffs on their libel and privacy case against. The Brownsville Herald, including denying the newspaper's motion for summary judgment.

The plea deal was part of a broad federal investigation in corruption in South Texas. In March 2011, Limas pled guilty to federal racketeering charges, admitting he took over \$235,000 in bribes from lawyers. Limas has been a witness for the prosecution in several corruption trials and is scheduled to be sentence in July.

The Court of Appeal decision affirming denial of summary judgment was made before the corruption came to light. The newspaper asked the Texas Supreme Court to grant summary judgment on the merits. However, without hearing oral argument, the court vacated and remanded the case,

holding that appellate courts had no authority to hear an appeal arising out the trial court's void for corruption order.

Background

At issue in the case is a 2008 full page campaign advertisement published in the Brownsville Herald and Valley Morning Star newspapers (both owned by Freedom Communications) in the days leading up to a Texas Democratic primary election for district attorney. The

advertisement, by the challenger, accused the incumbent of being soft on crimes against children and included the names of dozens of men charged with sex crimes. Four men named in the advertisement sued the newspaper and candidate for libel and invasion of privacy.

In November 2008, the trial court denied summary judgment. In 2009, a divided Texas appellate court panel affirmed. Freedom Communications Inc. d/b/a the Brownsville Herald and the Valley Morning Star v. Coronado, et al., No. 13-08-00628-CV, 2009 WL 2462887 (Tex. App. Aug. 14, 2009).

The advertisement was based on an internal report prepared by the District Attorney's office. The majority held that the advertisement was not a substantially true or a fair summary of the official report because it created the impression that the plaintiffs were convicted of the crimes they were charged with. The privacy claim could also go forward because it is not clear to the court whether the mere accusation of a crime constitutes a legitimate matter of public concern.

The dissenting justice on the panel wrote a forceful dissent, stating "the advertisements were true. They stated that appellees were accused of crimes

concerning children. They were. The advertisements also stated that appellees' cases were declined at intake. They were." The dissenting judge would also have dismissed the privacy claim, stating "Criminal allegations related to misconduct against children are of legitimate public concern."

Freedom Communications was represented by John Bussian, The Bussian Law Firm PLLC, Raleigh, NC. Plaintiffs were represented by Marc G. Rosenthal and Charles L. Levy, Rosenthal & Watson, PC, Austin.

The Court took judicial notice of a plea agreement entered into by the now-convicted trial judge Abel
Limas in which he admitted taking \$8,000 to make rulings favorable to plaintiffs on their libel and privacy case against The Brownsville Herald, including denying the newspaper's motion for

summary judgment.

Esquire Blog Post About Birther Book Protected By D.C. Anti-SLAPP Law

Blog Post Was Satire; Anti-SLAPP Applies in Federal Court

The D.C. federal district court this month applied the District's new anti-SLAPP statute to dismiss libel, privacy and related claims brought over a satirical Esquire magazine blog post poking fun at a birther conspiracy book. Farah v. Esquire Magazine, Inc., 11-cv-1179 (D.D.C. June 4, 2012) (Collyer, J.). The satiric blog post was clearly speech on a matter of public interest and was protected by the anti-SLAPP statute and federal motion to dismiss standards. The court also notably held that the anti-SLAPP statute applies in federal court, disagreeing with a recent decision by a fellow D.C. federal district court judge. See 3M Co. v. Boulter, Civil No. 11-1527, 2012 WL 386488 (D.D.C. Feb. 2, 2012) (Wilkins, J.).

Background

Plaintiff Joseph Farah is the founder and editor of WorldNetDaily.com, a conservative news site, and CEO of its publishing arm, WND Books. In May 2011, WND published a book entitled "Where's the Birth Certificate? The Case That Barack Obama Is Not Eligible To Be President," by Jerome Corsi. A few weeks before publication, the White House released a copy of President Obama's long form birth certificate, deflating the book's impact.

With that background, on the day the book was officially published esquire.com published a satirical blog post headlined "BREAKING: Jerome Corsi's Birther Book Pulled From Shelves!" Among other things the blog post stated:

In a stunning development one day after the release of Where's the Birth Certificate? The Case that Barack Obama is not Eligible to be President, by Dr. Jerome Corsi, World Net Daily Editor and Chief Executive Officer Joseph Farah has announced plans to recall and pulp the entire 200,000 first printing run of the book, as well as announcing an order to refund the purchase price to anyone who has already bought

either a hard copy or electronic download of the book. In an exclusive interview, a reflective Farah, who wrote the book's forward and also published Corsi's earlier best-selling work, Unfit for Command: Swift Boat Veterans Speak out Against John Kerry and Capricorn One: NASA, JFK, and the Great "Moon Landing" Cover -Up, said that after much serious reflection, he could not go forward with the project. "I believe with all my heart that Barack Obama is destroying this country, and I will continue to stand against his administration at every turn, but in light of recent events, this book has become problematic, and contains what I now believe to be factual inaccuracies," he said this morning. "I cannot in good conscience publish it and expect anyone to believe it."

Ninety minutes later the post was updated, adding among other things:

Update, 12:25 p.m., for those who didn't figure it out yet, and the many on Twitter for whom it took a while: We committed satire this morning to point out the problems with selling and marketing a book that has had its core premise and reason to exist gutted by the news cycle, several weeks in advance of publication.

In June 2011, Joseph Farah, individually and on behalf of his publishing company, sued Hearst Communications and reporter Mark Warren for libel, false light, misappropriation, tortious interference with business relations and violation of the Lanham Act. Hearst moved to dismiss under the anti-SLAPP statute, D.C. Code § 16-5501 et seq.; and Rule 12(b)

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(6). The motion was granted in full. The Lanham Act claim failed because the blog post was non-commercial speech; and the common law claims were barred by the anti-SLAPP statute and motion to dismiss standards of *Bell Atl. Corp. v. Twombly*, 550 U.S. 544 (2007) and *Ashcroft v. Iqbal*, 560 U.S. 662 (2009).

public interest speech "statements directed primarily toward protecting the speaker's commercial interests." The district court, however, found that the text of the blog post belied this assertion.

The blog post addressed an obvious matter of public interest – the dispute over President Obama's birthplace and

eligibility to serve as President. It bore numerous indicia of its satiric nature.

It was tagged as "humor," had an exaggerated headline, made reference to a fake book and contained obviously exaggerated quotes attributed to plaintiff. In fact, about an hour after the posting, plaintiff in an interview called it "a very poorly executed parody."

"Because later it became inconvenient to treat the Blog Post as satire cannot erase Plaintiffs' own contemporaneous admission that it was so intended," the court wrote, adding "Political satire can be, and often is, uncomfortable to its targets, but that does not render it any less satiric or any less an expression on a topic of public concern."

Thus all of plaintiffs' claims were barred.

Plaintiff was represented by Larry Klayman, Washington, DC. Defendants were represented by Hearst in-house counsel Jonathan Donnellan and Kristina Findikyan; and Laura Handman and Rory Eastburg, Davis Wright Tremaine, Washington, DC.

Anti-SLAPP Analysis

The district court began its anti-SLAPP analysis by noting that the statute "follows the lead of other jurisdictions" in creating a mechanism to protect acts in furtherance of the right of advocacy on issues of public interest. In a footnote the court concluded that the statute applies in federal court since the law "is substantive" or "has substantive consequences." Quoting from Sherrod v. Breitbart, Civil No. 11 -477(RJL), 2012 WL 506729, *1 (D.D.C. Feb. 15, 2012); and disagreeing with Judge Wilkins' conclusion in 3M Co. v. Boulter that the D.C. anti-SLAPP does not apply in federal court because it restricts the procedural right to maintain an action in federal court.



Plaintiffs argued that the parties were competitors and that the blog post was intended to harm its publishing business. Thus, according to plaintiffs, the case fell outside the scope of the anti-SLAPP law as commercial speech. *See* D.C. Code § 16-5501(3). That subsection excludes from the scope of

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No Personal Jurisdiction Over Out-of-State News Source

Interview Did Not Target Forum State

Analyzing in detail whether the *Calder* effects test could be applied to exert personal jurisdiction over an out-of-state news source, a divided Indiana Court of Appeals panel recently held that merely responding to questions from a reporter is not conduct "expressly aimed" at the forum state. *Davis v. Simon*, 963 N.E.2d 46 (Ind. App. 2012) (Brown, Baker, Kirsch, JJ.).

Background

Plaintiff Herbert Simon is a prominent Indiana real estate developer and owner of the Indiana Pacers basketball team. Defendant Joseph A. Davis is a California attorney. Simon and his wife Bui Simon sued Davis in Indiana for defamation and false light over comments Davis made to a reporter for WTHR, an Indianapolis news organization.

The media in Indiana were interested in lawsuits Davis had filed in California against the Simons on behalf of domestic workers employed at a home the Simons own in California. In covering those lawsuits, a reporter from WTHR contacted Davis over the phone multiple times. Initially, in March 2010, Davis declined to

provide the reporter with materials related to the suits. Davis was then informed that WTHR obtained copies of the complaints on their own. In April 2010, WTHR called Davis once again and, according to Davis, WTHR said "that it was prepared to take [Davis'] recorded statement."

During that call, Davis, who was always in California when he spoke to WTHR, told the reporter that one of his clients was fired because she "refused to engage in an unlawful, meaning criminal, act pursuant to our immigration laws." Davis continued to note, that "[t]his was all designed to conceal from local and state authorities the existence of this undocumented worker." WTHR broadcasted those comments on television during the April 9th evening news.

Subsequently, on May 5, 2010, the Simons filed a complaint against Davis in Indiana state court for defamation

and false light. In response, Davis filed a motion to dismiss for lack of personal jurisdiction, or in the alternative, on grounds of forum non conveniens.

Based on Davis' declaration that WTHR called him saying it was "prepared to take [his] statement," the Simons argued that the comments were made in a pre-arranged interview scheduled for that time. As a result, the Simons claimed that "Davis knowingly and voluntarily directed defamatory statements to Indiana with the understanding and intention that they would be published [in Indiana.]"

On October 27, 2010, the trial court denied Davis' motion to dismiss. The trial court accepted the Simons' presentation of the facts and found that "[b]y responding and scheduling a taped interview with WTHR, Davis... did initiate contact with WTHR," and he therefore "purposefully established

contact with the State of Indiana." Those findings led the trial court to conclude that "Davis does have the 'minimum contacts' sufficient to support specific jurisdiction." Davis filed an interlocutory appeal with the Court of Appeals of Indiana.

A divided Indiana Court of Appeals panel recently held that merely responding to questions from a reporter is not conduct "expressly aimed" at the forum state.

The Express Aiming Test

On appeal, the Court focused on whether Davis had "minimum contacts" with Indiana sufficient to form the basis for personal jurisdiction. To answer that question, the court relied heavily on the Indiana Supreme Court decision in LinkAmerica Corp. v. Albert, 857 N.E.2d 961 (Ind. 2006), which applied and interpreted much of the U.S. Supreme Court's personal jurisdiction jurisprudence. Citing the Supreme Court's rulings in Helicopteros Nacionales de Colombia, S.A. v. Hall, 466 U.S. 408 (1984) and Burger King Corp. v. Rudzewicz, 471 U.S. 462 (1985), the appellate court explained, as an initial matter, that "minimum contacts" can be based on either (1) "continuous and systematic" contacts that establish general jurisdiction; or (2) a controversy "related to or aris[ing] out of the defendant's contacts with

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the forum state" so as to establish specific jurisdiction.

In this case, the court and the parties agreed that the only possible basis for personal jurisdiction would be specific jurisdiction. However, Davis maintained that his contacts with Indiana were insufficient to be considered "minimum contacts" for personal jurisdiction.

To determine whether Davis' contacts met the "minimum contacts" threshold, the court invoked the "express aiming test" derived from the Supreme Court's decision in *Calder v. Jones*, 465 U.S. 783 (1984). The *Calder* court held that because two Florida journalists published their nationally-circulated magazine in California, their "intentional, and allegedly tortious, actions were expressly aimed at California," thereby constituting "minimum contacts" that met the due process requirements for personal jurisdiction.

Interpreting *Calder*, the court here described three ways that a defendant's contacts with a forum can satisfy the "express aiming" test: (1) if the defendant's conduct was "intentionally directed at' the forum resident"; (2) if "the defendant is alleged to have engaged in wrongful conduct targeted at a plaintiff whom the defendant knows to be a resident of the forum state"; or (3) if the "defendant exhibit [ed] 'purposeful conduct' in which 'the forum is the focal point of the conduct and the injury." If a defendant's conduct is deemed to have been "expressly aimed" at the forum state, then personal jurisdiction there is appropriate.

Conduct Not "Expressly Aimed" at Indiana

Applying the "express aiming" test, the appellate court found it to be "immaterial" whether or not Davis returned WTHR's call "because the record unequivocally demonstrates that it was WTHR who initiated the contact, and Davis did *nothing more* than simply respond to WTHR's inquiry." If Davis did not initiate contact with Indiana, the

court reasoned, he did not expressly aim his conduct there. While Davis conceded on appeal that it was possible to draw the inference from his lower court filings that he returned WTHR's call, the appellate court found "the trial court's heavy reliance on this inference in its order to be problematic."

Distinguishing Davis' conduct from other cases where "minimum contacts" were deemed sufficient for personal jurisdiction, the court noted that Davis neither sent letters into the state of Indiana, nor wrote or disseminated a news story about the Simons there.

As such, the court found no "purposeful conduct' which was 'intentionally directed at Indiana' on the part of Davis to defame the Simons in Indiana." While the court acknowledged that the resulting injury in Indiana may have been foreseeable to Davis, that foreseeability alone did not mean that Davis "purposefully availed himself of an opportunity to act in" Indiana.

Asking "whether an attorney, answering a reporter's unsolicited questions, in which the attorney made comments regarding the allegations of a lawsuit and represented that the allegations were truthful, without more, constitutes expressly aiming one's conduct," the majority "conclude[d] that it does not."

The dissenting judge argued that the circumstances of the instant case were, in fact, more compelling than in *Calder* for purposes of exercising jurisdiction. Judge Kirsch wrote: "The reporter worked only in Indiana, and WTHR broadcasts only in Indiana. Where else, but in Indiana, could the defamatory remarks have been aimed?"

Plaintiffs were represented by David K. Herzog, Jon Laramore, and April E. Sellers of Baker & Daniels LLP in Indianapolis. Defendant was represented by Julia Blackwell Gelinas and Maggie L. Smith of Frost Brown Todd LLC in Indianapolis and by Robert D. Emmerson and Scott Shockley of Defur Voran LLP in Fishers, Indiana.

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FCC policies affect the programming we watch and listen to; who may own which and how many media outlets; and what burdens are placed on the operations and speech of licensees. What every media lawyer should know about the FCC.

California Appellate Court Strikes Down Bank Rumor Statute

Craigslist Posts Were Protected Opinion

A California appellate court granted an anti-SLAPP motion striking a defamation complaint brought by a bank against a former employee who posted "rants and raves" about the bank on Craigslist.com. *Summit Bank v. Rogers*, No. A129800 (Cal. App. 1st Dist. May 29, 2012). In granting the motion, the court struck down as unconstitutional California's bank rumor statute, Financial Code Sec. 1327, which imposes criminal liability for false statements and rumors about a bank's financial condition. The statute, enacted in 1917, failed on multiple grounds: it lacked a fault standard, was vague and over broad, and discriminated based on content.

The messages were posted under a pseudonym. The Bank subpoenaed Craigslist and obtained a court order for disclosure of the identity of the poster. The Bank then sued Rogers for defamation. The trial court denied Rogers' anti-SLAPP motion under section 425.16 to strike the Bank's complaint. The bank successfully argued to the trial court that the anti-SLAPP statute did not apply because the Craigslist posts were illegal as a matter of law under Financial Code Sec. 1327. See Flatley v. Mauro, 39 Cal.4th 299, 320, 324 (2006) (conduct illegal as a matter of law falls outside protected speech and petition rights).

Background

At issue were a series of statements posted by Robert Rogers to the "Rants and Raves" section of Craigslist about his former employer, Summit Bank in Oakland, CA. Among other things defendant wrote:

Whats up at this problem Bank.
The CEO provides a executive position to her worthless, lazy fat ass son Steve Nelson. This should not be allowed. Move your account now.

The FDIC and the California Department of Financial Institutions are looking at Summit Bank. This is the third time in less than one year. This is not a good thing, move your accounts ASAP.

This is a piss poor Bank. I would suggest that anyone that banks at Summit Bank leave before they close.

Move your accounts now before its too late.

A California appellate court granted an anti-SLAPP motion striking a defamation complaint brought by a bank against a former employee who posted "rants and raves" about the bank on Craigslist.com.

Bank Rumor Statute Unconstitutional

California Financial Code Sec. 1327 provides:

Any person who willfully and knowingly makes, circulates, or transmits to another or others, any statement or rumor, written, printed, or by word of mouth, which is untrue in fact and is directly or by inference derogatory to the financial

condition or affects the solvency or financial standing of any bank doing business in this state, or who knowingly counsels, aids, procures, or induces another to start, transmit, or circulate any such statement or rumor, is guilty of a misdemeanor punishable by a fine of not more than one thousand dollars (\$1,000), or by imprisonment for not more than one year, or both.

The statute was enacted in 1917 to prevent bank panics. The Court found no case law interpreting the statute, but

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concluded that under modern constitutional principles it failed on a variety of grounds. It was unconstitutional on its face because it did not contain an actual malice requirement or any statutory language limiting its reach to those banks which are not considered public figures. Its description of prohibited conduct was unconstitutionally vague and over broad. Lastly, it was an unconstitutional content-based proscription. Thus the trial court erred in not applying the anti-SLAPP statute to the bank's defamation claim.

Anti-SLAPP Analysis

The Court first concluded that the statements at issue questioned the bank's financial stability and thus concerned a matter of public interest, particularly in light of the current economic downturn and "profound public interest in the financial world, and a heightened interest in private banks."

Second, the bank could not establish a probability of prevailing on its claim for defamation. Statements about FDIC review of the bank were substantially true. The other comments were opinion in the context of online blogs and message boards.

Rogers's statements must be viewed from the perspective of the average reader of an Internet site such as Craigslist's Rants and Raves, not the Bank or a banking expert who might view them as conveying some special meaning. ... Rogers's statements that the Bank was mismanaged and rendered poor service and that the Bank's depositors would be well advised to move their accounts "before its [sic] too late" and "before they close,"do not imply a provably false factual assertion to form the basis for a defamation action. Instead, as a matter of law, such statements constitute nonactionable opinions.

Plaintiff was represented by Law Offices of Steven B. Piser and Andrew Chang, Esner Chang & Boyer, Pasedena, CA. Defendant was represented by Kurt E. Wilson, Scott A. Mangum of Sweeney, Mason, Wilson & Bosomworth, Los Gatos, CA.



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New Hampshire Governor Vetoes Right of Publicity Bill

Senate Fails to Override

On June 27 the New Hampshire Senate failed to override New Hampshire Governor John Lynch's veto of Senate Bill 175, the so-called "J.D. Salinger bill" which had been requested by the Salinger family. A number of state and national media organizations, including MLRC, wrote to Governor Lynch and individual senators pointing out the bill's flaws as amended by the New Hampshire House and urging that it not become law.

MLRC Member William L. Chapman wrote the following opinion column for the Concord Monitor on the morning of the Senate vote urging that the Governor's veto be sustained.

Gov. Lynch was right: Publicity bill means needless litigation

By William L. Chapman

Gov. John Lynch vetoed Senate Bill 175, "An act regulating the commercial use of a person's identity." He did so because "this legislation is overly broad, would potentially have a chilling effect on legitimate journalistic and expressive works" and "would invite rather than diminish litigation."

The aim of Senate Bill 175 is laudable. No one should be able to exploit another person's identity for commercial purposes. But the means the Legislature has chosen to achieve that end are unnecessarily broad.

SB 175 did not start out that way. As passed by the Senate, it contained specific exemptions to permit the use of a person's identity in "news, public affairs, public interest or sports broadcasts"; in a "play, book, story, graphic novel, article, editorial, commentary, or other similar written or theatrical work"; in a "speech," "musical composition or musical lyrics," and in "an original work of art."

Those exemptions were removed from the bill in the House. As passed by the Legislature, SB 175 gives a person, or his or her heirs, "the right to control the commercial use of (such) . . . person's identity" during the person's life "plus 70 years after his or her death." Yet in revising the bill, the Legislature chose not define what constitutes a "commercial use" of a person's identity.

Is a "sports broadcast" documenting Ted Williams's or Larry Bird's career a "commercial use"? What about a "play," "book," "theatrical work," or "song" about Tom Brady? Or what about a "work of art" of one of them in action? All those forms of journalistic or artistic works were not commercial use and were exempt under the original Senate version of the bill.

In removing those and the other specific exemptions from the original version of Senate Bill 175, the Legislature did no more than state the obvious: The right to control the commercial use of a person's identity is "subject to limitations imposed by the New Hampshire Constitution and the United States Constitution." That is why Lynch was correct in stating that "the omission of legitimate, clear exceptions for news and expressive works will . . . result in needless litigation to judicially establish what should have been made explicit in this bill."

In politics it is often said that "the perfect is the enemy of the good." SB 175 is not such a case. It is a case of the House taking a good Senate bill and turning it into a very "imperfect bill." The Legislature should sustain the governor's veto.

William L. Chapman is an attorney with Orr & Reno in Concord, NH. His column was published on June 27, 2012 in the Concord Monitor and is republished with permission.

New York State Assembly Judiciary Committee Chair Sponsors Significant Expansion and Toughing of New York's Anti-Slapp Law

Weinstein's bill advances

a notably more streamlined

definition of a SLAPP suit,

while providing equally

robust protections for

public participation.

By M.J. Williams

On June 7, 2012, Assemblywoman Helene E. Weinstein, who chairs the New York State Assembly Committee on the Judiciary, introduced <u>legislation</u> that would significantly reform New York's anti-SLAPP statute. SLAPP, an acronym for "strategic lawsuits against public participation," refers to frivolous lawsuits calculated to silence citizens who express their views on matters of public interest.

New York was one of the first states to enact anti-SLAPP legislation (New York Civil Rights Law §§ 70-A and 76-A; CPLR 3211(g)-(h), enacted in 1992). However, according to Assemblywoman Weinstein's findings, New York's law has failed in two important ways to safeguard public participation against the threat of retaliatory lawsuits. As drafted and

interpreted the courts, the current law's scope is so narrow that it has failed to protect New York citizens from frivolous suits commenced solely to discourage their exercise of free speech or petition.

The law's principal remedy, the award of costs for attorneys' fees to SLAPP suit defendants, has also proven to be toothless, as shown in Assemblywoman Weinstein's

findings. The legislation sponsored by Assemblywoman Weinstein, Bill No. A10594, specifically addresses these failings.

First, the bill expands the law's scope. Currently, the statute defines a SLAPP suit as one related to "a public applicant or permittee." Assemblywoman Weinstein's explanation of the bill states that courts have strictly applied the law solely to cases based on controversies involving public permitting, generally in the context of real estate development. Each year, however, many frivolous lawsuits filed to chill free speech fall outside the anti-SLAPP law's ambit because they are not directly linked to the public "permit" process.

Assemblywoman Weinstein's bill is intended to reform the anti-SLAPP statute so that it provides protection for all free speech and public participation on matters of public concern. Specifically, the bill amends the definition of an "action involving public petition and participation" in Section 76-A of the Civil Rights Law to refer to claims based on

- 1. Any communication in a place open to the public or a public forum in connection with an issue of public concern; or
- ii. Any other lawful conduct in furtherance of the exercise of the constitutional right of free speech in connection with an issue of public concern, or in furtherance of the exercise of the constitutional right of petition.

According to Assemblywoman Weinstein, so revised, New York's anti-SLAPP legislation will better accomplish its original purpose, namely to provide "the utmost protection for the free exercise of speech, petition, and association rights, particularly where such rights are exercised in a public forum with respect to issues of public concern." L.1992 ch.767.

The bill also toughens the law's penalties by making mandatory the award of attorneys' fees to the victims of SLAPP suits brought in bad faith. Currently, this remedy is discretionary only. Assemblywoman Weinstein's findings revealed that while the Legislature originally intended the award of fees and costs to undo the threat of costly defense against frivolous suits, courts have all but failed to use their discretionary power to grant the remedy. The bill revises Section 70-A of the Civil Rights Law to direct that costs and attorneys' fees "shall be recovered upon a demonstration that [a SLAPP suit] was commenced or continued without a substantial basis in fact or law." Together, the two amendments are meant to reboot New York's protections against the chilling effect and financial hardship of abusive

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Studies of more robust anti-SLAPP laws were brought to the attention of Assemblywoman Weinstein's staff prior to her introducing the new legislation. Currently, 27 U.S. states and territories have anti-SLAPP statutes; of those, 22 make an award of attorneys' fees mandatory. The studies provided to Assemblywoman Weinstein pointed out, for instance, that more awards of attorneys' fees were granted to SLAPP suit defendants in the inaugural year of Texas's anti-SLAPP statute than in the nineteen years since New York enacted its law.

The bill would bring New York's law in line with legislation common in the rest of the county. In a departure,

however, from the recently passed statutes in Texas (H.B. No. 2973, effective 2011) and Washington State (RCW 4.24.525, effective 2010) and the often lauded, and frequently litigated, law in California (Cal. Civ. Proc. Code § 425.16, effective 1993), Assemblywoman Weinstein's bill advances a notably more streamlined definition of a SLAPP suit, while providing equally robust protections for public participation.

While already brought to the Assembly by the Committee on Rules, at Assemblywoman Weinstein's request, and referred to the Judiciary Committee, the bill has not yet been introduced in the New York Senate.

M.J. Williams is an associate at Satterlee Stephens Burke & Burke, LLP.

MLRC UPCOMING EVENTS

MLRC/NAA/NAB 2012 Media Law Conference Sept. 12-14, 2012 | Reston, Virginia

MLRC Annual Dinner & MLRC Forum November 14, 2012 | New York, NY

Defense Counsel Section
Annual Meeting and Lunch
November 15, 2012 | New York, NY

MLRC/Southwestern

Media & Entertainment Law Conference

January 17, 2013 | Los Angeles, CA

Unanimous Supreme Court Invalidates FCC's "Fleeting Expletives" Indecency Decisions and Denies Review of Invalidated Super Bowl Fine

New Policy Was Too Vague to Put Broadcasters on Notice

By Robert Corn-Revere and Ronald G. London

On June 21, 2012, the U.S. Supreme Court decided <u>FCC</u> <u>v. Fox Television Stations</u> by holding that Federal Communications Commission (FCC) decisions targeting "fleeting" broadcasts of allegedly indecent material were unconstitutional under the Due Process Clause. The decision reviewed FCC indecency findings against utterances of expletives by performers on Fox's live 2002 and 2003 <u>Billboard Music Awards</u> shows, and a scene from

ABC's NYPD Blue depicting the nude buttocks of an adult actress for seven seconds and the side of her breast momentarily. The Court reached the same ultimate outcome as the Second Circuit, which invalidated the FCC's actions on grounds its revised indecency regime was unconstitutionally vague under the First Amendment, though the Supreme Court did so on Due Process rather than First Amendment grounds. It thus vacated the decision below.

Justice Kennedy's unanimous 8-0 opinion (Judge Sotomayor having taken no part in the case) held the FCC standards, as revised in its indecency crackdown commencing in 2004, "as applied to these broadcasts were vague, and the Commission's orders must be set aside."

The Court declined to address the overall constitutionality of the current indecency policy as revised by the FCC's 2004 *Golden Globes* decision on "fleeting expletives," and it did not address whether the 1978 Supreme Court decision in *FCC v. Pacifica Foundation, Inc.* is still valid. The *Fox* decision states that it leaves the FCC free to modify its current indecency policy in light of *Fox* and "other applicable legal requirements," and lower courts free to review that or any modified policy based on its content

and application.

Due Process Clause Analysis

Though *Fox* presented such broad issues as whether the overall FCC indecency regime is unconstitutionally vague, and whether there remain grounds to treat "indecent" speech on broadcast media differently from such content on media like cable and the Internet (where it gets full First

Amendment protection), the narrow decision invalidated the FCC's indecency findings on traditional Due Process grounds. Justice Kennedy's opinion held that Fox and ABC lacked constitutionally sufficient notice of the FCC's policy as applied to these broadcasts, because the FCC historically had exempted fleeting material from its indecency enforcement policy. As such, application of the policy to the broadcasts at issue was "void for vagueness" under the Due Process Clause of the Fifth Amendment.

As the Court explained, this doctrine applies generally to all laws, and requires that regulated parties are able to know what is expected of them, and regulators to have guidelines that prevent arbitrary enforcement. The opinion adds, however,

that these requirements have special force in the First Amendment context to avoid chilling speech. Here, the Court held, the FCC's regulatory history "makes it apparent that the Commission policy in place at the time of the broadcasts gave no notice to Fox or ABC that a fleeting expletive or a brief shot of nudity could be actionably indecent."

In particular, all the shows at issue aired before the FCC rendered its *Golden Globes* decision, which reversed course

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on such "fleeting" material, and also held the expletives used in the broadcasts were presumptively indecent. Justice Kennedy wrote that the Due Process command that "a person of ordinary intelligence [have] fair notice of what is prohibited" prevented the FCC from issuing indecency findings against broadcasts that aired before the policy change. "This would be true with respect to a regulatory change this abrupt on any subject," he wrote, "but it is surely the case when applied to the regulations in question ... that touch upon sensitive areas of basic First Amendment freedoms."

The Court rejected the FCC's argument that Fox could not raise its vagueness challenge because the agency did not impose a sanction. Even though the FCC pledged it would not consider the prior indecent broadcasts in any context (such as on license renewal, or the amount of future fines, if any), the

Court held that the mere fact that its rules allowed it to make the findings against Fox sufficed: "Just as in the First Amendment context, the due process protection against vague regulations does not leave regulated parties at the mercy of *noblese oblige*." The Court further held that the injury to a broadcaster's reputation with viewers and advertisers was "further reason for granting relief."

The Court also rejected claims that ABC had sufficient notice the nudity

in *NYPD Blue* could be punishable, based on a 1960 FCC decision stating that "televising of nudes might well raise a serious question" of indecency. This, the Court held, was too "isolated and ambiguous" a statement to put broadcasters on notice, especially when subsequent decisions involving fleeting nudity resulted in FCC findings that the broadcasts were not actionable.

The Court stopped short of deciding the First Amendment issue, however, and declined to offer any opinion on whether the FCC may enforce its policy against isolated words or images in the future under *Golden Globes*. It also put off for another day any decision on the continuing validity of *Pacifica*. And it concluded, "this opinion leaves the [FCC] free to modify its current indecency policy in light of its determination of the public interest and applicable legal requirements," and "courts free to review the current policy

or any modified policy." In other words, the FCC could try to enforce its policy under *Golden Globes* going forward, or it could try to tweak the policy to make it clearer, but reviewing courts are free to rule on the constitutionality of its choice(s).

Ultimately, the Court vacated the Second Circuit opinions and remanded for further proceedings consistent with "the principles set forth in this opinion." Justice Ginsburg wrote a one-paragraph concurring opinion saying she would have reached the First Amendment issues and overruled *Pacifica*, which was "wrong when it was issued."

Court Denies Cert. in "Wardrobe Malfunction" Case

The *Fox* decision also all but ensured the Court would decline to review the Third Circuit's re-affirmance that the FCC improperly fined CBS for the "wardrobe malfunction" at the end of the Super Bowl XXXVIII halftime show, which

also was broadcast before the agency's change in policy on fleeting broadcasts of allegedly indecent material. And, sure enough, on June 29, 2012, the Supreme Court denied *certiorari* in *FCC v. CBS Corp.* The denial brings finality to the Super Bowl indecency action, and entitles CBS to a refund of the \$550,000 fine it had paid in the case.

As in *Fox*, Justice Ginsburg wrote a one -paragraph concurring opinion in the denial of *certiorari* in *FCC v. CBS*, noting that the

Fox decision gives the FCC a chance to reconsider its indecency policy "in light of technological advances" and the FCC's "uncertain course since this Court's ruling in FCC v. Pacifica." The Chief Justice also issued a concurring opinion in the FCC v. CBS denial, writing somewhat more expansively to question whether the appeals court was in fact correct that the FCC's fine departed from agency precedent. Nonetheless, the Chief Justice ultimately concluded, any error in that regard has been rendered moot by the Fox decisions. He added, however, that "[a]ny future 'wardrobe malfunctions' will not be protected on the ground relied on by the court below."

Robert Corn-Revere and Ronald G. London, Davis Wright Tremaine LLP in Washington, D.C., represented CBS Broadcasting Inc. Merits and amicus briefs are available online here.

Seventh Circuit Affirms South Park Parody Video Was Fair Use

Case Was Properly Dismissed Without Discovery

By Dan Laidman

A *South Park* parody of a popular viral video was such an obvious fair use that a judge was correct to promptly dismiss a copyright infringement claim against the show without putting its creators through burdensome discovery, the Seventh Circuit Court of Appeals has ruled. *Brownmark Films, LLC v. Comedy Partners*, No. 11-2620, 2012 U.S. App. LEXIS 11454 (7th Cir. June 7, 2012).

Courts have long recognized in other First Amendment-related contexts like defamation and the right of publicity that early dismissal of weak claims is crucial to avoid chilling protected speech with the prospect of costly, drawn-out litigation and invasive discovery. The Seventh Circuit's opinion Brownmark Films is the first appellate decision to extend this reasoning into the realm of copyright fair use.

The *Brownmark* decision is also significant for recognizing that parody cases require more than a rote

application of the traditional fair use factors, and that while a parody must inherently borrow a significant amount of the underlying piece, it does not necessarily supplant the market for the original work.

The case began with a 2008 *South Park* episode titled "Canada on Strike" that lampooned the 2007-2008 Writers Guild of America strike (which involved disputes over compensation for work distributed over the Internet), and the growing phenomenon of online viral videos. In the episode, the nation of Canada goes on strike seeking a greater share of "Internet money." The *South Park* schoolboys try to end the

strike by making their own viral video to raise money to placate the striking Canadians.

Background

The video the *South Park* characters produce is a parody of one of the earliest and most popular videos to go viral on YouTube, Samwell's "What What (In The Butt)." The

original "WWITB" video features a real-life adult singer who vamps through choruses of "I said, what what, in the butt" and "you want to do it in my butt, in my butt?" and lyrics such as "I will give you what you need; all I want is your big fat seed; give it to me, if you please," while highly sexualized imagery appears in the background. South Park parody, the song's crudely sexual lyrics are delivered by Butters Stotch, a fourth grader who is the most naïve and innocent of the show's animated schoolboys. Butters performs



A South Park parody of a popular viral video was such an obvious fair use that a judge was correct to promptly dismiss a copyright infringement claim against the show without putting its creators through burdensome discovery.

the song wearing versions of Samwell's iconic outfits, but he also appears dressed as an astronaut, a teddy bear, and a daisy.

Intercut with the Butters parody of WWITB are images of users viewing the video on "YouToob," and sure enough, the video goes viral and racks up an enormous number of hits. But when the boys go to the "Colorado Department of Internet Money" to claim their compensation, they are disappointed to be paid in "theoretical dollars." There they encounter animated versions of the real-life stars of several

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other iconic viral videos, including Tay Zonday of "Chocolate Rain," the Numa Numa Guy, the Tron Guy, the Dramatic Gopher, the Sneezing Panda, and Afro Ninja. Ultimately the episode pokes fun at Internet users' apparently insatiable appetite for inane viral videos, while pointedly parodying WWITB as one of the most widely-viewed viral videos of all time.

More than two years after the episode first aired, Brownmark Films LLC, the purported co-owner of a copyright in the WWITB video, sued Comedy Partners, MTV Networks, Paramount Home Entertainment Inc., Viacom International Inc., and South Park Digital Studios LLC ("South Park") for copyright infringement. South Park moved to dismiss for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6), arguing that its segment parodying WWITB was permitted by Section 107 of the Copyright Act, which protects the right to make limited "fair use" of copyrighted materials without the owner's consent and without having to seek a license, "for purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research." Brownmark responded by attacking the procedural propriety of deciding fair use on a motion to dismiss, but it did not address the substance of South Park's defense.

On July 6, 2011, Judge J.P. Stadtmueller of the United States District Court for the Eastern District of Wisconsin granted South Park's motion and dismissed Brownmark's complaint with prejudice. See Brownmark Films, LLC v. Comedy Partners, 800 F. Supp. 2d 991 (E.D. Wis. 2011). Judge Stadtmueller acknowledged that it was "irregular" to decide an affirmative defense such as fair use when ruling on a Rule 12(b)(6) motion, which is meant to test the legal sufficiency of the plaintiff's claims based on the pleadings themselves. However, the judge determined that it was proper to grant a motion to dismiss based on an affirmative defense where, as here, the allegations of the complaint and material incorporated by reference therein provide everything necessary to satisfy the defense. Viewing the original WWITB video and the South Park episode side-by-side provided everything the judge needed to conclude that the South Park video was "a classic parody" constituting a protected fair use. The judge found that early dismissal was appropriate because, given "the rather obvious resolution of the substantive underlying issue, the court can conclude that this dispute simply does not warrant 'putting the defendant[s] through the expense of discovery."

Brownmark appealed, arguing that fair use is a fact-based defense that cannot be decided on a motion to dismiss for failure to state a claim. South Park countered that when two videos incorporated by reference into the pleadings provide all a court needs to adjudicate fair use, there is no reason to delay a ruling. Moreover, South Park argued that early dismissal of copyright claims challenging obvious parodies serves important First Amendment and public policy goals, because the specter of having to defend against costly lawsuits and undergo burdensome and intrusive discovery could discourage important but controversial expression, such as parody and criticism - a classic "chilling effect." This argument was echoed and expanded in an amicus brief supporting South Park filed by the Electronic Frontier Foundation, an organization that is sometimes at odds with large media companies on copyright issues. However, in this case EFF sided with Viacom because it saw Brownmark's lawsuit as an example of the "rapidly escalating problem of 'copyright trolls' - i.e., entities that embrace copyright litigation as a business model." Without a mechanism for early dismissal, EFF argued, speakers who rely on the fair use defense are at risk because the threat of drawn-out discovery provides plaintiffs with the leverage to extract quick settlements no matter how weak their claims.

Seventh Circuit Decision

On June 7, 2012, a unanimous Seventh Circuit panel ruled in South Park's favor, affirming Judge Stadtmueller's opinion while calling it "well-reasoned and delightful." Judge Richard D. Cudahy wrote the opinion, and was joined by Chief Judge Frank H. Easterbrook and Judge David F. Hamilton.

For the first time in a federal appellate decision, the Court recognized the importance of early dismissal in the fair use context, acknowledging that the "expense of discovery ... looms over this suit." Agreeing that "the only two pieces of evidence needed to decide the question of fair use" were the original WWITB video and the *South Park* episode, the Seventh Circuit concluded that it was "an obvious case of fair use."

Judge Stadtmueller granted South Park's motion to dismiss after finding that the videos were incorporated by reference into the pleadings. The appellate panel took a slightly different approach, noting that whether the incorporation-by-reference doctrine applies to videos is a

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question of first impression in the Seventh Circuit, and opting not to resolve the issue.

The Court did note that "it makes eminently good sense to extend the doctrine to cover [television programs and other] such works, especially in light of technological changes that have occasioned widespread production of audio-visual works." The Court's stated rationale for not reaching the question was that the parties did not brief the issue, although South Park discussed the issue extensively in its briefing.

Rather, the Seventh Circuit treated South Park's Rule 12 (b)(6) motion to dismiss as a Rule 56 motion for summary judgment, and affirmed on that basis. The Court acknowledged that South Park had avoided captioning its motion as a request for summary judgment because such motions usually come after discovery. However, the Seventh Circuit explained that district courts do not have to grant discovery requests at this stage, and that they "ought not" in cases like this where "it is clear that the case turns on facts already in evidence."

The Court noted that Brownmark argued – for the first time on appeal – that it needed discovery into the state of mind of *South Park*'s creators, "all relevant video images or clips" including images created for purposes divorced from the "Canada on Strike Episode," and licensing information related to the episode. The panel found that "such a broad discovery request, surely entailing expensive e-discovery of emails or other internal communications, gives Brownmark the appearance of a 'copyright troll.'" Therefore, the Court concluded that regardless of the caption on South Park's motion, the district court properly decided the case based on the two videos alone without requiring additional discovery.

Turning to the substance of the fair use argument, the Seventh Circuit agreed with South Park that Brownmark waived its opposition to the defense by failing to argue the merits of fair use in the district court. However, the Court nonetheless went through the Section 107 factors and affirmed Judge Stadtmueller's conclusion that South Park's use was privileged, providing a rare and important appellate decision about the scope of the parody defense. The Seventh Circuit explained that "[w]hen a defendant raises a fair use defense claiming his or her work is a parody, a court can often decide the merits of the claim without discovery or a trial." Viewing the two videos side-by-side, the Court determined that "the South Park episode is clearly a parody of the original WWITB video, providing commentary on the

ridiculousness of the original video and the viral nature of certain YouTube videos."

Section 107 of the Copyright Act presents four non-exclusive factors to determine if a use is protected: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use on the potential market for or value of the copyrighted work. See 17 U.S.C. § 107.

On the first factor, the Court held that South Park's "parodic use has obvious transformative value." As to the second factor, the Court acknowledged that WWITB is itself a creative work within the "core of copyright protection," but it explained that "[i]n the context of parody, this factor offers little help to Brownmark" because parodies inevitably copy known expressive works.

Regarding the amount used, the Seventh Circuit found that South Park's use was "not insubstantial" and that it had used the "heart" of the original work, but again held that this was not especially important in the context of parody. The Court reasoned that "when parody achieves its intended aim, the amount taken becomes reasonable when the parody does not serve as a market substitute for the work."

Because South Park's video was "clearly a parody," the Court explained that it "has not supplanted" the market for the original WWITB video. Therefore, with respect to the fourth factor, the Court held that Brownmark failed to present any "concrete suggestion about potential evidence indicating that the *South Park* parody has cut into any real market (with real, non-Internet dollars) for derivative uses" of the original WWITB video. The Seventh Circuit concluded its analysis with the observation that the *South Park* episode's "likely effect, ironically, would only increase ad revenue" for Brownmark.

Indeed, according to statistics on the WWITB YouTube page, the video had been viewed about 10 million times around the time that the "Canada on Strike" episode aired in 2008. As of this week, WWITB has more than 47 million views. The original WWITB video can be viewed at this link; the South Park parody is available here.

Comedy Partners, MTV Networks, Paramount Home Entertainment Inc., Viacom International Inc., and South Park Digital Studios LLC are represented in this matter by Alonzo Wickers, Jeff Glasser, and Dan Laidman of Davis Wright Tremaine in Los Angeles and Michelena Hallie of Viacom Media Networks in New York.

Artist's Depictions of College Football Team Protected By First Amendment

Expressive Right Trumps Trademark Claim

In June, the Eleventh Circuit Court of Appeals held that unlicensed artistic depictions of a university football team in paintings, prints, and calendars did not violate the Lanham Act because they were protected by the First Amendment. *Univ. of Ala. Bd. Of Trs. v. New Life Art, Inc., 2012 WL* 2076691 (11th Cir. June 11, 2012) (Anderson, Martin, Schlesinger, JJ.).

The University of Alabama (U of A) brought suit alleging that an artist's inclusion of the school's football uniforms in

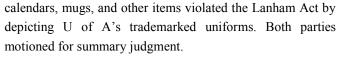
paintings, prints, calendars, mugs, and other items infringed on the school's trademarks held in the uniform. In a strong affirmation of expressive rights, the Eleventh Circuit held that the artist's right to freedom of expression outweighed U of A's trademark rights, and most of the artist's products were therefore entitled to First Amendment protection.

Background

The case arose out of the work of artist Daniel Moore, who since 1979 has been painting famous football scenes involving the U of A Crimson Tide football team. From 1991-1999, Moore had yearly licensing agreements with U of A for the production and

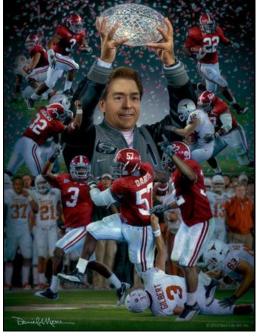
marketing of certain items. After 1999, he continued to create new products without a licensing agreement. In 2002, U of A contacted Moore to inform him that he would need to license all of his U of A-related products because they contained depictions of various U of A trademarks. Believing that he did not need a licensing agreement to paint historical events, Moore continued his business as per usual.

In 2005, U of A brought suit in federal court in the Northern District of Alabama alleging that Moore breached their prior agreements and that Moore's paintings, prints,



The district court granted summary judgment to Moore on the paintings and prints by finding that the depiction of uniforms there was protected by the First Amendment and constituted fair use. However, the court granted summary judgment to U of A with regard to the mugs, calendars, and other "mundane products." For those items, the court found

Moore to be violating the Lanham Act because uniform depictions there were not protected by the First Amendment, did not constitute fair use, and would likely result in consumer confusion. Both sides appealed those rulings to the Eleventh Circuit.



Impact of Prior Licensing Agreements

The Eleventh Circuit first considered U of A's allegations relating to the depiction of uniforms in paintings, prints, and calendars. In its ruling, the district court considered calendars to be more similar to smaller replications on mugs or post-cards. However the circuit court found calendars to be more analogous to

works like paintings and prints for which the artistic work itself is much more likely to be considered significant by the purchaser.

U of A argued that its licensing agreements with Moore completely prohibited Moore from any unlicensed portrayal of U of A uniforms. However, the court found the licensing contract to be ambiguous on this point, and, applying Georgia law, the court resolved that ambiguity by exploring the parties' course of conduct during and after the contracts' duration.

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The court found that (1) between 1991-2002, Moore produced new paintings and prints containing the U of A uniforms for which no royalties were requested; (2) U of A had sold Moore's unlicensed calendars in its own campus stores; (3) in 2001, U of A asked Moore to sketch an unlicensed work of art on live television during a nationally televised football game; (4) U of A's athletic department displayed Moore's unlicensed paintings in its offices; and (5) U of A had issued press passes to Moore so he could take photographs to use as the basis for his paintings. The court concluded that this "course of conduct clearly indicates that [the parties] did not intend that Moore would need permission every time he sought to portray the University's uniforms in the content of his paintings, prints, and calendars."

Trademark Analysis

The court then moved on to U of A's claim that the depictions of its uniforms in unlicensed paintings, prints, and calendars "infringe on the University's trademarks because... [they create] a likelihood of confusion on the part of the buyers that the University sponsored or endorsed the product." That confusion, U of A argued, constituted a violation of the Lanham Act, 15 U.S.C. § 1125(a), which prohibits the commercial use of symbols "likely to cause confusion... as to the origin, sponsorship, or approval" of goods or services.

To sort out that issue, the court invoked the test adopted by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d. Cir. 1989), whereby the Lanham Act only applies to artistic works if "the public interest in avoiding consumer confusion outweighs the public interest in free expression." The court further noted that other circuits in *ESS Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) and *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915 (6th Cir. 2003), have similarly invoked the *Rogers* test to prevent the Lanham Act from inhibiting First Amendment rights.

However, U of A attempted to distinguish those cases from its own situation by pointing out that Moore's artwork is not a parody and does not infringe on rights of publicity. However, the court rejected that argument by finding that the *Rogers* test is "generally applicable to works of artistic expression" and that the common element between U of A's

claims and those other cases is the alleged false endorsement, not the right of publicity. Thus, the court declared that it has "no hesitation in joining our sister circuits by holding that we should construe the Lanham Act narrowly when deciding whether an artistically expressive work infringes a trademark."

In light of that narrow construction, the court found that (1) Moore's uniform depictions are "artistically relevant" because they "are needed for a realistic portrayal" of historical scenes; and (2) Moore's unlicensed products contained no claim that they were "endorsed" or "sponsored' by U of A. Consequently, the court concluded that the "risk of misunderstanding... is so outweighed by the interest in artistic expression as to preclude' any violation of the Lanham Act." Therefore, the court affirmed the district court's ruling for prints and paintings and reversed its ruling on the calendars. For those three categories, the court found that the First Amendment protected Moore's ability to depict U of A's uniforms without a licensing agreement.

Mugs and Other "Mundane Products"

Just as with the paintings, prints, and calendars, the court concluded that the contract is ambiguous as to whether it prohibits Moore's unlicensed depictions of uniforms on mugs and other "mundane products."

But, for these items, the circuit court found that the record lacked sufficient evidence relating to the parties' course of conduct on which to resolve that ambiguity. As such, the court remanded the case for further proceedings on this issue. Importantly, however, the court explained that Moore had waived his First Amendment defense for these items by not raising it on appeal.

The University of Alabama was represented by Jay Ezelle, Tabor R. Novak, III, and Walter W. Bates of Starnes & Atchison LLP in Birmingham and by Richard Randolph Edwards, R. Charles Henn, Jr., and Jerr B. Swann of Kilpatrick Townsend & Stockton, LLP in Atlanta. Daniel Moore was represented by Stephen D. Heninger and Gayle L. Douglas of Heninger Garrison Davis LLC in Birmingham, by Robert Larry Bradford of Johnstone Adams Bailey Gordon & Harris LLC in Birmingham, by Tomas C. Phelps, III and Shane T. Sears of Bradford & Sears, PC in Birmingham, and by W. Staneil Starnes of Starnes Davis Florie, LLP in Birmingham.

Court Rejects "Soul Man" Singer's Claims Based on "Soul Men" Movie and Soundtrack

Trademark in Titles Protected Where They Do Not "Explicitly Mislead"

By Laura P. Merritt and Emily J. Zibart

A federal district court in Nashville recently granted summary judgment to defendants on all claims asserted by Sam Moore, formerly of the soul music group "Sam & Dave." *Moore v. The Weinstein Company, LLC, et al.*, No. 3:09-cv-00166 (M.D. Tenn. May 23, 2012). Moore is probably best known for his versions of the songs "Soul Man" and "Hold On I'm Comin" in the 1960s. His claims related to the 2008 feature film "Soul Men," starring Samuel L. Jackson and the late Bernie Mac.

The lawsuit was filed in 2009 by Mr. Moore, his wife and

manager Joyce Moore, and their purported Tennessee trust. They sued The Weinstein Company (the film studio that produced and released the film), Metro-Goldwyn-Mayer Studios, Inc. (the film's theatrical distributor), Genius Products, LLC (the distributor of the DVD), Concord Music Group, Inc. (the creator and distributor of the film's official soundtrack), and Harvey and Bob Weinstein (the film's executive producers and principals of The Weinstein Company).

The existence of some
"broad stock similarities"
between the movie's
characters and Mr. Moore
and/or "Sam & Dave" "[did]
not even approach
establishing that the Movie
and the Soundtrack are
explicitly misleading as to
their content."

Background

"Soul Men" is a comedy centering on the reunion of two feuding former back-up soul singers known as "The Real Deal," who reluctantly agree to reunite following the sudden death of their former band leader in order to sing at his memorial tribute show at New York City's famed Apollo Theater. At the heart of the lawsuit were the plaintiffs' allegations that Louis Hinds, the character in the film played by Samuel L. Jackson, was intended to portray plaintiff Mr. Moore, and that the film's title, "Soul Men," infringed common law trademark rights purportedly owned by one or more of the plaintiffs in terms including "Soul Man," "Soul Men," "The Original Soul Men," "The Original Soul Man," and "The Legendary Soul Man."

The Plaintiffs asserted nine separate claims: (1) violation of the right of publicity under Tennessee statutory and common law; (2) false light invasion of privacy; (3) unfair competition pursuant to Section 43(a) of the Lanham Act, based on alleged common law trademark rights; (4) violation of the Tennessee Consumer Protection Act; (5) common law unfair competition; (6) unjust enrichment; (7) trademark dilution pursuant to Section 43(c) of the Lanham Act; (8) civil conspiracy; and (9) state trademark dilution.

The defendants initially sought dismissal of the case on grounds including the First Amendment protections available

to expressive works, while also seeking dismissal of all claims against the individual defendants, Harvey and Bob Weinstein, based on a lack of personal jurisdiction. In 2010, the district court granted defendants' motion with respect to the individual defendants, but declined to dismiss the plaintiffs' substantive claims under Rule 12.

After the close of a protracted and contentious discovery period, plaintiffs attempted to add a common law copyright claim alleging use of Mr. Moore's ad lib

"catch phrase" coined in a 1966 sound recording. The magistrate judge denied the plaintiff's motion to add the copyright claim, and the district court denied plaintiffs' motion for reconsideration. *See Moore*, No. 3:09-cv-00166 (M.D. Tenn. May 11, 2012). The court rejected plaintiffs' argument that they were not aware of the claim until deposition testimony indicated that a film producer might secure consent for the use of an ad lib phrase. Furthermore, the court found that there would be substantial prejudice to defendants in allowing the unjustifiably untimely copyright claim that was "likely futile."

In early 2012 the defendants filed a motion for summary judgment on all claims. In a ninety-eight page opinion, the court granted the defendants' motion in its entirety. As a

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preliminary matter, the court disposed of all claims brought by Joyce Moore and the plaintiff trust, finding that plaintiffs had failed to articulate any viable claims by those parties. Accordingly, the remainder of the court's opinion focused solely on the claims of Mr. Moore.

Lanham Act and Unfair Competition Claims

In addressing Mr. Moore's claim of unfair competition under Section 43(a) of the Lanham Act, the court noted that two separate types of trademark claims were at issue. The first type involved the alleged infringement of rights claimed by Mr. Moore in the common law marks "Soul Man," "Soul Men," "The Original Soul Men," "The Original Soul Man," and "The Legendary Soul Man" in connection with his services as an entertainer. The second consisted of a competing titles claim based on Mr. Moore's purported ownership of rights in the titles "Sam & Dave: Soul Men" (a "Sam & Dave" album released on the Atlantic Records label in the 1960s) and "The Original Soul Men: Sam & Dave" (a documentary about "Sam & Dave" produced by Historic Films and released in the United States in 2008).

Applying the standard established in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), which provides that the use of a trademark in the title of an expressive work is protected by the First Amendment unless the mark "has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or content of the work," the court found that Mr. Moore's claims based on his purported service marks were barred by the First Amendment. As noted by the court, "the Movie and Soundtrack titles do not explicitly reference Mr. Moore or Sam & Dave, neither Mr. Moore nor Sam & Dave are mentioned in the script, and plaintiffs have no cited to any marketing materials or promotional materials that incorporate explicit references to Sam & Dave or Mr. Moore." The existence of some "broad stock similarities" between the movie's characters and Mr. Moore and/or "Sam & Dave" "[did] not even approach establishing that the Movie and the Soundtrack are *explicitly misleading* as to their content."

The court then disposed of Mr. Moore's competing titles claim on the dual bases that Mr. Moore had neither produced evidence of a cognizable interest in the titles, nor provided any evidence to support a finding of likelihood of confusion between the film title, "Soul Men," and the album and

documentary titles at issue. Assuming the two titles qualified as trademarks, the court found that they were entitled to "at most . . . a minimal level of protection" due to the large number of third party entertainers and uses associated with the terms "soul man" or "soul men" and the dearth of evidence regarding Mr. Moore's promotion and enforcement of the purported marks. Relevant factors including differences in the marks, the lack of evidence of intent on the part of defendants, differences in marketing channels, and unlikelihood of Mr. Moore's expansion into a directly competing product line further weighed against any likelihood of confusion. Mr. Moore's state unfair competition claims failed for the same reasons as his claims under Section 43(a) of the Lanham Act, and because the record did not indicate the existence of any actual confusion between the titles at issue, as would be required to support such a claim under Tennessee law.

The court similarly disposed of Mr. Moore's federal and state law dilution claims, finding that Mr. Moore had failed to establish that any of the marks being asserted were "famous" pursuant to the relevant factors set forth in Section 43(c)(2) of the Lanham Act.

Right of Publicity

The court found that Arizona law governed the plaintiffs' claims based on the Restatement's "most significant relationship" test. None of the parties were current residents of Tennessee, and the majority of the filming of "Soul Men" took place outside of Tennessee. The court found plaintiffs' allegations of links between the claims and Tennessee, including that plaintiffs occasionally received forwarded mail in Arizona originally addressed to a Nashville address and that Joyce Moore retained her Nashville area code cell phone number, immaterial and insufficient to establish the necessary relationship.

To establish a claim for invasion of the right of publicity, a plaintiff must show (1) the defendants' of use of the plaintiff's identity; (2) the appropriation of the plaintiff's name or likeness to the defendant's advantage, commercial or otherwise; (3) lack of consent; and (4) resulting injury. The court agreed with the defendants' argument that plaintiffs had not established either of the first two elements of a right of publicity claim because plaintiffs had not shown evidence that defendants used Mr. Moore's name or likeness. The

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movie does not contain any reference to Mr. Moore or "Sam & Dave," nor does it contain any likeness or image of them.

Alternatively, the court determined that, even if Tennessee law governed the claim, it would still fail because plaintiffs had not provided evidence from which a reasonable fact finder could conclude that defendants "knowingly use[d] or infringe[d] upon Mr. Moore's name, photograph or likeness" as required under the applicable Tennessee statute. *See* Tenn. Code Ann. § 47-25-1105(a).

False Light Invasion of Privacy

The court rejected plaintiffs' false light invasion of privacy claim because there was no basis from which a reasonable jury could conclude that "Soul Men" "concerns" Mr. Moore. The movie is simply a fictional homage to a bygone era of R&B music that does not purport to portray Mr. Moore or "Sam & Dave," does not reference Mr. Moore or "Sam & Dave" in the script, and contains no images of Mr. Moore or "Sam & Dave." The court ruled that elements of the film — including an internal feud followed by ultimate reconciliations — were "stock elements" of any entertainment picture about a musical group and could not reasonably be interpreted as intended to portray "Sam & Dave."

As an additional basis for its ruling, the court held that, even if Mr. Moore could satisfy the elements a false light claim, he had not produced evidence of actual malice, which he conceded applied. The court held that, although the record indicated that the movie's scriptwriters and producers were generally aware of "Sam & Dave," the producers had incorporated a cover version of "Hold On I'm Comin" in the movie and considered utilizing another song performed by "Sam & Dave," and a friend of Mr. Moore's and Mr. Moore's counsel had informed The Weinstein Company of Mr. Moore's belief that publication of the movie might violate Mr. Moore's rights, none of this evidence suggested that the defendants actually entertained serious doubts as "truthfulness" of the movie. The court determined that because none of the individuals involved in creating the movie intended for the movie to concern Mr. Moore, they could not have intended for it to portray a "truthful" account of his life. The fact that plaintiffs wrote to defendants to express their subjective concerns is not sufficient to establish actual malice.

Unjust Enrichment

The court found several independent reasons to reject Plaintiffs' unjust enrichment claim. First, the court noted it was unclear what "benefit" Mr. Moore could have contributed to the movie. Second, the court pointed out that Plaintiffs had not identified any case in which a court applied a theory of unjust enrichment to a lawsuit primarily related to infringement or appropriation of a person's trademark and privacy rights. Finally, even if Mr. Moore could otherwise establish the elements of unjust enrichment, because the benefits plaintiffs alleged to have conferred were his trademark and public person, the First Amendment required that Plaintiffs meet the elements of the *Rogers* test, which they had not done.

Conspiracy

The court also found for the defendants on plaintiffs' conspiracy claim because the defendants were entitled to summary judgment on all of the underlying tort claims. Nonetheless, the court also ruled that the movie and DVD distributors, MGM and Genius, were also entitled to summary judgment because the only evidence presented of their involvement was that MGM entered into a global distribution agreement with The Weinstein Company to distribute a number of movies, including "Soul Men," and Genius distributed the "Soul Men" DVD pursuant to a standard distribution agreement.

Similarly, the court additionally held that The Weinstein Company and Concord were also entitled to judgment on Plaintiffs' conspiracy claim, rejecting Plaintiffs' suggestion that they colluded to promote Concord's efforts to re-launch the "Stax brand." The court found it was unclear if Concord's plan to re-launch the Stax brand had any relevance to the conspiracy claim and that it nonetheless did not provide sufficient evidence from which a jury could conclude that Concord and The Weinstein Company engaged in a common plan to commit a tort against Mr. Moore.

All defendants were represented by Robb S. Harvey and Heather J. Hubbard of Waller, Lansden, Dortch & Davis, LLP, Nashville. The authors are associates at the firm. The Weinstein Company, Bob Weinstein and Harvey Weinstein were also represented by Bertram Fields of Greenberg Glusker Fields Claman & Machtinger LLP, Los Angeles. The Plaintiffs were represented by Arnold P. Lutzker of Lutzker & Lutzker LLP, Washington, D.C. and Sean Martin, Nashville.

Google Books Update: S.D.N.Y. Denies Google's Motion to Dismiss, Grants Class Certification to Authors Guild

Fair Use Decision Likely

By Ryan Fox

In the latest development in the *Authors Guild v. Google* litigation, Judge Denny Chin, sitting by designation, denied Google's motion to dismiss the copyright infringement claims against it in the Southern District of New York, and granted the Authors Guild's motion for class certification. *Authors Guild v. Google, Inc. American Society of Media Photographers, et al. v. Google, Inc.*, Nos. 05 Civ. 3136 (DC), 10 Civ. 2977 (DC), 2012 WL 1951790 (S.D.N.Y. May 31, 2012) (Chin, J.). The decision brings this case one step closer to the major fair-use determination anticipated by many throughout this litigation.

Background

The Authors Guild and its representative plaintiffs originated a class action suit in 2005, alleging that Google engaged in massive copyright infringement by scanning over 12 million in-copyright books from the stacks of major research libraries and publicly

displaying "snippets" of these works for internet search purposes. This copying is the cornerstone of the "Google Books" project.

After conducting discovery, the parties began settlement talks in late 2006 and filed a proposed settlement agreement two years later. When the proposed settlement met with objections, the parties reconvened and executed an Amended Settlement Agreement, which was preliminarily approved by Judge Chin in November, 2009.

Objections were filed again, many by class members. The Department of Justice raised concerns, and amici briefs were filed on both sides. After a fairness hearing, Judge Chin declined to approve the Amended Settlement Agreement in March, 2011.

In 2010, the American Society of Media Photographers and its representational plaintiffs brought a similar class

action, also charging Google with copyright infringement arising from the Google Books project.

In defense to both class action suits, Google argues that its copying amounts to fair use. The present decision concerns (1) Google's motion to dismiss both "associational plaintiffs" (the Authors Guild and the American Society of Media Photographers) for lack of standing, and (2) the Authors Guild's motion for class certification.

Google's Motion to Dismiss

Google challenged whether the associational plaintiffs (together, the Authors Guild and the American Society of

Media Photographers)—not having been injured themselves—have standing to represent individual authors and visual artists whose works had been copied without permission. Judge Chin held that the doctrine of associational standing does in fact allow the organizations to litigate on behalf of their members.

To determine associational standing, courts apply the three-pronged test stated in *Hunt v. Wash. State Apple Adver. Comm'n*, 432 U.S. 333 (1977). "[A]n association has standing to bring suit on behalf of its members when: (a) its members would otherwise have standing to sue in their own right; (b) the interests it seeks to protect are germane to the organization's purpose; and (c) neither the claim asserted nor the relief requested requires participation of individual members in the lawsuit." *Id.* at 343.

Google agreed that the first two prongs of the *Hunt* test were satisfied. So, the associational standing issue hinged on whether either the claim or the requested relief "requires the participation of individual members in the lawsuit." Is each injured individual's participation necessary to properly resolve the case? No, said Judge Chin. Google argued that

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The decision brings this case one step closer to the major fair-use determination anticipated by many throughout this litigation.

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two fair-use factors—"the nature of the copyrighted work" and "the effect of the use upon the potential market for or value of the copyrighted work"—require an individualized inquiry, because different works require different treatment.

Judge Chin, however, pointed out that Hunt's third prong focuses on "matters of administrative convenience and efficiency" (citing *United Food and Commercial Workers Union Local 751 v. Brown Grp., Inc.*, 517 U.S. 544, 557 (1996)). Accordingly, he decided in the organizations' favor, holding that here no individualized inquiry is necessary, because different types of works properly can be analyzed by classifying them in sub-groups such as "fiction, non-fiction, poetry, and cookbooks" and then assessing the merits of the fair use defense as it applies to each sub-group. In a passage notable for its admonitory tone, Judge Chin wrote,

When Google copied works, it did not conduct an inquiry into the copyright ownership of each work; nor did it conduct an individualized evaluation as to whether posting "snippets" of a particular work would constitute "fair use." It copied and made search results available en masse. Google cannot now turn the tables and ask the Court to require each copyright holder to come forward individually and assert rights in a separate action. Because Google treated the copyright holders as a group, the copyright holders should be able to litigate on a group basis.

Authors Guild's Motion for Class Certification

As one might infer from the foregoing passage, the class certification issue was resolved more easily, and in favor of the Authors Guild. Here Google made its stand behind the Rule 23(a) adequacy requirement, arguing there is "a fundamental conflict between the interests the named plaintiffs seek to advance and the interests of absent class members."

Google supported this argument by presenting a survey in which 58% of authors approved of Google scanning their work for search purposes, and 19% feel they benefit financially from Google's scanning. However, according to Judge Chin, "[the fact] that some class members may prefer to leave the alleged violation of their rights unremedied is not a basis for finding the lead plaintiffs inadequate."

So, authors and visual artists, along with the associations representing them, can take comfort in this procedural victory, and those following the case for its fair use implications can take comfort in the fact that it's a good deal closer to being decided on the merits.

Ryan Fox is a Legal Intern at the Authors Guild and a 3L at Fordham Law School. He is Editor-in-Chief of the Fordham Intellectual Property, Media & Entertainment Law Journal. Plaintiffs were represented by Michael J. Bon and Joanne E. Zack of Boni & Zack LLC (Bala Cynwyd, PA); Sanford P. Dumain of Milberg LLP (New York, NY); Jeffrey Paul Cunard and Bruce P. Keller of Debevoise & Plimpton LLP (New York, NY); and Robert J. Larocca of Kohn, Swift & Graf, P.C. (Philadelphia, PA).

Defendants were represented by Ronald Lee Raider and Alex Seth Fonoroff of Kilpatrick Townsend & Stockton LLP (Atlanta, GA); Adam Howard Charnes and Joseph M. Beck of Kilpatrick Stockton LLP (Winston-Salem, NC); Daralyn Jeannine Durie, David Floyd McGowan, Genevieve P. Rosloff, and Joseph C. Gratz of Durie Tangri LLP (San Francisco, CA); and Jeffrey A. Conciatori of Quinn Emanuel (New York, NY).

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Trademark Lawsuit Over Hangover II Dismissed

Images of Knock-off Bag Not Actionable

A New York federal district court this month held that the use of a knock-off Louis Vuitton (LV) bag in "The Hangover" movie sequel was protected by the First Amendment, and therefore did not violate LV's trademark rights. Louis Vuitton Malletier S.A. v. Warner Brothers Entertainment Inc., 2012 WL 2248593 (S.D.N.Y. June 15, 2012) (Carter, Jr., J.).

LV had alleged that the use of the knock-off bag in the movie infringed on its trademark rights under the Lanham Act. In its ruling, the court held that Warner Bros.' (WB) use of the bag was protected by the First Amendment because it

was artistically relevant to the movie and it did not explicitly mislead viewers as to the origins of the film.

Background

The case arose out of the 2011 WB movie "The Hangover: Part II" (Hangover II), which was the sequel to the 2009 movie "The Hangover." In an early scene in Hangover II, the movie's main characters are shown walking through the Los

Angeles airport and a porter

is shown pushing a dolly with what appear to be LV brand trunks, luggage, and travel bags. One character, Alan, is shown carrying what appears to be a matching over-the-shoulder LV bag, but Alan's bag is actually a trademark-infringing knock-off bag made by a company called Diophy. Alan later sits down on a chair and places the Diophy bag on the chair next to him. When another character moves the Diophy bag, Alan, mispronouncing the brand, says: "Careful that is... that is a Lewis Vuitton."

In December 2011, LV brought suit against WB, alleging that "[b]y using the infringing Diophy [b]ag and affirmatively

misrepresenting that it is a Louis Vuitton bag," viewers of Hangover II will think that the Diophy bag is a genuine LV product and that LV has sponsored and endorsed WB's use of a knock-off. LV asserted three causes of action stemming from that allegation: a federal false designation claim in violation of the Lanham Act, 15 U.S.C. § 1125(a), and state law claims of unfair competition and trademark dilution. WB moved to dismiss LV's complaint "on the ground that its use of the Diophy bag in the Film is protected by the First Amendment under the framework established by *Rogers v. Grimaldi*, 875 F.2d 994 (2d. Cir. 1989)."



The court held that Warner Bros.' use of the bag was protected by the First Amendment because it was artistically relevant to the movie and it did not explicitly mislead viewers as to the origins of the film.

The *Rogers*Balancing Test

To determine whether the First Amendment barred LV's claims, the court applied the Second Circuit's Rogers test to determine whether public's interest freedom of expression outweighs the public's interest in avoiding consumer confusion. Under that test, Lanham Act i s inapplicable to 'artistic works' so long as the defendant's use of the mark

is (1) 'artistically relevant' to the work' and (2) not 'explicitly misleading' as to the source or content of the work." If those two conditions are fulfilled, then WB's use of the Diophy bag would be protected by the First Amendment from LV's Lanham Act claim, as well as its state law claims.

Bag Was "Artistically Relevant" to the Movie

To determine the Diophy bag's "artistic relevance" to Hangover II, the court analyzed the context in which the bag

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was presented and discussed. The court noted that Alan's comment in combination with the bag's appearance came across as "funny," "snobbish," and "ironic" and introduced the plot's "comedic tension." As a result, the court saw the bag's brief presence as contributing to the movie's comedic, and therefore artistic, function.

Nevertheless, LV argued that discovery was needed to determine whether WB intentionally used a knock-off bag or not. Only with that evidence, LV claimed, could a ruling be made as to whether the use of the Diophy bag was truly "artistically relevant" to the movie.

However, the court found that the threshold for artistic relevance is "purposely low." The court noted that regardless of WB's intentions as to the authenticity of the bag, the use of the bag "was intended to create an artistic association with Louis Vuitton, and there is no indication that its use was commercially motivated." Consequently, the court held that discovery was unnecessary, as it could already declare that the use of the Diophy bag was "artistically relevant" to the movie.

Did Not "Explicitly Mislead" Viewers as Origin

Citing the Second Circuit's ruling in *Twin Peaks Prods.*, *Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366 (2d. Cir 1993), a case that applied the *Rogers* test, the court explained that the inquiry on the second *Rogers* condition "is whether [WB's] use of the mark 'is misleading in the sense that it induces members of the public to believe [the work] was prepared or otherwise authorized" by LV. In that vein, the Lanham Act will only outweigh First Amendment rights "when trademarks are used to 'dupe[] consumers into buying a product they mistakenly believe is sponsored by the trademark owner."

Nevertheless, LV attempted to argue that the court should impose liability on WB under the Lanham Act based on allegations that viewers would be misled into believing that (1) the Diophy bag was made by LV; and (2) LV approved the use of the Diophy bag in the movie. However, the court found that, under the Lanham Act as applied in *Rogers* and *Twin Peaks*, these allegations were insufficient to state a claim because they do not suggest that any confusion was created as to the origins of WB's artistic work. As the court wrote, "Louis Vuitton does not allege that Warner Bros. used the Diophy bag in order to mislead consumers into believing that Louis Vuitton produced or endorsed the Film." Thus, the type of confusion alleged by LV is not actually covered by the Lanham Act.

The court went on to note that even if LV's allegations did sufficiently allege a claim, it would still fail under the Rogers test which requires that "the likelihood of confusion must be particularly compelling" for Lanham Act claims to override First Amendment protection. In the court's view, any confusion alleged by LV was quite minimal because (1) viewers would not know that the bag was a knock-off; (2) viewers would not take Alan's comments as to the bag's origins seriously; and (3) there was no reason to assume that Alan affirmatively misrepresented the bag's origins rather than thinking that he was simply misinformed. Because the likelihood of confusion is so low, "the public's interest in avoiding consumer confusion... is not so great as to overcome the significant threats to free expression from holding Warner Bros. liable for its noncommercial speech." While LV presented a final objection that it is inappropriate to apply the Rogers test on a motion to dismiss, the court affirmed its application of the test at this juncture by noting that "no amount of discovery will tilt the scales in favor of [LV] at the expense of the public's right to free expression."

Louis Vuitton was represented by Theodore C. Max of Sheppard Mullin Richter & Hampton LLP in New York and by Robert E. Shapiro, Wendi E. Sloane, and Vito S. Solitro of Barack Ferrazzano Kirschbaum & Nagelberg LLP in Chicago. Warner Bros. is represented by Andrew H. Bart, Gianni P. Servodidio, and David Z. Moskowitz of Jenner & Block in New York.

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What to look for when vetting news and information, from confidential sources and filming law enforcement to privacy issues in the Facebook age.

Self-Described Journalist's Shield Law Claim Rejected

Defendant Lacked Credibility to Assert Protection

The question of who should

By Kathleen A. Hirce

In proceedings on remand from the New Jersey Supreme Court, self-described journalist Shellee Hale's deposition was ordered last month by a State trial court, over Hale's objections pursuant to the New Jersey Shield Law, N.J.S.A. 2A:84A-21. Too Much Media, LLC v. Hale, No. MON-L-2736-08 (May 24, 2012).

Hale, who is being sued for defamation and false light based upon a series of comments she allegedly posted on the message board of website www.oprano.com, had previously sought the protection of the Shield Law, claiming that her postings were part of her investigation and reporting of the

online adult entertainment industry. Too Much Media, LLC v. Hale, No. A-7 (June 7, 2011).

The New Jersey Supreme Court had disagreed, and held that the message board on oprano.com was not similar to the type of news entity protected by the Shield Law. On remand, Hale again argued that the Shield applied to her, based in part upon her work both on "Pornafia," a website she created and trademarked, and on a nonfiction book she was researching, also to be called "Pornafia." The trial court

rejected Hale's arguments regarding the "Pornafia" website, and though it allowed a hearing on Hale's claim regarding the nonfiction book, which had never been raised previously, it found Hale's credibility was lacking. She was ordered to appear for a deposition.

Background

As set forth in the New Jersey Supreme Court opinion, Hale's work investigating the online adult entertainment industry began while she was working as a life coach, when she encountered "cyber flashers" during the course of her online interactions with clients. Hale complained, to no avail. She decided to create "Pornafia," a website that, she claimed, would work as an "information exchange" and would provide resources and news to the public regarding the online adult entertainment industry. The site was not fully launched, however, and Hale conceded that it was "still being worked on, and was not live."

The defamation claims against Hale stem from postings she made on oprano.com following her investigation on reports of a security breach by Too Much Media, a company that manufactures software used by adult entertainment websites in order to track both access to related websites and

> commissions earned by referring sites. The security breach caused potential exposure of the personally identifying information of thousands who had signed up for adult websites. Hale claimed that she investigated the breach and talked with confidential sources, then posted The postings allegedly implied that Too Much Media had made money off the breach and had threatened those who questioned it. Too Much Media and its owners sued and

protective order, invoking the New Jersey Shield Law.

Following an extensive trial court hearing regarding whether or not Hale qualified as a journalist for Shield purposes, the case made its way to the New Jersey Supreme Court, where an Appellate Division decision denying Hale the protection of the Shield Law was affirmed and modified. The Supreme Court held that Hale's postings on the oprano.com message board were not protected by the Shield Law.

qualify as a journalist for Shield Law purposes is a charged one, and the court's emphasis on the Model Jury Charge for credibility and its oprano.com's message board. analysis of Hale's claims in this case will be informative for those representing nontraditional media members. sought to depose Hale. Hale sought a

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"[E]ven under the most liberal interpretation of the statute, defendant's use of a message board to post her comments is not covered under the Shield Law. We do not believe that the Legislature intended to provide everyone who posts a comment on Oprano or a response to an article on NJ.com an absolute reporter's privilege under the Shield Law. We cannot find support for that proposition in the words of the statute or any other statement of the Legislature's intent."

Proceedings on Remand

Hale's arguments to the trial court upon remand were essentially that the Supreme Court's decision had

"established new standards governing the application of the Shield Law to Internet activities," so Hale must be allowed to show that the work she did on her "Pornafia" site met those new standards. Hale also argued, for the first time, that when she posted the statements on oprano.com she had also been at work on a nonfiction book about the pornography industry. The sources for her oprano.com posts were the same as for the nonfiction book, the argument went, so they must be protected under the Shield.

The court rejected Hale's arguments regarding "Pornafia," finding that Hale had already had plenty of opportunity to raise and argue that her work on "Pornafia" qualified her as a journalist for Shield purposes. "Pornafia" had been examined in the initial trial court hearing, and addressed by both the Appellate Division and Supreme Court. All three courts had confirmed that Hale was "not entitled to assert the protections of the Shield Law as a result of her activities with the Oprano or Pornafia sites[.]"

The trial court did, however, allow Hale to present evidence regarding her new claims about a nonfiction book. A hearing was held over two days, and the court ultimately viewed the evidence through the framework of the Model Jury Charge on credibility. The court found, in short, that Hale's credibility about the nonfiction book was lacking.

Primarily, the court found it problematic that Hale had never mentioned the existence of a nonfiction book project at any point in the initial hearing or appeal process and that she failed, at the remand hearing, to explain why she had never brought it up. "Even more troubling," according to the court, was the fact that Hale also failed to address that she had actually claimed during the initial hearing that she was writing a *fictional* story regarding the mafia and pornography. Hale had also failed to raise the nonfiction book in the certification she initially submitted to the trial court, in support of her first set of arguments under the Shield Law.

Indeed, the court found that this certification was questionable in several other respects as well. Among them, contrary to Hale's initial hearing testimony (as set forth in the *Background* section above and described in the factual

explanation provided in the Supreme Court opinion) that she started "Pornafia" and her investigation of the online adult entertainment industry because she was being "cyber-flashed" while interfacing with clients for her life coaching business, Hale's initial moving certification apparently indicted that she became involved in this work "because, as a wife and mother, she heard parents complaining about unsolicited advertisements, referred to as pop-ups and spam, which they were

A hearing was held over two days, and the court ultimately viewed the evidence through the framework of the Model Jury Charge on credibility. The court found, in short, that Hale's credibility about the nonfiction book was lacking.

receiving."

Hale's failure to address or explain this discrepancy at the remand hearing negatively impacted on her credibility as well. The court also found Hale's witnesses—a woman who testified that she worked on promotions for the nonfiction book on the "Pornafia" site and a man who testified that he was a publisher and had spoken with Hale about a book, though he didn't specify whether it was fiction or nonfiction—were not credible.

As there was no further outstanding basis for Hale to argue for Shield protection, and as her claims regarding a nonfiction book were not credible, the court denied Hale Shield protection and ordered that she appear for a deposition.

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Conclusion

The question of who should qualify as a journalist for Shield Law purposes is a charged one, and the court's emphasis on the Model Jury Charge for credibility and its analysis of Hale's claims in this case will be informative for those representing non-traditional media members. Indeed, the importance to the court of the substance of the moving certification regarding journalistic qualifications could apparently not have been understated in this matter.

In its *Too Much Media* decision, the New Jersey Supreme Court noted that while a "straightforward certification" could suffice to show that a traditional newsperson is a journalist for Shield Law purposes, a "more probing hearing would likely be needed" for a "self-appointed journalist[]" who has "little track record[.]" However, the Court warned: "[h] earings should not devolve into extensive questioning about an author's editorial, writing, or thought processes. Likewise, they should avoid exposing the privileged materials the Shield Law is designed to protect."

The remand hearing in this case was not ordered by the Supreme Court, and only occurred because of Hale's new claims regarding the nonfiction book. Thus, the focus was on Hale's credibility as a self-identified nonfiction writer, and not on the substance of the book. Had Hale been credible, however, and the matter progressed, the court noted that questions would have been raised regarding the book in its research and draft stage.

If the instructions of the Supreme Court are not followed, the extent of a hearing on such questions could veer dangerously close to areas regarding reporting methods and sources. In this case, however, it was "unnecessary to resolve whether Hale's purportedly nonfiction book was sufficiently developed to meet the standards [of the Shield Law] because Hale's contention that she was writing a nonfiction book is not credible and cannot be accepted."

Kathleen A. Hirce is an associate at McCusker, Anselmi, Rosen & Carvelli, P.C. in Florham Park, NJ. Plaintiffs are represented by Joel N. Kreizman, Evans, Osborne and Kreizman, Ocean Township, NJ. Defendant is represented by Jeffrey M. Pollock, Fox Rothschild LLP, Princeton, NJ.



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D.C. Circuit Reinstates Privacy Act Claim Against DOJ Over Leak to Newspaper

Decision May Renew Confidential Source Clash

The D.C. Circuit Court of Appeals this month reinstated the Privacy Act claim of a former federal prosecutor against the Department of Justice over the alleged wrongful leak of information about him to the *Detroit Free Press*. <u>Convertino v. U.S. Dept. of Justice</u>, No. 11-5133 (D.C. Cir. June 22, 2012) (Henderson, Rogers, Tatel, JJ.).

According to the decision, the district court should not have granted summary judgment to the government, but should have stayed the motion pending further confidential source litigation in the Sixth Circuit and Eastern District of Michigan. The decision appears likely to set off another round of contentious litigation to force *Detroit Free Press* reporter David Ashenfelter or other newspaper staff to reveal a confidential DOJ source.

Background

The plaintiff brought one of the first post 9/11 terrorism cases, winning a conviction of four Michigan men charged with belonging to an Al Qaeda sleeper cell. The convictions, though, quickly fell apart. Convertino was removed from the case for ethical violations and was referred to the DOJ's Office of Professional Responsibility for an internal investigation to determine whether he withheld evidence from the defense.

On January 17, 2004 the *Detroit Free Press* published a front page article on the DOJ investigation by reporter David Ashenfelter entitled *Terror Case Prosecutor is Probed on Conduct*. Information about the investigation of Convertino was sourced to a confidential source in the DOJ.

On February 14, 2004, Convertino sued the DOJ in D.C. federal district court for willfully or intentionally disclosing "confidential Privacy Act-protected information" to Aschenfelter. After several years of discovery litigation in Michigan involving the *Detroit Free Press*, in 2010 a federal district court there upheld the reporter's right to protect his confidential source under the Fifth Amendment. The reporter invoked the Fifth Amendment privilege against self-incrimination in response to Convertino's allegations that Ashenfelter was a "criminal" who conspired with the DOJ to defame him. Notably, the district court had earlier rejected any First Amendment privilege to protect the identity of the source.

Last year, D.C. District Court Judge Royce Lamberth granted summary judgment to the government. *See* 769 F. Supp. 2d 139, 156 (D.D.C. 2011) ("Convertino has spent nearly a decade in his unsuccessful attempts to identify Ashenfelter's sources, and there is simply no reason to believe that yet another delay in this case will result in discovery of that information.")

D.C. Circuit Decision

Notwithstanding the years of litigation, the Court of Appeals held that the district court should have granted Convertino's request to stay the summary judgment motion pending further discovery in Michigan. The Court disagreed with the DOJ that further discovery would be a waste of time. Instead, the Court found it "reasonably likely" that a *Free Press* editor was privy to the identity of the source based on Convertino's assertion to the Court that the newspaper's policy was to publish anonymously-sourced articles only with approval of an editor. Moreover, while Ashenfelter could invoke the Fifth Amendment privilege against self-incrimination, "the Free Press — as a corporation — enjoys no Fifth Amendment privilege."

Stephen M. Kohn argued the cause for the Convertino. U.S. Attorney Samantha L. Chaifetz, argued the case for the Department of Justice. Herschel P. Fink, Honigman Miller Schwartz and Cohn LLP, Detroit, represented reporter David Ashenfelter in the discovery litigation in Michigan.

Minnesota Federal District Court Reaffirms Strong Reporter's Privilege Under the First Amendment

The Minnesota federal

district court has

reaffirmed a strong qualified

reporter's privilege under

the First Amendment.

By Holly Miller

The Minnesota federal district court has reaffirmed a strong qualified reporter's privilege under the First Amendment. The court granted a Motion to Quash Subpoena on Star Tribune reporter David Chanen. *Keefe v. City of Minneapolis*, No. 09-02941-DSD-SER (D. Minn. May 25, 2012).

The order granting the motion marked the first time since the 1990s that a federal court in Minnesota has applied the reporter's privilege and provided a detailed explanation for the decision. *See J.J.C. v. Fridell*, 165 F.R.D. 513 (D. Minn. 1995). Although the existence of a reporter's privilege under the First Amendment remains an open question in the Eighth Circuit, several district courts in other states have recognized and applied the privilege.

Background

Plaintiff, Michael Patrick Keefe, is a Minneapolis police sergeant who formerly held the rank of Lieutenant and who served as the commander of the Minneapolis

Police Department (MPD)/FBI Violent Offenders Task Force.

Chanen wrote an article in January 2008 about a letter from the Minneapolis City Attorney's Office that accused Keefe of professional misconduct. A second Star Tribune article published in May 2009 described an internal investigation that resulted in Keefe's suspension and relied on confidential sources whose identities were not revealed. On the day the second article ran, Keefe was relieved from duty.

Shortly after, Keefe filed sued the City of Minneapolis and three John Does in state court, alleging that unnamed city employees communicated confidential information about Keefe to the Star Tribune and other local news organizations. That suit presented three causes of action: (1) violation of the Minnesota Data Practices Act, (2) breach of common law right of privacy, and (3) defamation.

During discovery in the state proceeding, Keefe deposed five MPD officers about their communication with Chanen and other members of the media. On May 3, 2010, the lawsuit settled. Meanwhile, in October 2009, Keefe had filed a separate state-court action against the City of Minneapolis, its Police Chief, and other officers.

In the second action, which the City Defendants removed to federal court, Keefe alleged that the Defendants had engaged in a tacit agreement and conspiracy resulting in adverse employment actions and harassment in violation of his statutory, civil, and constitutional rights, including reprisal, common law and statutory whistleblower claims, invasion of privacy, and intentional infliction of emotional distress.

Keefe alleged that, as part of this conspiracy, MPD officers had "leaked" information to Chanen for articles.

Keefe served a subpoena *duces tecum* and deposition notice on Chanen in January 2012 that instructed Chanen to arrive with all relevant notes, email correspondence, and documents exchanged between him and the sources for his stories. Keefe sought to depose Chanen in an attempt to learn the identities of his sources and the

nature of their statements for the January 2008 and May 2009 Star Tribune articles.

Motion to Quash Subpoena

Star Tribune and Chanen filed a motion to quash arguing that Chanen should not have to be deposed because it would require the disclosure of privileged information protected by the First Amendment, federal common law, and the Minnesota Free Flow of Information Act and would subject Chanen to undue burden.

Plaintiff argued that the Minnesota state shield law did not apply in federal court and that *Branzburg v. Hayes*, 408 U.S. 665 (1972), should not be interpreted as categorically establishing a reporter's privilege because it remains an open question in the Eighth Circuit. Plaintiff argued that even if the

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Court recognized a reporter's privilege, his interests overrode any First Amendment interest.

Both parties addressed the potential applicability of Minnesota's state shield law, Minn. Stat. §595.023. Star Tribune argued that under Federal Rule of Evidence 501, state laws of privilege apply directly to "an element of a claim or defense as to which State law supplies the rule of decision." Plaintiff countered that the Minnesota statute was inapplicable in this case, due to the presence of federal statutory claims.

The Order of Magistrate Judge Steven Rau did not address the state shield law or the Star Tribune's arguments under the common law and instead granted the Star Tribune's motion based solely on the ground that Keefe could not overcome the qualified privilege established by *Branzburg*. The order acknowledged that the existence of a qualified reporter's privilege is an open question in the Eighth Circuit, but noted that several other district courts (in addition to the District of Minnesota in *Fridell*) have recognized one. That, together with the weight of authority of other circuits, the court said, was enough to establish that a privilege applied.

The court then applied the three-prong balancing test established in *Fridell*. Under the test, a requesting party may overcome the privilege if he can demonstrate that the information sought is: (1) critical to the maintenance or heart of the claim; (2) highly material and relevant; and (3) unobtainable from other sources. All three factors must be met to overcome the reporter's privilege.

In its analysis, the court determined that Keefe had not met any of the three requirements of the test and therefore the privilege applied and Chanen could not be deposed. First, the court found that the information was not "critical to the maintenance or heart of the claim" because it related only to two isolated instances of alleged retaliation within a two-year span that Keefe alleged were "part of a wider pattern of retaliation and reprisal." Next, the court said the information was not "highly material and relevant" to Keefe's claims because he relied on a series of inferences to argue that Chanen's sources were relevant. Magistrate Judge Rau noted: "While this string of conjectures exists in the universe of imaginable outcomes, it is too much for the Court to rely on Keefe's hypothesis to compel Chanen's deposition. ... Keefe's interest in 'verifying' information that goes only to credibility issues which are not essential to Keefe's case-inchief does not lend any support to overcoming Chanen's interest in protecting his confidential sources. ... [T]he disclosures here go only to a facet of the case and, at most, would result in cumulative evidence undermining the credibility of the officers." Finally, the court found that the information sought could be obtained from other sources.

The briefs for this case are available through the Media Law Resource Center's BriefBank.

Holly Miller is a summer associate at Faegre Baker Daniels, LLP in Minneapolis. John Borger and Leita Walker, Faegre Baker Daniels, LLP, Minneapolis, represented Star Tribune and Chanen. Plaintiff was represented by Damon Ward, Ward Law Group and Albert Goins, Sr., Goins Law Offices, LTD. The City Defendants were represented by Susan Segal, Minneapolis City Attorney; James Moore, Assistant City Attorney; and Sara Lathrop, Assistant City Attorney.

MLRC/NAA/NAB Media Law Conference

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Spotlight on Boutique Session:

Dealing With Patent Trolls

A practical discussion of how to deal with patent trolls. What to do when you receive a license "offer letter" and strategies for responding; possible use of declaratory judgment actions and motions to transfer; substantive defenses that can result in an early resolution; how to find and use prior art and non-infringement defenses; aggressive strategies to make litigation unprofitable for patent trolls; and special strategies for use in multi-defendant cases.

5th Circuit Rejects Reporter's Motion to End Terror Trial Gag Order

Gag Order Not in Violation of the First Amendment

The Fifth Circuit this month rejected a reporter's motion to dissolve a gag order barring prosecutors and defense lawyers in a high profile terrorism case from speaking to the press. <u>U.S. v. Aldawsari</u>, No. 11-10683 (5th Cir. June 11, 2012) (Higginbotham, Garza, Clement, JJ.). Aldawsari was convicted on June 27.

Background

In Febrary 2011, Khalid Aldawsari, a former Texas Tech University chemical engineering student and Saudi national, was arrested and charged with

attempting to create explosives and plotting to commit a terrorist attack inside the U.S., including targeting former President George W. Bush.

In March 2011, Federal District Court Judge Sam Cummings in Lubbock, Texas imposed a gag order barring both sides from speaking to the press about the case. Citing the

"extraordinary amount of media coverage" of the arrest, Judge Cummings found there was a "substantial likelihood that extrajudicial commentary could prejudice a fair trial." The order stated in relevant part that "the parties, their representatives, or their attorneys of record SHALL NOT communicate with the news media concerning this case."

In April 2011, Texas reporter James Clark filed a motion to intervene to challenge the gag order as over broad. The district court denied the motion, finding that the reporter did not have standing and, on the merits, that the gag order was narrowly tailored to protect defendant's fair trial right. The reporter filed a writ of mandamus and ultimately the Fifth Circuit agreed to hear the matter on interlocutory appeal.

Fifth Circuit Upholds Gag Order

Reviewing the district court order de novo, the Fifth Circuit panel first reviewed the issue of standing. The government argued that the reporter had no standing to challenge the gag order absent evidence that anyone bound by the order would be willing to speak to him about the case. The Fifth Circuit rejected this narrow approach to standing. The terrorism trial was "unquestionably newsworthy and of public interest" and the gag order affected the reporter's right to gather news and thus he had

standing to challenge it.

The Fifth Circuit, however, was less sanguine on the merits of the reporter's challenge, concluding the gag order was not over broad and did not violate the First Amendment. The Court noted that under the First Amendment a gag order on trial participants'

communications with the press "will be upheld only if the government can establish that the activity restrained poses either a clear and present danger or a serious and imminent threat to a protected competing interest." According to the Court, the reporter did not contest that defendant's fair trial right was threatened, but objected to the scope of the gag order. The Court upheld the constitutionality of the gag order, holding it was limited to participants "involved with the proceedings." Finally the Court rejected the reporter's argument that the gag order interfered with his right to pursue his profession. "[T]here is no constitutional right to pursue a profession in a manner that infringes on the constitutional rights of another citizen," the Court concluded.

Reporter James Clark acted pro se in this matter.

Execution Must Be Open to the Press

Media Coalition Successfully Challenged Idaho Restriction

By Charles Brown

On June 8, 2012, the Ninth Circuit Court reversed and remanded an Idaho District Court's denial of a media coalition's request for a preliminary injunction in regard to an execution which was scheduled for June 12, 2012. *The Associated Press, et al. v. Otter*, No. 12-35456, 2012 WL 2086362 (9th Cir. June 8, 2012) (Kozinski, Reinhardt, Berzon, JJ.).

The plaintiffs in the matter were a coalition of 16 news-related organizations spearheaded by *The Associated Press* and joined by various newspapers throughout the state of Idaho and *The Spokesman Review* out of Spokane, Washington, along with the Idaho Press Club, Inc. and Idahoans for Openness in Government, Inc.

Background

During the late afternoon hours of May 17, 2012, a death warrant was issued for the execution of Mr. Richard Leavitt. Mr. Leavitt was convicted in 1995 for a brutal stabbing and mutilation of a 31 year old woman.

The news organizations had their Complaint filed three business days later — May 22, 2012. The news organizations sought a preliminary injunction requiring ". . . all phases of the execution process,

beginning with the condemned inmate's procession into the execution chamber, the restraining of the condemned inmate on the execution table, the connection of medical monitoring devices, the insertion of catheters, and the attachment of IV lines, and all incidental treatment of the condemned inmate be conducted in full and open view of the assembled witnesses to that execution."

The initial 20 minutes as described above occurred behind a pulled curtain preventing all gathered witnesses from viewing the entire execution process. The news organizations relied upon *California First Amendment Coalition v. Woodford*, 299 F.3d (9th Cir. 2002), hereinafter referred to as CFAC (IV), which ruled that the witnesses had the First Amendment right to view the entire execution process.

The court had ruled that if there is going to be capital punishment then the execution process was an aspect of capital punishment and, thus, had to be viewed in its entirety in order to allow for open debate and discussion, and First Amendment rights attached to the rights to view the process in its entirety. In order to have a robust debate it is necessary to have an informed debate.

The State of Idaho argued that the facts of the CFAC (IV) case were distinguishable from the facts in the state of Idaho. They argued that the news organizations' Complaint was not timely filed in that it should have been filed prior to the scheduling of the execution so that a change in the State's protocol could have been made in a timely manner. They also argued that the statutory history in Idaho prevented the

public from viewing executions and that their penological concerns legitimized a closing of a portion of the execution process.

Prior to Mr. Leavitt's execution, the previous execution in Idaho was in November of 2011 of a Mr. Rhoades. Prior to Mr. Rhoades, the previous execution was 15 years earlier.

In response to the State's allegation of statutory closure, the news organizations produced references to books and newspaper articles showing that from 1899 forward, executions did take place within

the confines of the state penitentiary but were consistently attended by witnesses and representatives of the media and others. (Prior to 1899, executions took place on the county level and generally in the town square, which is what the statutory provisions were seeking to avoid.)

Two days after the filing of the Complaint, the Summonses were issued, and along with them, they and the Complaint were served, and the Honorable District Judge Lodge entered an order scheduling mandatory mediation for May 31, 2012, before Federal Magistrate Candy Dale which was unsuccessful. Judge Lodge also ordered a briefing schedule requiring final briefs to be submitted to him on June 4, 2012.

(Continued on page 35)

The news organizations were assuredly going to win on the merits and that the news organizations also showed that they would suffer irreparable harm because the holding in CFAC (IV) was that the First Amendment protects the right to witness executions in their entirety.

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Concurrent with the filing of the Complaint, the Ninth Circuit Court contacted the attorneys involved indicating they were following the case. Judge Lodge entered an order on June 5, 2012, denying the news organizations' request for a preliminary injunction. On June 5, 2012, the news organizations filed a notice of appeal in response to which the Ninth Circuit Court immediately entered an order setting forth a briefing schedule within 24 hours and oral argument on June 7, 2012, all of which took place less than two days after the entry of Judge Lodge's order.

Oral argument was held on June 7, 2012, in Pasadena, California, and the Ninth Circuit Court entered their opinion on June 8, 2012, reversing the lower court and granting the news organizations' motion for preliminary injunction and issuing a writ of mandate to that effect.

On June 11, 2012, Judge Lodge entered a court order honoring the opinion and ordering that the Leavitt execution go forward without the curtain being drawn. Mr. Leavitt was executed on June 12, 2012. In their request for a preliminary injunction, the news organizations had not requested a stay of the execution, only that the viewing process be changed to accommodate a full viewing.

Ninth Circuit Decision

The opinion issued by the Ninth Circuit is very forceful and declarative. Prior to the Rhoades execution in November 2011, the news organizations had approached the Idaho Department of Corrections and asked them to change the protocol to conform with CFAC (IV). The State of Idaho refused, but said they would review their protocol with the case in mind. At a later date, some members of the news organizations and Charles A. Brown met with representatives of the IDOC and, again, made the request and articulated their reasons. On February 1, 2012, the director of the IDOC issued a letter indicating that they were not going to change their protocol.

In regard to the timeliness of the news organizations' Complaint, the Ninth Circuit stated:

The State of Idaho has had ample opportunity for the past decade to adopt an execution procedure that reflects this settled law. It can hardly complain that it has been unaware of the binding precedent, since the

media coalition specifically cited *California First Amendment Coalition* in asking the State to alter its execution procedure prior to the November 2011 execution of Paul Rhoades.

See Associated Press v. Otter, 12-35456, 2012 WL 2086362 *1 (9th Cir. June 8, 2012)

The penological concerns expressed by the state of Idaho were to (1) preserve the prisoner's privacy and dignity, (2) respect sensitivities of the condemned prisoners family, (3) the same for his fellow death-row inmates, and (4) protect the anonymity of the members of the medical team who participate in the execution. The Ninth Circuit citing its own opinion from CFAC (IV), again reasserted that the relevant inquiry is ". . . whether a prison regulation that burdens fundamental rights is reasonably related to legitimate penological objectives, or whether it represents an exaggerated response to those concerns" (internal quotation marks omitted)). Associated Press v. Otter, 12-35456, 2012 WL 2086362 *2 (9th Cir. June 8, 2012).

In regard to the feelings of the condemned, the condemned's family, and others on death row, the Ninth Circuit stated:

The State of Idaho already offends the dignity of condemned inmates and the sensibilities of their families and fellow inmates by allowing strangers to watch as they are put to death. It strains credulity for the State to assert that these interests will be offended to a meaningfully greater degree when witnesses are permitted to watch the insertion of intravenous lines than when they are simply allowed to watch the inmates die.

See Associated Press v. Otter, 12-35456, 2012 WL 2086362 *2 (9th Cir. June 8, 2012)

In regard to the anonymity of the medical team, the Ninth Circuit simply found:

We considered this interest at length in *California First Amendment Coalition*, however, characterizing California's "fear that execution team members [would] be publicly

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identified and retaliated against" as "an overreaction, supported only by questionable speculation," 299 F.3d at 880

See Associated Press v. Otter, 12-35456, 2012 WL 2086362 *3 (9th Cir. June 8, 2012)

The Ninth Circuit found that the use of surgical medical garb is a practical alternative to restricting access to witnesses of lethal injections.

The June 12, 2012, Leavitt execution went forward as scheduled. No change was made to the written protocol, and the medical team simply wore surgical garb to hide their identity.

Thus, the Ninth Circuit ruled that the lower court abused its discretion by not granting the preliminary hearing, that the news organizations were assuredly going to win on the merits and that the news organizations also showed that they would suffer irreparable harm because the holding in CFAC (IV) was that the First Amendment protects the right to witness executions in their entirety.

To say that the plaintiffs will not suffer harm because they will be able to witness part of Leavitt's execution is like saying that the public would not suffer harm were it allowed to read only a portion of the *New York Times*.

Id.

The court then also stated that the denial of First Amendment rights for even minimal periods of time questionably constitutes irreparable injury. The Ninth Circuit then ruled that the State was to allow witnesses to observe:

. . . Leavitt's entire execution, "from the moment [he] enters the execution chamber through, to and including, the time [he] is declared dead." *California First Amendment Coalition*, 299 F.3d at 886 (internal quotation marks omitted).

See Associated Press v. Otter, 12-35456, 2012 WL 2086362 *4 (9th Cir. June 8, 2012)

Conclusion

There does not appear to be a great deal of developed case law concerning a full viewing of the execution process in the other Circuits. Due to the strength of the language in the Ninth Circuit's Opinion and the fact that it is confirming its 2002 CFAC (IV) Opinion. The ruling should be quite helpful to other media outlets seeking access to view the entire execution process in other Circuits throughout the country.

Charles A. Brown of Lewiston, Idaho, represented the news organizations in this case. The organizing of the media representatives was accomplished by Mr. Todd Dvorak and Ms. Rebecca Boone from the Boise, Idaho, department for The Associated Press.

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Spotlight on Boutique Session:

Current Issues in Ethics

Including the use of new technologies and communications media, recent developments in the rules regarding conflicts and issues arising from law firm websites, as well as changes in the ethics rules that are on the horizon.

Media Coalition Keeps Court Records Open in Trayvon Martin Shooting Prosecution

By Scott D. Ponce and Charles D. Tobin

In a Florida murder trial that has garnered international and national headlines, attorneys for a coalition of 17 news outlets have fought back efforts by both prosecutors and defense counsel to seal public court files.

George Zimmerman is charged with second degree murder in the February death of teenager Trayvon Martin, an unarmed African American teenager. neighborhood watch coordinator for his gated Sanford, Florida community, has pleaded not guilty and claims Martin attacked him. Martin's family has said that the young man was taking a short cut home after buying a package of Skittles and an iced tea at a nearby store.

In an unusual alliance, the state and defense jointly moved

the trial judge, Kenneth R. Lester, Jr. of Florida's Eighteenth Judicial Circuit, for a protective order sealing documents that had been provided to Zimmerman under the discovery provisions of Florida's Rules of Criminal Procedure. Florida's Public Records Law, discovery in a criminal proceeding becomes a public record once it is provided to the person arrested.

At Zimmerman's arrest in April, the defense requested, and the state agreed, that the court seal the entire file. The

judge agreed. A coalition of national and Florida media outlets quickly filed a motion to intervene, objecting the a blanket sealing and urging a document-by-document analysis with the party seeking closure bearing a heavy burden under the First Amendment and Florida law. At an April 27 hearing, Judge Lester agreed, ordering the opening of the file and further ordering that, once the state serves discovery on the defendant, the parties file motions tailored to any individual documents they sought to seal.

The state provided discovery and filed a motion to seal, as did the defense. Included among the information that they sought to seal were:

All statements Zimmerman gave to law enforcement;

- Results of tests performed by law enforcement on Zimmerman;
- Audio recordings of witness statements;
- Identifying information for 22 civilian witnesses; and
- Crime scene and autopsy photos.

At the conclusion of the June 1 hearing on this motion, the judge noted the unique nature of Florida's public records law in providing public access to criminal discovery materials. While he expressed his concerns, he told the parties that he would follow the law and review the documents in camera, applying the heavy burden for closure.

Judge Lester on June 12 followed up with a six-page

order that denied the closure motions in almost every respect. Order on the State's Motion for Protective Order and the Media Interveners' Motions to Intervene and to Oppose the Closure of Judicial Records, State v. Zimmerman, Case No. 12-CF-1083 -A (Fla. Cir. Ct. June 12, 2012).

The only information that the court sealed outright were photographs of the victim's body (which the media organizations said they had no interest in publishing) and the names of the twentytwo civilian witnesses, whom the court

described as people who performed their civic and moral duty to provide information to law enforcement.

The judge also expressed concern over the release of witness names. Throughout the June 12 order, he made observations that most court-access law "predates the rise of the blogosphere" and that "the world has changed." lamented the news coverage in this case that "have been routinely disseminated presenting opinion as fact" and that the numbers of calls from the media required the court to dedicate a public information officer. The judge wrote that "common sense" tells him the media will contact witnesses once their names are disclosed, and that "claims that these people will not be affected when their identities are exposed (Continued on page 38)

In a Florida murder trial that has garnered international and national headlines, attorneys for a coalition of 17 news outlets have fought back efforts by both prosecutors and defense counsel to seal public court files.

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(Continued from page 37) are misguided."

The court, expressing its goal of protecting the witnesses from unwanted public scrutiny while balancing the public's right to information, created a process for the release of witness names. The court ordered the media outlets to provide the state with the names of people it suspects are among the witnesses and who also have spoken to the media, together with the dates on which those people spoke to the media. If any of the people on that list are among the witnesses, then the state is required to release their full identities and to identify which statements those people gave.

The court ordered the full release of Zimmerman's statements to law enforcement, the results of the tests performed on Zimmerman, all photographs of the crime scene that do not depict Trayvon's body, Martin's cell phone records, emails to the Sanford Police Department, and the recordings of telephone calls Zimmerman received in jail.

Zimmerman's lawyers have filed a motion to reconsider portions of the ruling. That motion remains pending.

Scott D. Ponce, Sanford L. Bohrer and Charles D. Tobin, of Holland & Knight LLP, Miami, FL and Washington, D.C., represent Media Interveners The McClatchy Company, publisher of The Miami Herald and The Bradenton Herald; NBCUniversal Media LLC; Gannett Co., Inc., publisher of

USA TODAY, The News-Press, Pensacola News Journal, FLORIDA TODAY, The Tallahassee Democrat, and owner of First Coast News and WTSP-TV; New York Times Company, publisher of The New York Times; Times Publishing Company, publisher of The Tampa Bay Times; Associated Press; Dow Jones & Company, Inc., publisher of The Wall Street Journal; The E.W. Scripps Company, publisher of Naples Daily News, Stuart News, Ft. Pierce Tribune, and Vero Beach Press Journal, and owner of WPTV-TV and WFTS-TV; CBS News, a division of CBS Broadcasting Inc. and WFOR-TV, owned and operated by CBS Television Stations Inc.; The Hearst Corporation, owner of WESH-TV and WPBF-TV; Morris Publishing Group, LLC, d/b/a The Florida Times-Union; In Session, a division of truTV; The First Amendment Foundation; and Florida Press Association

Rachel E. Fugate, Thomas & LoCicero PL, Tampa, FL, represent Orlando Sentinel Communications Company, publisher of the Orlando Sentinel; Sun-Sentinel Company, publisher of the South Florida Sun-Sentinel; and WFTV, Inc., d/b/a WFT-TV

Mark M. O'Mara, Orlando, FL, and Donald R. West, Don West Law Group, Orlando, FL, represent Defendant George Zimmerman

Bernie de la Rionda and John Guy, Office of the State Attorney, Jacksonville, FL, represent the State of Florida.

MLRC UPCOMING EVENTS

MLRC/NAA/NAB 2012 Media Law Conference Sept. 12-14, 2012 | Reston, Virginia

MLRC Annual Dinner & MLRC Forum November 14, 2012 | New York, NY

DCS Annual Meeting & Lunch November 15, 2012 | New York, NY

Ethics Corner: Proposed Changes in the Ethics Rules

A Few High-Tech Highlights

By Len Niehoff

Earlier this year, the American Bar Association Commission on Ethics 20/20 submitted to the House of Delegates a number of proposals for consideration at its August, 2012 annual meeting in Chicago. Those proposals resulted from a three-year study of how technology and globalization are transforming the practice of law and how the ethics rules should be updated in light of those developments. The Commission plans to submit additional recommendations later this year for the House of Delegates to consider in February of 2013.

The Commission identified two trends that have shaped

its proposals to date. First, technology now affects almost every aspect of the practice of law, including how attorneys handle confidences, store information, communicate with clients and potential clients, conduct discovery, engage in research, and portray themselves and their services to the public.

Second, clients increasingly require their lawyers to handle matters that extend

well beyond the geographical boundaries of their licenses. As a result, attorneys now regularly face questions about the permissible boundaries of multi-jurisdictional practice, their competency to offer cross-jurisdictional counsel, and their professional mobility. The Commission sought to accommodate these realities while continuing to hold lawyers to appropriate ethical standards.

A full set of the Commission's resolutions and reports can be found <u>here</u>.

Many of the proposed revisions to the rules are relatively minor and technical. Others, however, offer useful clarifications, raise interesting issues, or appear to work at least some substantive change in the standards for ethical conduct. This column will discuss just a few of the most intriguing of the proposals that attempt to address technological change.

Competence

The Commission has suggested that Comment [6] to RPC 1.1 be revised to state that "a lawyer should keep abreast of changes in the law and its practice, *including the benefits and risks associated with relevant technology* (new language italicized)." The Commission maintains that this language imposes no new obligations on lawyers because Comment [6] to MRPC 1.1 already encompasses a duty to remain aware of changes in technology that affect law practice. In the Commission's view, the proposed revision thus serves only to emphasize that competent representation includes some level

of technological competency.

It remains difficult, however, to discern with any precision what Rule 1.1 actually requires. And neither the proposed change nor the accompanying report offers any additional insight on this front. To the contrary, the Commission's report just summarily indicates that a competent lawyer needs "some awareness of the basic features of technology" and a "basic

understanding of the benefits and risks of relevant technology."

But what does this mean? On one hand, this may seem to set the bar pretty low; after all, demanding "some awareness" of "basics" does not appear to ask much. On the other hand, it seems uniquely true of technological matters that one person's "basic" is another person's "advanced and incomprehensible." A critic might conclude from this exercise that the Commission missed an opportunity to provide some useful guidance about what Rule 1.1 actually intends and expects with regard to technological competency.

The problem with this criticism, of course, is that the MRPC revision process cannot possibly keep up with the pace of technological change. Specific guidelines would become obsolete before they reached the end of the formal adoption process. In recognition of this reality, the

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Commission has proposed that the ABA Center for Professional Responsibility create a centralized, user-friendly, easily understood, continuously updated, and highly detailed website that contains information about "the latest data security standards," the "key issues that lawyers should consider when using technology in their practices," and "the administrative, technical, and physical safeguards that should be employed." Such a website could therefore answer the question that Rule 1.6 itself does not. What does a lawyer need to know to be technologically competent? The information offered here.

Confidentiality

The Commission has also proposed that MRPC 1.6 be revised to state explicitly that a lawyer must "make reasonable efforts to prevent the inadvertent or unauthorized disclosure of, or unauthorized access to, information relating to the representation of a client." As the report observes, this language does not really add anything new to the rules. Instead, it underscores a concern that is elevated by the use of current technologies.

The more significant proposed change may be the addition in the Comment of a list of "[f]actors to be considered in determining the reasonableness of the lawyer's efforts" in this regard. These include, but are not limited to, "the sensitivity of the information, the likelihood of disclosure if additional safeguards are not employed, the cost of employing additional safeguards, the difficulty in implementing the safeguards, and the extent to which the safeguards adversely affect the lawyer's ability to represent clients."

This seems like a useful and practical inventory of considerations. Indeed, it is so pragmatic that it might strike a critical reader as inconsistent with the rule's expansive and idealistic declaration that all "information" that "relat[es]" in any way "to the representation of the client" must be treated as sacrosanct—a declaration that I have elsewhere criticized as not just impractical but nonsensical and unenforceable. See Leonard M. Niehoff, In the Shadow of the Shrine: Regulation and Aspiration in the ABA Model Rules of Professional Conduct, 54 Wayne L. Rev. 3 (2008).

The Disciplinary Rules created a hierarchy of information that the lawyer secures about the representation,

distinguishing between confidences and secrets and carefully defining both (*see* DR 4-101(A)). The proposed revision to the Comment to MRPC 1.6 seems to adopt a hierarchical approach as well, recognizing that some information is more sensitive than other information. The problem, alas, is that the broad language of the Model Rule leaves no room for this irresistibly sensible idea to play a role in our analysis.

In any event, the website proposed by the Commission would play a significant clarifying role with respect to this rule as well. Attorneys who have concerns about whether their use of a particular technology complies with MRPC 1.6 could consult the website for guidance. And, of course, the Commission recognized that some clients may demand that their lawyers implement measures beyond those required by the rules or may give informed consent to the use of more relaxed (and less expensive) procedures.

Inadvertently Disclosed Information

MRPC 4.4 requires a lawyer who receives a document that he or she knows (or reasonably should know) was inadvertently disclosed must promptly identify the sender. The Commission has proposed revising the rule so that it explicitly embraces "electronically stored information" that the sender inadvertently discloses. This is a helpful clarification, even if an interpretation of the word "document" that was made consistent with the spirit of the rule would have achieved the same result.

Again, the more interesting proposed revisions concern the Comment. First, the Commission suggests including language that explains what "inadvertently sent" means in this context: "A document or electronically stored information is inadvertently sent when it is accidentally transmitted, such as when an email or letter is misaddressed or a document or electronically stored information is accidentally included with information that was intentionally transmitted." Second, the Commission has proposed defining "electronically stored information" so that it includes "embedded data (commonly referred to as 'metadata')."

The second proposal raises some interesting issues. Having defined "electronically stored information" to encompass "metadata," the new Comment would also specifically state that "Metadata in electronic documents creates an obligation under this Rule *only if* the receiving

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lawyer knows or reasonably should know that the metadata was inadvertently sent to the receiving lawyer." (emphasis supplied)

In other words, the new rule would hold that a party who produced electronically stored information is presumed to have *intended* to disclose the metadata embedded in those documents—even if extracting the metadata requires efforts that would have led most people to conclude that, as a practical matter, it wasn't being provided. This prompts questions about the sorts of evidence that would suffice to rebut the presumption that the Comment would create, short of an express declaration that there was no intention to turn over metadata as part of the production.

Conclusion

The ABA Commission on Ethics 20/20 has made a serious and thoughtful effort to address some of the knottier problems that new technologies have brought to the practice of law. Its proposal to solve some of those technological challenges through technology itself—i.e., the proposed website—seems like an inspired idea. These proposals will benefit, however, from the criticism, analysis, and discussion that the following months will bring.

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MLRC UPCOMING EVENTS

MLRC/NAA/NAB 2012 Media Law Conference Sept. 12-14, 2012 | Reston, Virginia

MLRC Annual Dinner & MLRC Forum November 14, 2012 | New York, NY

Defense Counsel Section
Annual Meeting and Lunch
November 15, 2012 | New York, NY

MLRC/Southwestern

Media & Entertainment Law Conference

January 17, 2013 | Los Angeles, CA