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**MEDIA LAW LETTER**

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Reporting Developments Through October 25, 2014

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# Dutch Court Rejects Right to Be Forgotten

## *More Freedom of Speech for Search Engines, Less Right to Be Forgotten For Criminals*

By **Joran Spauwen and Jens van den Brink**

This month, the Court of Amsterdam in preliminary relief proceedings got a chance to shed light on the consequences of the European Court of Justice's much-discussed right to be forgotten decision. Case No. [C/13/569654 / KG ZA 14-960](#) (Sept. 19, 2014). As far as we are aware, this is the first national court in the EU to interpret and apply the [Google Spain](#) ruling.

### Background

The proceedings in Amsterdam centred on one of the many “right to be forgotten” requests Google received after the *Google Spain* judgment. This request was made by the owner of an escort agency who was sentenced to six years in prison in 2012 for “attempted incitement of contract killing,” which is still under appeal. He had been caught on camera by Peter R. de Vries – a well-known Dutch crime journalist, who got international attention for his coverage of the Nathalie Holloway case.

This year the man wanted to have links removed to online publications linking him to the crime he had committed. Although Google was willing to remove part of the search results he complained about, the search engine refused to comply fully with his request. The complainant decided to bring suit in order to have other search results removed as well.

While the Court of Justice of the European Union (“CJEU”) seemed to suffer from a slight case of privacy tunnel vision, the Court of Amsterdam displayed a more practical approach and arguably paid more attention to the freedom of speech issues concerned with these kinds of requests. The Court rejected the claims of the owner of the escort agency.

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### Dutch Court's Analysis of RTBF

The interesting thing about the judgment is how the Amsterdam court reached this conclusion. The Dutch Court briefly summarized the test provided by the CJEU, giving it a personal twist:

“The [Google Spain] judgment does not intend to protect individuals against all negative communications on the Internet, but only against ‘being pursued’ for a long time by ‘irrelevant’, ‘excessive’ or ‘unnecessarily defamatory’ expressions.”

The elements ‘being pursued for a long time’ and ‘unnecessarily defamatory’ are not quotes from *Google Spain*. Apparently the Dutch Court read those elements into the CJEU decision. This, however, provides a more

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balanced view than that of the CJEU because it does not imply that privacy outweighs free speech and the freedom of information (which the CJEU suggested in the *Google Spain* decision).

The Dutch court added that it will be hard for a person convicted of a serious crime to meet these criteria:

“The conviction for a serious crime such as the one at issue and the negative publicity as a consequence thereof, in general provide information about an individual that will remain relevant. The negative qualifications that may be involved will only be ‘excessive’ or ‘unnecessarily defamatory’ in very exceptional cases, for instance when the offense committed is brought up again without a clear reason, apparently for no other purpose than to damage the individual involved, if reporting is not factual but rather a ‘slanging-match’.”

It was clear to the Court of Amsterdam that the request of the complainant did not meet these criteria.

### **Full Last Name and Auto-Complete Function**

The Dutch Court also confirmed that it is common practice in Dutch journalism to anonymize convicted persons by only mentioning the first letter of their last name. Nevertheless, the Court underlined that this does not mean that an enforceable standard exists:

“Furthermore, the claimant apparently assumes that there is an enforceable standard which obliges journalists – including, according to the claimant, search engines like Google Search – under all circumstances to anonymize a suspect or a convict of a criminal offense. However, such an enforceable standard does not exist.”

Therefore, the fact that some Google search results contain the full name of the claimant, while the media abbreviated his last name, did not persuade the Court to have these links removed for this reason alone.

The Court further doesn’t consider it illogical or unlawful that the auto-complete function of Google suggests journalist ‘peter r de vries’ as soon as the name of the claimant is typed in. Google automatically makes these suggestions on the basis of earlier search requests. Apparently, Google users still search for the claimant’s name in combination with Peter R. de Vries relatively often. Furthermore, the Court does not share the opinion that through the auto-complete function internet users would be able to find out the full name of the claimant.

### **Communication of Removed Results**

As mentioned above, Google did remove a number of search results following complainant’s request. In this regard, claimant also objected to the following notice, which Google displays when you search for his name: “*Some results may have been removed on the basis of European data protection legislation. More information.*” Google contended that since June 2014 it includes this notification in all search requests for a personal name, unless “*it is the name of a well-known person.*”

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We were not aware of this policy and we wonder how it is applied exactly. When searching for our own name on Google (of course purely for editorial purposes), even our name appeared to be sufficiently famous to show this notification. The question is if we should feel flattered or whether Google does not apply very strict requirements as to what constitutes “well-known” (or it doesn’t strictly uphold its own policy).

The Court rejected the objections because Google’s notification does not create incorrect suggestions.

### Sufficient Urgency

The Court also questioned if the claimant had sufficient urgency to bring his suit in preliminary relief proceedings. He alleged that Google’s search results hindered him in his business life, as well as his private life. According to the Court, this was not sufficiently substantiated. The Court observed in this regard that people in the claimant’s immediate circle would already be aware of his criminal past:

“It can provisionally be assumed that relatives, friends and acquaintances of the claimant know what fact(s) the claimant is suspected of and for which fact(s) he was convicted by this court. After all, in the program “Misdaadverslaggever” of Peter R. de Vries of 27 May 2012 the claimant was shown on television in great detail. In this program, footage that had been surreptitiously recorded was shown in which the claimant, mentioned by his first name and the first letter of his last name, discussed with an alleged contract killer the best way of liquidating or having liquidated a competitor of the claimant in the escort sector. In this footage the claimant was shown extensively and recognizably, and no image or sound distortion was used. Subsequently, the claimant was in prison for quite a while. Under these circumstances it cannot be understood, without further explanation of the claimant – which was not given – that the claimant, who has now been released to await his appeal, is seriously hindered in his private life as a result of the actions of Google Inc.”

### Conclusion

All in all, this ruling is good news, because it provides a more workable interpretation of the *Google Spain* judgment and the *right to be forgotten* under Dutch law, justifiably leaving a lot more room for the freedom of speech. However, the question is whether this case will actually have an impact. What would the outcome be in a case which doesn’t concern a crime of the seriousness at play here?

In this respect, we leave you with a small reprimand of the Court ([which ties in nicely with the Springer judgment of the ECtHR](#)):

“The claimant now has to bear the consequences of his own actions. One of the consequences of committing a crime is that a person can be in the news in a very negative way and this will also leave its tracks on the Internet, maybe even for a very long time.”

*Joran Spauwen and Jens van den Brink are lawyers with Kennedy Van der Laan in Amsterdam.*

# Google Spain: A Judgment Which Deserves To Be Forgotten

## *Right to Be Forgotten Judgment Not Working in Practice*

By Anya Proops

There is no question but that in our modern networked age, the internet has become central to the shaping of our personal identities and biographies. Nowadays if you want to build a picture of a particular individual, you will invariably start with what is said about them online. What is said may range from the very serious to the entirely trivial. It may relate to recent events or events which, but for the internet, would almost certainly have been lost in the mists of time.

As for the control which the individual exerts over their online persona, this has historically been very limited. An individual may have been able to go to the owners of a particular source web-page and require the offending content to be taken down, for example because it was defamatory. However, they were otherwise forced to live with whatever e-portrait of themselves was painted through the application of the internet search engine's complex indexing algorithms. In practical terms, this meant that the public right's to know was king within the online environment.

However, all this has now changed following the judgment of the Court of Justice of the European Union in [Google Spain v González](#) (Case C-131/12). Now it is the public's right to know which must routinely bend its knee to the right of the individual to protect their privacy in the online world. But is this brave new approach to the management of data online normatively and practically tenable? Experience and reason would suggest that it is not. Indeed, there are good grounds for supposing that, in the name of protecting individual privacy, the Court has forced a fundamental change to the architecture of the information society which is as precarious as it is unprincipled.

Before looking at the difficulties with the judgment, one has first to understand precisely what conclusions the Court arrived at in the case. These can be summarised as follows.

First, Google (and indeed all other search engines), despite ostensibly being a conduit for data rather than a data creator per se, can properly be characterised a 'data controller' for the purposes of the EU Data Protection Directive. What this means is that Google owes the individuals identified in the various web-pages which it indexes a range of legal duties, including a duty to process their data fairly and a duty to ensure that their data is not processed for longer than is necessary.

Second, in terms of protecting the privacy rights of data-subjects, the general rule is that the individual's right to be forgotten trumps the public's right to know. Thus, in general, where a person objects on privacy grounds to Google indexing a particular source web-page, Google must de-index that page, with the intended result that the web-page is effectively consigned to e-oblivion. Importantly, this principle applies not only to data which is unlawfully present on the web but also to information which is lawfully present on the internet and, moreover, information which is true.

Third, the general rule will only be disapplied where there is a stronger counter-veiling interest in the public being able to access the web-page using the Google search function.

There are a number of fundamental difficulties with this judgment. First, looked at from a normative perspective, the judgment plainly gives privacy rights pride of place in the analysis. To the extent that freedom of expression (which incorporates the right to receive information) is mentioned at all, it appears very much as an after-thought. There is scant reference to the right to freedom of expression afforded under Article 10 of the European Convention and the Court does not even trouble itself to refer to the right to freedom of expression provided for under Article 11 of the EU's own Charter of Fundamental Rights.

**Google owes the individuals identified in the various web-pages which it indexes a range of legal duties, including a duty to process their data fairly and a duty to ensure that their data is not processed for longer than is necessary.**

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Perhaps more importantly, the Court entirely fails to recognise that, when it comes to a competition between privacy rights and the right to freedom of expression, there is no right which can be treated as generally pre-eminent. Certainly, from the perspective of Convention jurisprudence, the suggestion that the right to freedom of expression must generally play second fiddle to the privacy Stradivarius is complete heresy. Of course, protection of the privacy of the individual is fundamental to the well-ordered democratic society. However, so too is it fundamentally important that the public is able to use the immense power of the internet to inform and educate itself. If there is to be a systematic shift in the weight to be afforded to these two fundamental rights then surely that is a shift which should result from a democratic mandate, rather than being the product of mere judicial fiat.

Second, looked at from a practical perspective, the judgment simply does not work. So far as protecting privacy rights is concerned, the lessons we have learned to date is that in practice exercising your right to be forgotten is likely to be largely ineffective. This is because, even if relevant web-pages are de-indexed on Google's European browsers (e.g. google.co.uk), they are still available for all to see on google.com. Still worse, the net effect of exercising your right to privacy may be that you only increase your notoriety. Thus, as we have seen in various cases, a request to Google to de-index a particular newspaper article may itself result in the newspaper simply republishing the page so as to give it new currency.

What this means is that a request to be forgotten can readily end up having something of a Spycatcher effect: if you seek to injunct indexation, rather than consigning your data to e-oblivion, you simply increase its profile.

Perhaps even more importantly, it is illogical to suppose that a commercial search engine could ever be the proper

body to make an assessment as to whether, in individual cases, particular data should be remembered or forgotten. The reason for this is obvious: unlike a newspaper which may be challenged to take down a story by a disgruntled data subject, a search engine is for all practical purposes a stranger to the data in issue and a stranger to the context in which that data was created.

The notion that it is the right sort of body to make the highly value-laden decisions as to whether such data should be de-indexed offends against common sense. Inevitably, the results of such a system are likely to be highly arbitrary and chaotic. This is itself inimical to the rule of law.

Added to this there is the difficulty that, as yet, there appears to be no obvious means of ensuring that the Article 10 rights are safeguarded within the system. Even if in principle Google permits the owners of the source web-page to object to de-indexation after the event, which is the model currently adopted by Google, in a case where Google has for whatever reason refused to re-index, there is no obvious legal mechanism which would enable individuals to enforce their right to know as against Google. Thus, once again the system has a troubling structural bias in favour of privacy rights.

The really unfortunate aspect of the judgment is that, rather than enhancing the debate around the important issue of privacy in the online world, it simply tethers us to a mechanism which is as inefficient as it is normatively unsound. One can only hope that the lessons learned from this highly problematic judgment may yet go on to inform the approach taken to the 'right of erasure' currently being debated in respect of the new draft EU General Data Protection Regulation.

*Anya Proops is a barrister specialising in information rights at 11KBW Chambers. She is a co-founder of the highly regarded information law blog: [panopticon.com](http://panopticon.com) and sits on the editorial board of the information law reports.*

**Looked at from a practical perspective, the judgment simply does not work.**

## Can I Use This Clip? A Guide to Audio/Video Use

A presentation from the Pre-Publication/Pre-Broadcast Committee on the legal issues arising from the use of audio or video clips. The presentation consists of a powerpoint to be used for training purposes. The powerpoint can be customized to suit the needs of a particular client. Slides that are not relevant to the organization's needs/issues can be deleted, and other information could be added, if desired.

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# Across the Pond: Updates on UK and European Media Law Developments

## *Serious Harm, Trial by Jury, Right to Be Forgotten, IPSO and More*

By David Hooper

### The Serious Harm Threshold

[\*Cooke v MGN Limited\*](#) [2014] EWHC 2831

Under section 1 Defamation Act 2013 which came into force on 1 January 2014 the threshold for libel claims was significantly raised in that in addition to the requirement of the offending words being likely to lower the reputation of the complainant in the eyes of right-thinking people there is a requirement that the words complained of must have caused or be likely to cause serious harm. The tendency of the words to damage a person's reputation is no longer sufficient. In the case of a company trading for profit there is a similar requirement of serious financial harm which is even more difficult to establish given that indicators such as a fall in the share price is not sufficient and that experience has shown that it is very difficult to prove specific damage such as a marked fall in business and to be able to link that to the defamatory publication.

The Cooke case arose out of a television series dealing with those living on social benefits and housing benefits. This led *The Sunday Mirror* to run a story about a housing association and its chief executive headlined "*Millionaire Tory cashes in on TV benefits*". The article was certainly critical of the chief executive pointing to her salary of £179,000 and her mansion in the Gloucestershire countryside which were in stark contrast to the living conditions of those in receipt of housing benefits who were paying rent to her company.

When a complaint was made on her behalf the newspaper – very wisely as it turned out – very promptly published an apology to the housing association and Mrs Cooke. The terms of the apology were not agreed with the other side, but they made it clear that the company was a not for profit housing and care charity and took its responsibilities to the community very seriously and the newspaper apologised to both the company and Mrs Cooke. They sued nevertheless and Mr Justice Bean who has now been promoted to the Court of Appeal had to decide whether serious harm had been caused or was likely to have been caused. The time at which that assessment is made is at the time of the institution of proceedings.

The claimants had the difficulty that normally arises in such instances that they could not produce witnesses who thought any less of the claimants as a result of reading the article. Claimants normally have to rely on people they know and those people tend to continue to hold the claimants in the same measure of esteem as before the publication of the offending article. The claimants did produce witness statements seeking to establish the likelihood of serious harm and the Judge indicated that unless the accusation was self-evidently highly damaging such as for example an accusation of terrorism or paedophilia such evidence would normally be required.

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**A requirement of serious harm is a game changer. Claims that would previously have been successful will now fail leaving the claimants to bear the costs of the action.**



The Judge considered the change in the law and recognised that the introduction of the words serious harm had raised the bar for determining what was actionable but he did not seek to define what would amount to serious harm, as he indicated that these were words in common usage and did not need definition nor did he lay down guidelines as to the sort of evidence that would be required in the future. The consequence therefore is that the issue which constitutes serious harm is likely to be further litigated. However this was a claim which would almost certainly have succeeded under the old law, albeit that the prompt publication by the newspaper of its apology would have mitigated damages.

A requirement of serious harm is a game changer. Claims that would previously have been successful will now fail leaving the claimants to bear the costs of the action. What was of particular significance was the importance the Judge attached to the apology. It was reasonably prominent in the newspaper, although not as prominent as the offending article, but what did resonate with the Judge was that it was very readily accessible on the internet so that anyone looking up the story would have their attention immediately drawn to the fact that there had been an apology. The Claimant was awarded his legal cost up to and including the publication of the apology but had to pay the Defendant's including the costs of trial thereafter.

What one learns from the case, therefore, is the merit of apologising very promptly and in being reasonably generous in the wording and positioning of the apology and ensuring that it is going to show up prominently on any internet search on the topic. If that is done – however counter-intuitive – there is a strong possibility that libel claims of this nature can no longer be brought successfully.

The trial judge, Mr Justice Bean has now given permission to appeal. He was persuaded to do so on the basis that this was the first case which considered the meaning of serious harm under Section 1 Defamation Act 2013 and that there were potentially far-reaching consequences in his interpretation of the meaning of serious harm, which it was argued overturned centuries old common law principles.

### **Juries and Libel Actions**

[\*Yeo v Times Newspapers Limited\*](#) [2014] EWHC 2853

This concerned a Member of Parliament who sat on various parliamentary select committees who joined a longish list of rapacious members of parliament who had been deceived by apparent businessmen with fat cheque books who turned out to be investigative journalists from *The Sunday Times*. Mr Yeo's Sunday breakfast was therefore somewhat spoilt by headlines such as "*Top Tory in New Lobbygate Row – the chairman of a commons committee has boasted of how he can promote businesses in which he has an interest.*"

The newspaper availed itself of the changes in the law under section 11 Defamation Act 2013 and section 69(3) Senior Courts Act 1981 to the effect that an action shall be tried without a jury unless the court in its discretion orders it to be heard by a jury and sought to argue that dealing with such a fundamental matter as the integrity of Members of Parliament one needed the enhanced impartiality of a decision taken by members of the public. Such is the low esteem in which most members of the public hold Members of Parliament that the newspaper may have felt that it could hardly fail if 12 members of the electorate started dissecting the ethics of a Member of Parliament.

However, the recently appointed libel judge, Mr Justice Warby, in a lengthy and impressively reasoned judgment, made it clear that it will only be in very rare circumstances that there will be a jury trial where, for example, there might be thought to be a risk of some involuntary bias in the case of a judge alone. All other factors pointed in favour of trial by judge alone. It was less costly and more proportionate to have trial by judge alone, the case was easier to manage and preliminary points which might be determinative could be resolved at an early stage and there would be the advantage of a reasoned judgment.

Despite its long history dating back to Fox's Libel Act 1792 which had then made juries the normal way of hearing libel actions and afforded protection to newspapers against establishment-minded judges, Mr Justice

Warby gave effect to the virtual abolition of jury trials by virtue of Defamation Act 2013. Jury trials had become increasingly rare by virtue of section 69 Senior Courts Act 1981 whereby there was to be no jury if the court was of the opinion that the trial required any prolonged examinations of documents, accounts or scientific matters.

The real question was whether there was still any mileage in the constitutional principle enunciated by Lord Denning in *Rothermere v Times Newspapers Limited* [1973] 1WLR 448 regarding the importance of a jury, if the newspaper had criticised the great and powerful on a matter of public interest, which had been considered by Lord Bingham in *Aitken v Guardian Newspapers*, noting that it was an important consideration in favour of a jury trial arises where the case involves prominent figures in public life and questions of great importance although in Aitken's libel case there was no jury.

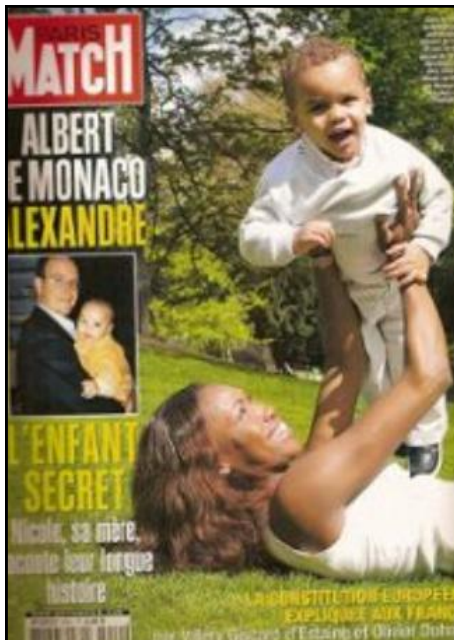
Judges do still have a discretion to order trial by jury, but it will only be extremely rarely that a jury will be held to outweigh the perceived advantages of trial by judge alone of reasoned judgment, proportionality and case management considerations. In any event, Mr Justice Warby considered that although Mr Yeo held an important position in the House of Commons, he was not a member of the government and not, the judge appeared to think, a figure of sufficient public distinction and importance to trigger the Lord Denning principle.

The case also was noteworthy for its analysis of how the defamatory meaning is determined. The defences were justification, a Reynolds defence and fair comment. The judge ruled that the words fell within what is known as a Chase 1 meaning, that is to say that the paper had to justify that the MP was guilty of the conduct it alleged rather than being able to substantiate its case by proving that there were reasonable grounds for suspecting that the allegations were true.

### A More Realistic Approach to Public Interest in the ECHR

There have been two interesting decisions recently where the European Court of Human Rights has reined back the French and German courts respectively, which had made findings against the media on the grounds of lack of sufficient public interest, where to American and English eyes the stories were self-evidently of legitimate public interest.

The first concerned *Paris-Match*, which published an article with photographs of a French lady taken in her flat with her son from a prior relationship with Prince Albert II of Monaco. [Couderc and Hachette Filipacchi Associés v France](#) [2014] ECHR 6004 (decision in French). Prince Albert apparently had not publicly acknowledged the child as his son, but seemingly he had done so privately before a notary in 2003. The mother wrote about her relationship with Prince Albert, his subsequent reaction to her pregnancy and his conduct towards the child.



The French courts had been persuaded by the representatives of Prince Albert that there was no matter of general interest justifying the publication of the article. As the child was illegitimate, he was unable to succeed under the Constitution of Monaco to the throne, that there really was, they argued, no public interest in making the paternity of the child public. The French courts had agreed and awarded €50,000 against *Paris-Match*. The trial court had required *Paris-Match* to put an extract of the judgment on the *entire* front cover of the magazine.

The Court of Appeal at Versailles had reduced this to a mere *one third* of the front cover. By a majority of 4 to 3 the European Court took a wider view of what constituted a contribution to a debate of

public interest bearing in mind that Prince Albert was head of state, albeit of Monaco, as famously described as “*a sunny place for shady people*.” The European Court considered that the French courts got the balance between the public interests of the magazine and privacy rights of Prince Albert wrong.

To broadly similar effect was the decision in [Axel Springer AG \(No.2\) v Germany](#) [2014] ECHR 745 (decision in French). There the German tabloid newspaper Bild had published an article which was critical of the recently retired Chancellor Gerhard Schroder as chairman of the supervisory board of a German-Russian consortium which built gas pipelines. It followed an agreement that had been signed in April 2005 in the presence of Mr Schroder and Mr Putin. The article was headlined “*What does he really earn from the pipeline project? Schroder must reveal his Russian salary.*” The article also contained speculation by a German politician, Mr Thiele, who was the deputy president of the FDP parliamentary group, that Schroder had resigned from his political office because he

had offered this well-paid job and that Schroder's decision to call early elections had been taken with that self-interested aim.

Although *Bild* had correctly reported what the politician had said, the German Regional Court considered that *Bild* had published serious and insulting suspicion against Schroder. While acknowledging that the article concerned a matter of public interest, they criticised the newspaper for lacking objectivity and balance and for failing to consult Mr Schroder or one of his team prior to publication.



The European Court, however, felt that the case concerned matters of public interest. The former chancellor, having held one of the highest political offices in the Federal Republic of Germany had a duty to show a much greater degree of tolerance than a private citizen to such articles. The article did not relate to his private life with the aim of satisfying public curiosity, but concerned his controversial appointment to a Russian-German gas consortium shortly after he had left office.

*Bild* had not exceeded the limits of journalistic freedom and the German court had failed to establish that there was a pressing social need to put the protection of the reputation of the Chancellor above the right of the press to freedom of expression. In the political arena freedom of expression was of the utmost importance and the press had a vital role as public watchdog. The German courts had therefore violated article 10 when they had made an order prohibiting any further publication of the passage in the article which reported the comments of Mr Thiele.

### **Parody Can Be Fair Dealing in Copyright**

On 1 October 2014, British copyright law is changed by the implementation of [Regulation 30A Copyright and Rights in Performances \(Quotation and Parody\) Regulations 2014](#). This provides that fair dealing with a work for the purpose of caricature, parody or pastiche does not infringe copyright in the work. Up until that time there was a real risk that a parody could be viewed as involving the unlawful copying of a substantial part of the original work.

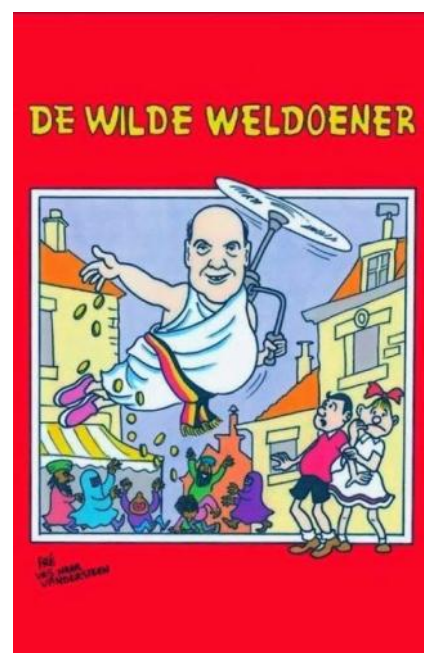
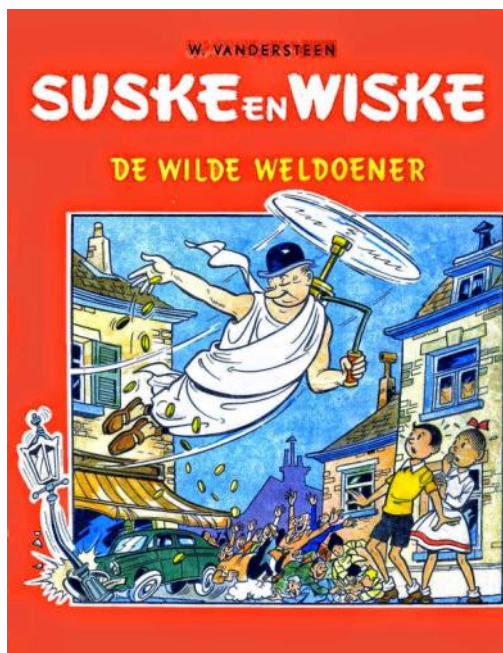
Fair dealing itself is not defined, but there are some guidance notes from the Intellectual Property Office, which gives some indications of how one judges whether or not it is fair dealing. One would look at whether the amount taken from the original work was fair and reasonable and whether the new work would be said to be a competing work in the sense that it affects the market for the original work. One would also need to look at the question of whether the amount taken from the original work in the parody is fair and reasonable.

Essentially, anyone will be able to parody a copyrighted work if it evokes the original work, it is noticeably different from the original work, it is humorous and there is a fair balance in how the parody is used. Ideally one

will want to make the judge smile. The scope for the new parody exception could be very considerable in the commercial as well the literary sector. It will be easier to mock titles in advertisements by parodying their advertising campaigns and the exception is also likely to be exploited by TV production companies, computer game publishers, theatre production companies, musicians and video-hosting websites.

### CJEU Parody Decision

This change in the British law of copyright mirrors the decision in *Deckmyn v Vandersteen* in the Grand Chamber of the European Court of Justice on 3 September 2014. This concerned a political parody of a well-known (to Belgians) Belgium comic called Spike and Suzy (Suske En Wiske to give the Flemish names). The cartoon characters appeared on a calendar based on the cartoon characters and produced by a Flemish nationalist party. The purpose was to attack the Major of Ghent, but the parody pictures had certain racial and discriminatory overtones.



Original cartoon cover, left; defendant's parody cover, right.

The case concerned a preliminary ruling on the interpretation of article 5(3)(k) of Directive 2001/29/EC which provided for a copyright defence in cases of use for the purposes of caricature, parody or pastiche. The European Court held that the essential characteristics of parody are firstly to evoke an existing work, while being noticeably different from it, secondly, to constitute an expression of humour or mockery. The parody should display noticeable differences with respect to the original parodied work and it should be reasonable attributed to a person other than the author of the original work and it should be seen to relate to the original work itself or mention the source of the parodied work. A fair balance is to be struck between on the one hand the interests and rights of the copyright holders and on the other freedom of expression of the user of the protected work who is relying on the exception for parody.

The interesting point in the Belgian case was that the rights holder in a comic series for children would be likely to object strongly to the discriminatory message based on race, colour and ethnic origin which the calendar

appeared to highlight. The European Court indicated that copyright holders could oppose a parody if it communicated a discernible message which they could legitimately not want to be associated with. While parody is within these parameters a transformative use of the copyright work which can be made without the permission of the copyright holder, all these factors had to be balanced and the European Court referred the matter back to the Belgian courts to decide where that balance should be struck. This parody would seem to be in real danger of being held not to be sufficiently humorous or mocking and not to strike a fair balance in the sense that the parodied use might be thought to damage the rights of the copyright holder.

### Right to be Forgotten – Latest Developments

The principle ramifications of [Google Spain SL v Agencia Espanola de Proteccion de Datos](#) have included the tens of thousands of requests to have disagreeable, personal data expunged. A recent case in Amsterdam, however, has given some grounds to hope that the *Google Spain* ruling will be applied more sparingly. There the owner of an escort agency who had been sentenced to six years imprisonment for attempted incitement of a contract killing wanted all links giving details of his crime removed.

Google were not prepared to agree to the width of his request. The judge ruled that the decision in [Google Spain](#) was not intended to protect individuals against all negative communications on the internet, but only against those being pursued for a long time by irrelevant or excessive or unnecessary defamatory expressions. The fact that the complainant had been convicted and sentenced to a term of imprisonment was already well-known in Holland. The information complained of did not appear to be unnecessarily defamatory and it appeared in the judge's view relevant, even after the elapse of a certain period of time. For a more detailed discussion of this case see the article by Jens van den Brink and Joran Spauwen.

Google Spain was considered in slightly different circumstances in England in the case of [Heglin v Persons Unknown](#) [2014] EWHC 2808. The claimant was a businessman in Hong Kong and relying on sections 10 and 14 Data Protection Act 1998, he sought to prevent Google processing data which was likely to cause him damage or distress. He was seeking the permission of the court to serve proceedings under the Data Protection Act on Google Inc in the United States, claiming that England was the appropriate forum for the dispute.

The claim arose out of a series of anonymous, abusive posts. It was accepted by the Claimant that Google had cooperated in taking down the posts, but there remained an issue for trial as to whether Google had done all that it could to have prevented publication of the material complained of and as to the extent of Google's obligations as defined in the Google Spain case in complying with its obligations under the relevant data protection legislation in processing the data. The argument of the Claimant is that Google was under an obligation enforceable in England to comply with the requirements of the Data Protection Act, including an obligation to prevent the processing of the personal data of the claimant, which was inaccurate, or was likely to cause him substantial damage or distress. The matter is likely to come on for trial in November 2014.

In the meantime, the House of Lords Home Affairs, Health and Education EU Sub-Committee has concluded that the decision in Google Spain relating to personal data which was inaccurate, irrelevant, no longer necessary, or excessive in relation to the purpose for which it had originally been processed was “*misguided in principle and unworkable in practice.*” However, what notice – if any- will be taken in the European Union as to their

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**The European Court indicated that copyright holders could oppose a parody if it communicated a discernible message which they could legitimately not want to be associated with.**

recommendations of their lordships and ladyships regarding proposals to remove any right to be forgotten or right to erase remains to be seen. It is however, indicative of the level of political controversy which has arisen in relation to this decision giving large measure to the tens of thousands of applications for the erasure and to the public perception that people, often of dubious antecedents are able now to launder their past.

As some measure of the political controversy which the Google Spain case has attracted the European Commission has rather bizarrely produced what it calls a fact-sheet entitled "[Myth-busting the Court of Justice of the EU and the 'Right to be Forgotten'](#)" which in a simplistic and crude fashion describes six myths against which a red cross is placed directing one's attention to the facts against which a green tick is placed so that the good burgers of Europe can be reassured that all is right with the world.

#### **Damages for Distress under the Data Protection Act**

[AB v Ministry of Justice](#) (2014) EWHC 1847

There was an interesting decision of Mr Justice Baker which was another example of the growth of remedies under data protection legislation. There a solicitor who sought information from the Ministry of Justice under the Data Protection Act following his wife's death took action against the Ministry on the basis that they had withheld one piece of information and had failed to provide other information within the statutory time limits. Under section 13(2) Data Protection Act the claimant is entitled to compensation for distress only where he has suffered damage. This was previously thought to mean specific financial damage but this limitation appeared to have been side-stepped by the Judge who awarded £1 general damages onto which he tagged £2,500 for the distress suffered.

#### **Open Justice**

[PNM v Times Newspapers Limited](#) [2014] EWCA Civ 1132

The judgment of Lady Justice Sharp LJ in the Court of Appeal upheld the High Court decision of Mr Justice Tugendhat that a court would not make an order for non-disclosure in favour of a person investigated but not charged in the course of a criminal inquiry into sexual offences against children.

PNM was not himself charged although others in a ring of sexual predators were and were convicted. PNM's name did however feature in the course of the trial and the media wanted to be able to report that evidence. He sought to prevent it being published pointing out that it could place his family and himself at risk.

The court felt however that his rights were outweighed by the higher degree of public interest in reporting proceedings which were held in open court. The court also considered that the public would discern the difference between suspicion and guilt and would understand and accept that PNM was in any event entitled to the presumption of innocence. In so saying the courts may perhaps have over-estimated the sense of fair play of the British public who have on occasions had difficulty in differentiating between paediatricians and paedophiles and have happily thrown bricks through the windows of the hapless doctors. However, the case was a reassuring re-assertion of the right to report proceedings in open court. The case may be heard in the Supreme Court and the orders for anonymity remain in place until the case is concluded.

#### **Protection of Sources and Abuse of RIPA Powers**

Evidence has emerged as to how the police have investigated unauthorised dealings between journalists and the police with the result that the police have been able to obtain whole-scale evidence as to journalist sources. On occasions there have been instances where the dealings between tabloid journalists and the police have breached

the criminal law, but the police do have well-recognised powers to investigate crime and to get the appropriate production orders or warrants.

What has increasingly been happening is that the police have circumvented the procedural safeguards under the Police and Criminal Evidence Act 1984 (PACE) with the protections that they provide for journalists and journalistic materials. There are special provisions under PACE for "Journalistic Material" which is material acquired or created for the purpose of journalism in the possession of the person who so acquired or created it. For the police to get hold of such material they have to go to a judge and satisfy him or her that there are reasonable grounds for believing an indictable offence has been committed, that there are reasonable grounds to believe that any material on the premises specified in the application is likely to be of substantial value to the investigation and that other methods of obtaining the material have been tried without success.

The police also have to satisfy a public interest test and the media organisation would normally have seven days to comply with the production order and they have an opportunity of challenging the order. That way a balance is struck between the prosecution of crime and the protection of sources.

However what the police have now been doing is using their powers under the Regulation of Investigatory Powers Act 2000 (RIPA) where such safeguards do *not* exist and the gateway to the material is obtaining permission from a senior officer of the police that normally tends to be a little more accommodating and unquestioning to his officers than a judge. The upshot is that under RIPA the police then go to the telephone company and get a print-out of all the numbers the journalist has been calling on his phone. That way they know who the journalist has been talking to which might include not only improper transactions involving corrupt police officers (where there have been a number of recent trials) but will almost certainly also include the numbers of a large number of unrelated sources. While it is right that crime is investigated, there are well-recognised procedures under PACE, but these are being circumvented under RIPA and at the same time a lot of confidential and unrelated information is being secretly and unaccountably hoovered up.

This has become routine and arbitrary and a challenge is being made by the Bureau of Investigative Journalists to the European Court of Human Rights as to whether UK legislation adequately protects journalist sources from routine government surveillance and mass scrutiny.

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### **IPSO Opens for Business**

The [Independent Press Standards Organisation](#) (IPSO) was launched on 8 September 2014. It replaces the discredited Press Complaints Commission (PCC) and is the product of considerable debate and controversy following the recommendations of the Leveson inquiry. There are some newspapers who have not signed up for IPSO. The aim of IPSO is to be "*rigorous, independent, fair and transparent.*" It sees its objective as helping rebuild public trust in the Press through a system of independent fair and transparent regulation. It will operate the standards of the Editor's Code of Practice and its Chairman is the retired Court of Appeal judge Sir Alan Moses.

The first case which IPSO may be called to adjudicate upon arises out of the resignation of the Minister for the Civil Service, Brooks Newmark. He was the victim of a tabloid newspaper sting which had him believing that he was flirting with an attractive Tory PR woman called "Sophie Wittam" and according to no less an authority than Mark Stephens sending her selfies of his toddler. The discovery that the PR lady was contrary to the impression

given by the photographs he had been sent in fact a male freelance reporter of the *Sunday Mirror* was a matter of some surprise and disappointment to Mr Newmark and his resignation followed swiftly.

Another MP who claims he was likewise approached by “Sophie Wittam” but did not feel the need to send her a selfie has asked IPSO to investigate the question of entrapment and any wrongdoing. The newspaper claims that the subterfuge was justified in the public interest. The matter will provide IPSO with an excellent opportunity to demonstrate how it will deal with such complaints.

Public interest may be used as something of a yardstick for critical assessment of IPSO. Many felt the PCC gave too much latitude to the media's claimed defence of public interest as opposed to the complaints of the public about apparent breaches of the Code. It looks as if the Newmark case may bring the issue into sharp focus in one of its first decisions

In the meantime the Information Commissioners Office has produced a booklet entitled [Data Protection and Journalism – A guide for the media](#) which explains how the Data Protection Act applies to journalists and explains what is good practice and what is the role of the Information Commissioners Office. It is simply guidance and does not replace any codes and it has also produced a quick guide for journalists which, given the increasing importance of data protection, most journalists are likely to want to have readily available.

*David Hooper is a lawyer with Reynolds Porter Chamberlain LLP in London.*

## MLRC UPCOMING EVENTS

### MLRC Forum: Controlling Data, Forgetting Data: What U.S. Lawyers Need to Know About the Right to Be Forgotten

November 12, 2014 | New York, NY

### MLRC Annual Dinner & Forum

November 12, 2014 | New York, NY

### DCS Annual Lunch & Meeting

November 13, 2014 | New York, NY

### MLRC/Southwestern

### Entertainment and Media Law Conference

January 15, 2015 | Los Angeles, CA

### Legal Frontiers in Digital Media

May 14-15, 2015 | Palo Alto, CA



## Seventh Circuit Affirms Photo on T-Shirt Is Fair Use

### *Court Expresses Skepticism Over Transformative Use Test*

The Seventh Circuit this month affirmed that the use of a photograph on a satirical T-shirt was a fair use. *Kienitz v. Sconnie Nation*, No. 13-3004 (7th Cir. Sept. 15 2014) (Easterbrook, Bauer, Williams, JJ.). The panel found that defendant's T-shirt incorporating plaintiff's photograph was not a substitute for the original and would not reduce demand for the original or any contemplated use of it.

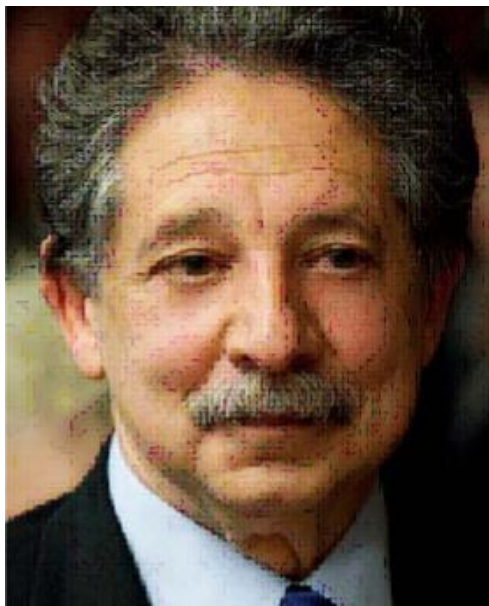
Judge Easterbrook, writing for the panel, deliberately avoided applying the "transformative use" test and, in fact, expressed skepticism about it. Instead the traditional non-exclusive four factor test was appropriate to resolve the case – particularly the fourth prong's consideration of impact on the market.

#### Background

At issue was the use of a photograph of Madison, Wisconsin Mayor Paul Sogin taken by plaintiff Michael Kienitz, a professional photographer. Defendants "posterized" the photo, added the slogan "Sorry For Partying," and used it on T-shirts and tank tops sold in connection with an annual Madison street party.

Mayor Sogin had participated in the party as a student protestor in the 1970's, but more recently tried to shut the party down – thereby making him a target for the satire.

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Left, plaintiff's photograph; right, defendant's parody t-shirt

Last year, a Wisconsin federal district court granted summary judgment in favor of the defendants based on fair use. See [965 F. Supp. 2d 1042](#) (W.D. Wisc. 2013). The district court analyzed the four fair use factors, but noted “the robust transformative nature” of the T-shirts.

### Seventh Circuit’s Fair Use Analysis

On appeal, the Seventh Circuit affirmed but without relying on “transformative use.” Judge Easterbrook noted that “transformative use” is not a statutory fair use factor, but something the Supreme Court mentioned in *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994) and the Second Circuit has “run with” it. See, e.g., *Cariou v. Prince*, 714 F.3d 694 (2nd Cir. 2013) (holding “appropriation art” was transformative).

Judge Easterbrook opined that “we’re skeptical of *Cariou*’s approach because asking exclusively whether something is ‘transformative’ not only replaces the [four-factor test] in § 107” but could override the copyright protection for derivative works. “To say that a new use transforms the work is precisely to say that it is derivative, and thus, one might suppose protected under § 106(2).”

Judge Easterbrook then applied the four statutory factors. First, the purpose and character of the use did not weigh one or the other between the parties. The T-shirts were sold for profit but were made for political commentary. Second, the nature of the copyrighted work was “unilluminating.” Third, the amount and substantiality of the use weighed in favor of defendant since it “removed so much of the original that, as with the Cheshire Cat, only the smile remains.” Fourth, and most importantly, the effect of the T-shirt upon the potential market for or value of plaintiff’s photograph weighed in favor of the defendants. The T-shirt incorporating plaintiff’s photograph was not a substitute for the original and the use would not reduce the demand for the original work or any contemplated use of it.

In dicta, Judge Easterbrook suggested that plaintiff could have argued that his long-range economic interest was harmed since people might not want to use him as a photographer if the photos appear on undignified T-shirts. But the argument was not made, and would likely have failed on the facts where the photograph was substantially altered.

*Plaintiff was represented by James D. Peterson and Jennifer L. Gregor, Godfrey & Kahn, S.C., Madison, WI. Defendants were represented by Eric Hatchell, Jeffrey Simmons and Naikang Tsao, Foley & Lardner LLP, Madison, WI.*

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# Copyright and Trademark Claims Over Biographical Movie Dismissed

## *Recreation of Old Movie Scenes Was Fair Use*

A New York federal court dismissed copyright and trademark claims against the producers of the movie *Lovelace*, a biographical portrayal of the star of the infamous 1970's porn movie *Deep Throat*. [\*Arrow Productions v. The Weinstein Company\*](#), No. 13-cv-05488 (S.D.N.Y. Aug. 25, 2014) (Grisa, J.). The court held that the reenactment of scenes from the 1970's movie was a fair use as a matter of law.

### Background

In 2013, the Weinstein Company released the movie *Lovelace* about Linda Lovelace, later Linda Marchiano, portraying her entry into the pornography business, her troubled marriage to Chuck Traynor, who allegedly abused her and coerced her into participating in *Deep Throat*, and her transformation from a famous porn star to an outspoken critic of pornography in later life. *Lovelace* does not contain any pornographic scenes or nudity.

Plaintiff Arrow Productions owns the copyright to the 1972 movie *Deep Throat* as well as trademarks for "Deep Throat" and "Linda Lovelace." Plaintiff alleged that three scenes in *Lovelace* violated its copyright and trademarks by reproducing dialogue, camera angles, lighting, costumes and settings from *Deep Throat*.

### Fair Use Analysis

Following a blow-by-blow comparison of the scenes from the two movies, the court ruled *Lovelace* was fair use as a matter of law. The court noted that as a critical biographical work, the defendants' movie was entitled to a presumption of fair use.

Looking at the purpose and character of the use the court held that *Lovelace* was transformative, i.e, it "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message." Quoting *Cariou v. Prince*, 714 F.3d 694, 705 (2nd Cir. 2013). As the court explained:

[D]efendants' use, or recreation, of the three scenes from *Deep Throat* constitutes transformative use, adding a new, critical perspective on the life of Linda Lovelace and the production of *Deep Throat*. *Deep Throat* is a pornographic film containing seventeen scenes of explicit sexual content. Conversely, *Lovelace* is a critical biographical film that documents the tragic story of Linda Lovelace and provides a behind-the-scenes perspective on the filming of *Deep Throat*. It does not contain any nudity. Defendants have recreated the three challenged scenes in order to focus on a defining part of Lovelace's life, her starring role in *Deep Throat*.

The judge summarily dismissed the plaintiff's trademark claims for infringement, false designation of origin and trademark dilution after concluding that the plaintiff failed to adequately plead those claims.

*Evan Mandel, Mandel Bhandari, LLP in New York, represented plaintiff Arrow Productions. Benjamin Stewart Akley and Tom J. Ferber, Pryor Cashman LLP in New York, represented defendant The Weinstein Company, LLC and the other defendants.*



# The Lies of Poets: Copyright in Literary Biopics

## *When Are “Fictional” Episodes Uncopyrightable “Historical Facts”?*

By Patrick Kabat

It is axiomatic that no author may lay claim to the facts of her life. This is no less true for poets who write autobiographies than public servants who publish memoirs, but the former are particularly prone to make art from life, producing autobiographical works that blend fiction with fact.<sup>[1]</sup> As the literary memoir occupies center stage in the catalogs of publishing companies,<sup>[2]</sup> and Hollywood gives us a spate of recent biopics about celebrated writers,<sup>[3]</sup> it is increasingly important to understand how copyrights materialize within the blurred lines between fact and fiction in literary autobiography.

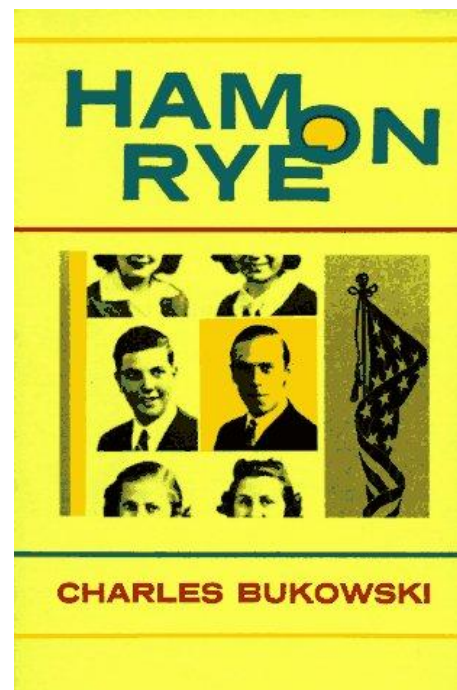
The freedom to make films about writers depends on it, because however significantly their semi-fictional writings may illuminate their lives, authors (or more commonly, their estates and assigns) may claim copyright in episodes from those works, even if the episodes reflect uncopyrightable facts. So how do we know an autobiographical fact when it appears in a work of fiction?

This novel question has been teed up by *Humphris v. James Franco et al.*,<sup>[4]</sup> a recently filed copyright suit against the polymath actor James Franco and his production company. The plaintiff says he owns the film rights to bar-poet Charles Bukowski’s semi-autobiographical novel *Ham on Rye*, and that Franco violated those rights by developing his own film about the poet, *Bukowski*. In addition to the usual allegations about access and similarity, and some less usual allegations about the parties’ prior dealings, the complaint identifies three scenes that the plaintiff says are stolen from *Ham on Rye*.

Bukowski being Bukowski, the suit lands awkwardly between two well-trodden bodies of copyright law: the uncopyrightability of fact, and the fair use of copyrightable expression. The former is straightforward: copyright simply “does not recognize private ownership of historical information, nor does it enforce efforts to hoard, suppress, sell or license historical fact, or to govern who may and who may not disseminate it.”<sup>[5]</sup>

Biographical facts, therefore, “may not be copyrighted and are part of the public domain available to every person” with only “thin” copyright protection lingering in the arrangement of those facts.<sup>[6]</sup> A dearth of caselaw specifically addresses autobiographies, but settled principles governing the use of personal letters (tiny autobiographies published to an audience of one), journals (serial autobiographies published to an initial audience of zero) and different biographical works about the same subject make plain that historical works making use of

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purely factual autobiographical material are doubly insulated from copyright claims: factual information is not protected by copyright, and the doctrine of fair use excuses the biographer's measured appropriation of the autobiographical expression itself. [7]

Where original works of fiction are concerned, by turn, a literary biographer's first line of defense is fair use, for even the stronger protection copyright affords to original works of fiction does not prevent a biographer's use, in appropriate measure, for an "illustrative" or "instructive historical purpose." [8] Literary biography simply could not exist without this accommodation, but in the context of factually based works the doctrine unsatisfactorily concedes copyright; in the context of literary expression it is vulnerable to judgments about the appropriation of particularly "radiant" expression; [9] and in the context of transposition across mediums—say, from verse to screen—fair use invites speech-chilling uncertainties about the extent to which innovative uses of creative material are transformative, and so on.

*Ham on Rye* straddles both bodies of law. Like most of the Bukowski corpus, it is both fictional and autobiographical – a thinly veiled *roman à clef* about the author's childhood in which the character Henry Chinaski serves as Bukowski's narrative avatar. In such a work, or innumerable others that both contain original invention and reveal biographical facts—Joyce's *Portrait*, Hemingway's *Moveable Feast*, or Franco's own recent pseudoconfessional, *Bungalow 89*, that "reads a lot less like fiction and a lot more like vignettes from his own life," [10] First Amendment principles that afford "broad latitude" to "authors who contemplate tackling an historical issue or event" [11] protect biographers who appropriate factual content. But how do we know fact from fiction? More precisely, to whom does the law of copyright entrust that judgment?

Authors, of course, can tell us themselves, and even when the extent of fictionalization is disputed, courts will hold them to their word. Copyright estoppel precludes authors from ginning up stronger rights than properly vest in works they have represented to be factual, for "equity and good morals will not permit one who asserts something as a fact which he insists his readers believe as the real foundation for its appeal to those who may buy and read his work, to change that position for profit in a law suit." [12]

On this basis, the owner of film rights to a biography could not claim that a Mel Brooks biopic about actress and activist Frances Farmer infringed even fictionalized elements of the biography, where promotional materials represented the work to be a true story, and reasonable readers would have understood it as such. [13] Likewise, where the author and publishers of a book about a famous medical examiner held the book out as factual, the author was estopped, as a matter of law, from proceeding against a television show on the basis that it was a protectable work of fiction. [14] The doctrine offers writers a sensible bargain, insisting that they choose between trading on the factual appeal of a true story, and asserting the more robust control over later use that copyright entitles fiction writers.

But copyright estoppel asks only how a work is held out to the public, not whether the underlying episodes are or are not factual, [15] and courts may be leery of applying the doctrine where an author's representations are anything short of unambiguous. Authors speak about their craft with varying degrees of conclusiveness, whether writing plainly, as Bukowski did of his novels, that "they're more fact than fiction" and "in the real sense they can't be called novels," [16] or more equivocally, as Hemingway instructed readers of *A Moveable Feast*, that

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though they may understand the collection of his Parisian reminiscences as fiction, “a book of fiction may throw some light on what has been written as fact.”<sup>[17]</sup>

Courts, in turn, may arrogate to themselves the task of separating uncopyrightable “historical facts” from authors’ fictional contributions, as two courts recently did when declaratory judgment actions against different claimants became necessary to quiet threats against *Effie*, a biopic about John Ruskin. In *Effie Film v. Pomerance*, Judge Oetken took extensive judicial notice of “historical facts” relating to the Victorian art critic,<sup>[18]</sup> a term prominent historiographer Richard J. Evans defines as “something that happened in history and can be verified as such through the traces history has left behind,”<sup>[19]</sup> and granted judgment on the pleadings for the film company on the basis of noticed facts.

His thorough and scholarly opinion explains that judicial notice may be used for the “careful parsing of protectable fictionalizations from unprotectible interpretations,” and that federal courts “may take judicial notice of the existence of certain historical facts and interpretations prerequisite to analysis of the protectible and unprotectible elements of the disputed works” on a Rule 12 motion.<sup>[20]</sup> As Judge Griesa put it in the other *Effie* action, this is “the court’s role.”<sup>[21]</sup>

Courts may also consider news reports<sup>[22]</sup> or weigh affidavit evidence from “reputable and knowledgeable authors”<sup>[23]</sup> to determine the factual nature of a work. In *Mosley v. Follett*, the court rejected a copyright plaintiff’s argument that his book about the exploits of a German secret agent in Cairo during the Second World War was entitled to the fuller protections afforded fiction. The defendant, who wrote an historical novel in which the secret agent appeared, was entitled to use the same “essential historical facts,”<sup>[24]</sup> because the plaintiff, a British journalist, introduced his book as a memoir of his time with spies, described having located and interviewed the secret agent after the war, and was understood by affiants (and at least one CIA analyst, who wrote in a recently declassified document that it was a book “of considerable interest” with a “factual basis”<sup>[25]</sup>) to have been telling true tales.

Though autobiographical accounts would seem to be uniquely authoritative historical “traces,” courts may have less comfort sifting facts from a partially fictionalized autobiography, or wading into a thicket of academic debates about historical truths, than conducting a review of peer-reviewed secondary literature or newspapers of record. As with copyright estoppel, courts may want more clarity than may be available outside the four corners of a partially autobiographical work. But does the law require juries to determine whether T.S. Eliot dared to eat a peach,<sup>[26]</sup> if no court dares to take judicial notice?

No. That is a task for biographers, not juries, and basic copyright and First Amendment principles protect a biographer’s freedom to undertake it. Ambiguity as to whether a work conveys an historical fact must be resolved, as a matter of law, in favor of the biographer who elects to treat it as fact, because resolving that ambiguity is an act of historical interpretation. *Feist* made plain that biographical facts “may not be copyrighted and are part of the public domain available to every person,”<sup>[27]</sup> so “[w]hen a biographer or historian, using a copyrighted work as a source, takes historical information from it, he does not infringe the copyright.”<sup>[28]</sup> A semi-autobiographical novel or poem is not just an exploitable narrative work, it is also itself an historical fact, and an important *source* about the author’s life, however much or for whatever reason his biographers may distrust it.

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Courts may notice such facts as they are comfortable finding, but it is the *biographer's* prerogative, not that of the author (and his profit-maximizing assignees) or the courts, to decide whether to trust a source: that judgment is idea, not expression. If an autobiographical novel is the only source for a particular vignette, whether to understand that event as fact or fiction is an exercise in historical interpretation, and if “the idea at issue is an interpretation of an historical event,” “such interpretations are not copyrightable as a matter of law.”<sup>[29]</sup>

In this way, the First Amendment’s solicitude for historical inquiry reinforces the same bargain that drives copyright estoppel. By declaring, implicitly or explicitly, his work to be at least partly confessional in character, the author of an autobiographical poem or novel creates both a work of literature and a primary source about his life. He abandons the stronger copyright protections afforded to pure invention, and becomes, for those interested in telling his story, a source of factual information. His biographers, in turn, approach that source (as do all historians when analyzing records of the past) according to their judgments about authenticity, reliability, and truthfulness.<sup>[30]</sup>

Indeed, a partially fictional autobiography may provide a biographer with a more reliable view of his subject than an autobiography emphatically held out as fact, for a thin veil of fiction has often left writers *freer* to tell true tales, whereas a memoirist’s table-pounding that his version is true may protest too much, stinking of calculated revisionism.

Autobiographical novels can also provide additional evidence that supplements our understanding of otherwise well-documented events, such as when a young James Joyce knocked impertinently on the Dublin door of another Irish writer, “A.E. the mastermystic” in the “small hours / of the morning to ask him / about planes of consciousness.”<sup>[31]</sup> Exercising that judgment is the very essence of biography, and depicting brief vignettes from partially fictionalized autobiographical works as biographical fact simply does not appropriate protectable expression; it announces a judgment that the source *can* be trusted. No biographer should avoid advancing that judgment because she fears a court may later disagree.

Admittedly, translating these principles across mediums is imperfect and untested. A film that interprets a source as a reflection of a biographical fact and depicts it onscreen does so less explicitly than a biographer who drops a footnote saying as much. Joyce’s leading biographer, for example, was able to confirm that Joyce had indeed accosted George Russell (A.E.) through an interview with one of Joyce’s contemporaries and accounts in A.E.’s letters, but whether A.E. also spoke with an American interviewer about the midnight interruption relied on “the evidence of *Ulysses*.”<sup>[32]</sup> But directors of biopics are not disentitled to the latitude the Constitution affords biographers in older mediums. Doubts as to whether a particular episode amounts to an interpretation must be resolved in the biographer’s favor: courts “construe the scope of ‘facts’ and ‘interpretations’ broadly” to avoid chilling the historical enterprise.<sup>[33]</sup>

Fair use may be necessary to justify poetic, rather than historical, appropriation—that is, where a biographer does not interpret (and portray) a vignette as reflecting a biographical fact, but rather quotes it outright *as a work of fiction*. A biopic screening Eliot at his desk, spliced with a visual depiction of *The Love Song of J. Alfred Prufrock* and its peach, is the on-screen equivalent of the poet’s biographer dropping a stanza or two in-text. *Howl*, for example, in which James Franco played Allen Ginsberg, punctuated the obscenity trial to which Ginsberg’s poem

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was subjected by screening the poem itself, alternately in animated form and at its seminal 1955 reading at San Francisco's Six Gallery.

These "quotations" may be justified under the familiar grounds of transformativeness, market overlap and similarity of expression, but they are, at root, reproductions of a fictional work *as fiction*, rather than the historical interpretation of a source's factual basis.<sup>[34]</sup> Whether Eliot's symbolic peach was biblical or sexual is a matter for critics to debate, and if quoted or depicted *as a poem* for a *critical* purpose, fair use is the appropriate response.

But imagine a biopic in which T.S. Eliot resolutely dares to *eat* that peach. Whether he agonized over its eating is a matter for biographers, who may make *biographical* use of the episode, or directors, should they choose to depict it as a factual occurrence onscreen. Or a biopic in which Matthew Arnold, who wrote *Stanzas from the Grand Chartreuse* while staying at the eponymous monastery, rides "[t]hrough Alpine meadows / soft-suffused / With rain, where thick the crocus blows."<sup>[35]</sup> A biographer may take him at his word, and a biopic depicting those episodes *as they happened*, rather than quoting the poem *qua* poem through Arnold at his desk or at a reading, need not concede copyrightability in Arnold's ride, crocuses, ragged pines, and all, and protest only that the use was fair. Nor need a production company wait to develop such a film until an army of scholars source the Alpine ride. The poem *itself* is a source for autobiographical facts, and their historical interpretation is reserved to those making historical use.

Assignees of rights in these poems may protest, but only to the extent that they bear unrealistic expectations about conveyable rights.<sup>[36]</sup> Likewise, holders of film rights in autobiographical works may be frustrated to discover that they lack claims against films that depict episodes described in those works, although certainly not in greater degree than production companies may be frustrated by the pragmatic expedient of licensing an autobiography, a biography, or a handful of each to avoid the cost of defending meritless copyright suits.<sup>[37]</sup> So *caveat emptor* to purchasers of film rights in a thinly fictionalized autobiographical work.<sup>[38]</sup> To the extent that episodes in a semi-autobiographical work are interpreted (and depicted) to state historical facts, they are no one's property.

*Patrick Kabat is an associate in the New York office of Levine, Sullivan, Koch & Schulz, LLP. The views expressed in this article are his own. Those interested in licensing biographical facts disclosed in it should contact the Media Law Resource Center.*

## **NOTES**

1. *E.g.* Ernest Hemingway, *Preface, A MOVEABLE FEAST* ("a book of fiction may throw some light on what has been written as fact."); Letter from Charles Bukowski to Jeff Weddle (1988), in 3 CHARLES BUKOWSKI: SELECTED LETTERS, 1978-1994, at 99-100 (Cooney, Seamus ed., 1999) ("On the novels, I'm afraid they're more fact than fiction and I suppose in the real sense they can't be called novels.").
2. James Atlas, *Confessing for Voyeurs; The Age of the Literary Memoir is Now*, *The New York Times Magazine* (May 12, 1996); available at <http://www.nytimes.com/1996/05/12/magazine/confessing-for-voyeurs-the-age-of-the-literary-memoir-is-now.html>; Ben Yagoda, *MEMOIR: A HISTORY* (2009) (genre sales in the U.S. increased by 400% between 2004 and 2008).

(Continued on page 25)



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3. E.g. PAPA (Bob Yari, forthcoming 2015) (Hemingway biopic); THE INVISIBLE WOMAN (BBC Films 2013) (Dickens); YOUNG GOETHE IN LOVE (Senator Film Produktion 2011); HOWL (Werc Werk Works 2010) (Ginsberg); BRIGHT STAR (Pathé Renn Productions 2009) (Keats); BECOMING JANE (HanWay Films 2007) (Austen); MOLIÈRE (Fidélité Productions 2007); Infamous (2006) (Warner Independent Pictures 2006) (Capote).
4. *Humphris v. Franco et al.*, No. 2:14-cv-03162 (C.D. Cal. Apr. 24, 2014).
5. *Craft v. Kobler*, 667 F. Supp. 120, 123 (S.D.N.Y. 1987) (citations omitted).
6. *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).
7. E.g. *Craft v. Kobler*, 667 F. Supp. 120, 126 (S.D.N.Y. 1987); *Wright v. Warner Books*, 953 F.2d 731, 736 (2d Cir. 1991) (“Most of the passages [from journal entries and private correspondence] on which plaintiff bases her allegations of copyright infringement convey facts or ideas.”).
8. *Id.*
9. *Id.* at 127 (Stravinsky’s biographer disentitled to make extensive use of composer’s “radiant” prose); see also *Salinger v. Random House, Inc.*, 811 F.2d 90, 100 (2d Cir. 1987) (J.D. Salinger’s biographer disentitled to paraphrase unpublished expressive content too closely).
10. Ben Beaumont-Thomas, *James Franco pens short story with central character Lindsay Lohan*, The Guardian (June 10, 2014), available at <http://www.theguardian.com/books/2014/jun/10/james-franco-short-story-lindsay-lohan-bungalow-89>; James Franco, *Bungalow 89*, Vice (June 10, 2014), available at <http://www.vice.com/read/bungalow-89-0000347-v21n6>.
11. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 978, 980 (2d Cir. 1980).
12. *Oliver v. Saint Germain Foundation*, 41 F. Supp. 296, 299 (S.D. Cal. 1941).
13. *Marshall v. Yates*, No. 81-1850, 1983 WL 1148, at \*2-3 (C.D. Cal. Oct. 26, 1983).
14. *Houts v. Universal City Studios, Inc.*, 603 F. Supp. 26 (C.D. Cal. 1984).
15. *Houts*, 603 F. Supp. at 31.
16. Bukowski, *supra* n.1.
17. Hemingway, *supra* n.1.
18. *Effie Film, LLC v. Pomerance*, 909 F. Supp. 2d 273, 296 (S.D.N.Y. 2012).
19. Richard J. Evans, IN DEFENSE OF HISTORY 66 (2000); see also *Pomerance*, 909 F. Supp. 2d at 296 (citing Evans).
20. *Pomerance*, 909 F. Supp. 2d at 298.
21. *Effie Film v. Murphy*, 932 F. Supp. 2d 538, 554 (S.D.N.Y. 2013), *aff’d*, --- Fed. App’x ---, 2014 WL 1797466 (2d Cir. May 7, 2014) (“In a work of historical fiction, very many elements of a work are drawn from historical events, not from the author’s own creativity. Historical ‘facts’ and interpretations themselves are not copyrightable.”).

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22. *Walker v. Time Life Films*, 784 F.2d 44, 50 (2d Cir. 1986) (“The killing of two police officers actually occurred and was reported in the news media, which placed the historical fact of the murders in the public domain and beyond the scope of copyright protection.”); *see also Wager v. Littell*, 549 F. App’x 32, 34 (2d Cir. 2014) (summary order) (“the two fictional works are set in World War II and focus on the Holocaust and its tragic consequences. Plainly, no author can claim a copyright in such historical themes or in public source material relating to them.”).
23. *Mosley v. Follett*, No. 80 CIV. 5628, 1980 WL 1171, at \*3 (S.D.N.Y. Nov. 5, 1980) (denying motion for preliminary injunction; copyright plaintiff unlikely to succeed on the merits).
24. *Id.*
25. *See 3 Studies in Intelligence* 139-140 (Central Intelligence Agency 1959) (*The Cat and The Mice* “is evidently simplified and embellished for popular consumption, but it has a factual basis and makes good reading.”), available at [http://www.foia.cia.gov/sites/default/files/document\\_conversions/89801/DOC\\_0000607323.pdf](http://www.foia.cia.gov/sites/default/files/document_conversions/89801/DOC_0000607323.pdf).
26. T.S. Eliot, *The Love Song of J. Alfred Prufrock*, Poetry (June 1915).
27. *Feist*, 499 U.S. at 348 (quoting *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 (5th Cir. 1981)).
28. *Craft*, 667 F. Supp. at 123; *see also Lott-Johnson v. Studio 620*, 11-CV-2205, 2011 WL 3468372, at \*2-3 (N.D. Ga. Aug. 8, 2011) (“biographical details . . . are not subject to copyright”).
29. *Hoehling*, 618 F.2d at 978.
30. E.g. Evans, DEFENSE OF HISTORY at 94.
31. James Joyce, ULYSSES at 115 (The Bodley Head 1986).
32. Richard Ellman, JAMES JOYCE (1965) (citing *Ulysses*, personal interview with Irish poet Monk Gibbon, and letters of A.E.).
33. *Pomerance*, 909 F. Supp. 2d at 296.
34. *Howl* (the film) does this as well, screening biographical episodes from Ginsberg’s life as reflected in the poem.
35. Matthew Arnold, *Stanzas from the Grande Chartreuse*, Fraser’s Magazine (April 1855), available at <http://rpo.library.utoronto.ca/poems/stanzas-grande-chartreuse>.
36. *See Nelson v. Grisham*, 942 F. Supp. 649, 656 (1996) (responding to memoirist plaintiff’s concern “that a ruling against her will be a dangerous acknowledgment that those who write their own memoirs cannot expect to receive protection from the copyright laws” by observing that “often in non-fiction work there are many uncopyrightable elements.”).
37. *Hofheinz v. AMC Prods., Inc.*, No. CV-00-5827, 2003 WL 25293919, at \*4 (E.D.N.Y. Apr. 23, 2003) (“a litigant may have any number of reasons for seeking licenses, including to avoid litigation such as this.”).
38. If misled by an author about the representations of a book’s semi-autobiographical nature, however, a publisher can prosecute a fraud claim. *Antidote Int’l Films, Inc. v. Bloomsbury Pub., PLC*, 467 F. Supp. 2d 394, 401 (S.D.N.Y. 2006).

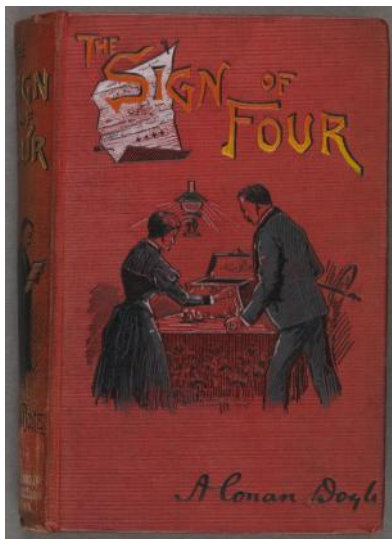
# The World's Greatest Detective and The Public Domain: What Remains of Sherlock Holmes?

By Devereux Chatillon

When a literary creation, a character in a novel, becomes such a part of a culture that understanding references to that character become a sort of shorthand understood by cultural consumers, it creates dilemmas for creators and lawyers.

The most recent case centers around Sherlock Holmes, and, of course, his unavoidable sidekick, Dr. John Watson. The Seventh Circuit recently ruled that the stories of Sir Arthur Conan Doyle are largely in the public domain and not protected by US copyright. [\*Klinger v. Conan Doyle Estate, Ltd.\*](#), 755 F.3d 496, 500-02 (7<sup>th</sup> Cir. June 16, 2014) (Posner, Flaum, Manion, JJ.)

While the decisions are largely unremarkable on their face (although Judge Posner's advisory rant about exploitation and possible antitrust violations by the Conan Doyle estate is a bit eye-opening), how to apply the ruling in the real world is a much more puzzling proposition.



**“How often have I said to you that when you have  
eliminated the impossible, whatever remains,  
however improbable, must be the truth?”**

*The Sign of the Four*, by Sir Arthur Conan Doyle (1890).

The enduring allure of the Sherlock Holmes stories by Sir Arthur Conan Doyle lies at least in part in the extremely logical approach of the main protagonist. Quotations like the one above are so obviously true (and logical) that it's only when they are repeated in what appears to be an impossible situation that the power and novelty appear.

Transforming crime solving into a logic puzzle may not have originated with Sherlock Holmes, but certainly reached a level of perfection in that character. And the character himself, is such a curmudgeon, such an inconsiderate and unfeeling character, that his willingness and ability to solve seemingly insoluble crimes and help people in the process is a fascinating contradiction. And having Watson along, the eternal sidekick for whom everything must be explained, adds a sympathetic character and a stand in for the reader.

But what does this have to do with law and copyright? Only that these characters have been the foundation for the layering of new skins, new situations, new plots and even new millennia by many creative minds. From *Elementary*, a series currently airing on CBS (with a female Watson) to *Sherlock* (a mini-series with the brilliant Benedict Cumberbatch airing in the United States on PBS), to the movies starring Robert Downey Jr. and Jude

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Law, Sherlock is omnipresent. Again, remarkable for such renowned, iconic and dare we say it, old characters - ones that have been around for over a hundred years. What could be the problem?

The problem turned out to be the aggressive licensing program of the Conan Doyle estate meeting Leslie Klinger, editor of an anthology of stories based upon the Sherlock Holmes characters. Because all but ten of the Sherlock Holmes oeuvre were published before 1923 and are therefore in the public domain in the United States, Klinger did not believe that he needed a license from the Conan Doyle Estate to publish his book.

The estate disagreed, arguing that until the last stories enter the public domain in 2022, no copying of the complex characters contained in the Sherlock Holmes stories is allowed, and, according to Klinger threatened his publisher and also threatened to use its influence with distributors to hobble its publication. [Klinger v. Conan Doyle Estate, Ltd.](#), at 500-02. Or, as phrased by the Court of Appeals for the Seventh Circuit, “whether copyright protection of a fictional character can be extended beyond the expiration of the copyright on it because the author altered the character in a subsequent work.” *Id.* at 500.

The court answered with a definitive no: “We cannot find any basis in statute or case law for extending a copyright beyond its expiration. When a story falls into the public domain, story elements—including characters covered by the expired copyright—become fair game for follow-on authors.” *Id.*

The estate had argued that creativity would be discouraged without extending copyright to the latter chunks of an ongoing story with ongoing characters, that the original author would be competing with copiers. The court wryly commented that “Of course this point has no application to the present case, Arthur Conan Doyle having died 84 years ago. More important, extending copyright protection is a two-edged sword from the standpoint of inducing creativity, as it would reduce the inventive of subsequent authors to create derivative works (such as versions of popular fictional characters like Holmes and Watson) by shrinking the public domain.” *Id.* at 501.

The estate argued that the details added to the characters of Holmes and Watson rounded out the characters and that those rounded characters should be protected in their entirety. The court rejected this argument out of hand. It recounted some of the details added in the later stories, that Sherlock has grown to like dogs and that Watson has been married twice. The court said:

These additional features, being (we may assume) “original” in the generous sense that the word bears in copyright law, are protected by the unexpired copyrights on the late stories. But Klinger wants just to copy the Holmes and the Watson of the early stories, the stories no longer under copyright. The Doyle estate tells us that “no workable standard exists to protect the Ten Stories’ incremental characters development apart from protecting the completed characters.” But that would be true only if the early and the late Holmes, and the early and the late Watson, were indistinguishable—and in that case there would be no incremental originality to justify copyright protection of the “rounded”[later] characters (more

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**These characters have been the foundation for the layering of new skins, new situations, new plots and even new millennia by many creative minds.**

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precisely the features that make them “rounder,” as distinct from the features they share with their earlier embodiments) in the later works. *Id.* at 502.

The court concluded that the estate’s appeal bordered on the “quixotic” and raised the “spectre of perpetual, or at least nearly perpetual, copyright” as “the Doyle estate is seeking 135 years (1887-2022) of copyright protection for the character of Sherlock Holmes.” *Id.* at 503. In a later opinion, awarding Klinger his attorneys fees for the appeal, the court used even stronger language: “In effect he [Klinger] was a private attorney general, combating a disreputable business practice—a form of extortion.” *Klinger v. Conan Doyle Estate, Ltd.*, No. 14-1128, at 6 (7<sup>th</sup> Cir., Aug. 4, 2014).

The court then did something remarkable—it opined that what the estate was doing was probably in violation of the antitrust law as it was organizing a boycott of a competitor, Klinger’s anthology, by suppliers of essential services. The court said “It’s time the estate, in its own self-interest, changed its business model.” *Id.* at 7.

In reaching its conclusion, the court’s decision is in line with the few previous cases that have examined this issue. *E.g.*, *Silverman v. CBS*, 870 F.2d 40 (2d. Cir.), *cert. denied*, 492 U.S. 907 (1989); 1-2 *Nimmer on Copyright* §2.12 (“Just as the copyright in a derivative work will not protect public domain portions of an underlying work as incorporated in the derivative work, so copyright in a particular work in a series will not protect the character as contained in such series if the work in the series in which the character first appeared has entered the public domain.”)

### Elementary My Dear Watson?

Sherlock actually never says that in the stories and books, but it sets up nicely the next point—the Seventh Circuit treated this case as a no-brainer. If something is in the public domain, it may be copied, no ifs, ands or buts. But are things really that simple? Let’s look at this from first the perspective of the user and then of the copyright holder.

Having advised clients in this situation, it’s important to keep a few things in mind. First although much of the underlying material, the original Conan Doyle stories and novels, are in the public domain, most of the material based on that material is not. So while *A Scandal in Bohemia*, a short story by Conan Doyle published in 1891, is in the public domain, the episode of the current BBC television show, *A Scandal in Belgravia*, is very much covered by copyright. What is covered by copyright in the television episode is everything and anything new that was added to the original. 4-13 *Nimmer on Copyright* § 13.03[B][2][b].

For example, in the current television series *Sherlock*, Sherlock Holmes uses a cell phone (it will shock no one familiar with the character to learn that Watson and not Holmes is the blogger and user of social media). Does that mean that if I want to write a novel using Holmes as a character and give him a cell phone, I’ve violated the copyright of the television series? While this kind of determination always relies on context, the answer is probably

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**“When a story falls into the public domain, story elements—including characters covered by the expired copyright—become fair game for follow-on authors.”**

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not, if that is the only distinctive characteristic that overlaps with the television series. But as is readily seen, this can become fairly complicated fairly quickly.

So if I wanted to develop a new movie series or television series or webisodes starring Sherlock Holmes, am I restricted to writers who have read only the stories in the public domain, and have never seen the movies or television shows? As that would undoubtedly be impossible, probably not. But it does mean that I would have to review everything carefully to make sure anything original added to the public domain material was not copied from anywhere else. A license from the estate may seem easier (although that of course does not give protection against charges of copying from later creators).

From the copyright holders standpoint, things have become considerably more complicated. While the Seventh Circuit correctly rejected the estate's argument that its ruling was unworkable, how does the estate determine

what's been copied only from the early public domain stories and what uses material from the stories still protected by copyright?

One of the claims made by the estate in the appeal to prove its point that the characters developed over the course of all of Conan Doyle's writings is that Holmes develops a more friendly attitude to dogs in the later stories. So, does that mean that any reference to dogs in my new material might violate the still extant copyrights held by the estate? Only references to Holmes being nice to dogs, but kicking dogs is fair game? What if I change Holmes's animal companions to cats in my script or novel (Holmes seems much more like a cat person anyway)?



**“There is nothing more deceptive than an obvious fact.”**

***The Boscombe Valley Mystery, The Adventures of Sherlock Holmes* by Sir Arthur Conan Doyle (1892).**

In response to the decision, the Conan Doyle estate put out a [press release](#). In the release, the estate correctly sums up the ruling as establishing that “part of Sherlock Holmes’s character is in the public domain.” The release continues, “but the complete Holmes character is still protected by copyright.” The estate’s analysis is that “[t]he court affirmed that the last ten original Sherlock Holmes stories contain the full portrayal of Holmes and Watson, and all character development in those ten stories is protected by the Estate’s copyrights. The protected material includes Holmes’s friendship with Watson, certain of his skills, Holmes’s growing emotion and warmth as a human being.”

While it’s arguable whether Holmes’s friendship with Watson is contained only in those last ten stories (in fact it’s featured in the first stories), the estate’s certainly is continuing its aggressive stance.

And one of the steps taken by the estate in the last few years has been to seek to register the name Sherlock Holmes as a trademark in the United States for movies, for computer games, for internet services, for magazines

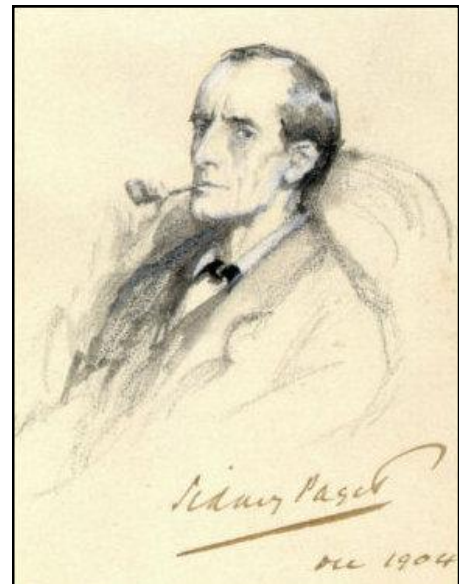
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and books. Could the estate now try to pursue subsequent unlicensed users of the public domain materials under trademark or unfair competition theories?

The estate could try, but if any such user has the temerity and resources to litigate such a claim, the estate has an uphill battle. The courts, including the Supreme Court, have made it clear that trademark law generally cannot be used to extend otherwise expired copyrights. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33-34 (2003). In *Dastar*, the Supreme Court confronted a related issue—the distributor of a public domain video listed itself as a producer and the original producers sued for violations of the Lanham Act. In rejecting that claim, the Court said:

The rights of a patentee or copyright holder are part of a "carefully crafted bargain," under which, once the patent or copyright monopoly has expired, the public may use the invention or work at will and without attribution. Thus, in construing the Lanham Act, we have been "careful to caution against misuse or over-extension" of trademark and related protections into areas traditionally occupied by patent or copyright. "The Lanham Act," we have said, "does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity." Federal trademark law "has no necessary relation to invention or discovery," but rather, by preventing competitors from copying "a source-identifying mark," "reduces the customer's costs of shopping and making purchasing decisions," and "helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product." Assuming for the sake of argument that *Dastar's* representation of itself as the "Producer" of its videos amounted to a representation that it originated the creative work conveyed by the videos, allowing a cause of action under § 43(a) for that representation would create a species of mutant copyright law that limits the public's "federal right to 'copy and to use,'" expired copyrights. (Citations omitted)



*Dastar* did not squarely resolve the issue that would be raised by the scenario here. But if the Conan Doyle estate were to challenge use of the public domain material related to Sherlock Holmes because it claimed that such use violates trademark rights in Sherlock Holmes, it would run straight into the policies articulated by the Supreme Court in *Dastar* and followed by other courts since. *E.g., Comedy III Productions, Inc. v. New Line Cinema*, 200 F.3d 593 (9<sup>th</sup> Cir. 2000); 1-1 *Nimmer on Copyright* § 1.01[D][2].

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Any trademark analysis would turn, at least in part, on the traditional trademark tests of whether the trademark is valid (i.e., used to mark goods or services in commerce) and whether its use by the alleged infringer is likely to cause consumer confusion as to the origin of those goods and services. 1-1 Gilson on Trademarks §§ 1.03[2], 1.05. In addition, courts would look to the policies above about public domain material and also to the expressive nature of the content whose use is being challenged by way of trademark law. *E.g., Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989)(in determining right of publicity and trademark claims brought by Ginger Rogers against a movie entitled “Ginger and Fred”, the court weighed the interest against consumer confusion against the public interest in free expression).

### **Conclusion**

The puzzle of using characters who have survived numerous episodes or stories or installments in subsequent works is not a simple one. To say simply that Sherlock Holmes or any other character is either protected by copyright (in part, that is right) or is in the public domain (and in part that is right) merely begins, but does not end the legal analysis. Given the continuing cultural interest in comic book figures and other similar characters, we can anticipate more legal action in this arena.

*Devereux Chatillon is a partner at Chatillon Weiss LLP in New York and specializes in the area of copyright and trademark counseling; strategic positioning and risk recognition; and litigation advice, including commercial as well as content related.*

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# Legal Databases' Use of Publicly Filed Briefs Is Fair, District Court Rules

## *Transformative Nature of Use Weighs Heavily in Decision*

A New York federal court held that the republication of legal briefs by legal database producers West Publishing (“West”) and Reed Elsevier, Inc. (“Lexis”) is fair use. [White v. West Publishing](#), 12 Civ. 1340 (S.D.N.Y. July 3, 2014) (Rakoff, J.). The court applied Section 107 of the Copyright Act and found that three of the four statutory factors for fair use favored the defendants, with one factor neutral.

### Background

Beginning in 2009, attorney Edward L. White was serving as class counsel in a class action suit in the Western District of Oklahoma. In the middle of the litigation, the judge in that case removed White as class counsel and decertified the class. In an attempt to prevent the use of his work product by other attorneys, White registered copyrights on two of his briefs, “Plaintiffs’ Combined Motion for Summary Judgment, Beer and Ramsey, and Brief in Support” and “Plaintiffs’ Motion in Limine.” Prior to registering copyrights on the two documents, White had filed the briefs using PACER. Filing a document in PACER makes it publicly available.

West and Lexis retrieved the briefs from PACER. After retrieving a document from PACER, West and Lexis convert it into a text-searchable file and save it in each’s proprietary format. Additional alterations include: an editor redacting any sensitive or private information; the categorization of the document by key characteristics such as jurisdiction or practice area; and the insertion of links to cited authorities.

On February 22, 2012, White and Kenneth Elan filed a putative class action against West and Lexis for copyright infringement. In June 2012, after the court had dismissed Elan’s claimed and those of the subclass of plaintiffs who had not registered for copyrights, White filed an amended, non-class action complaint for copyright infringement based on

the inclusion of his copyrighted briefs in West’s and Lexis’ databases. In an order dated February 11, 2013, the court granted defendants’ motion for summary judgment. The July memorandum and order explains that decision and directs the entry of final judgment.

### Fair Use

Judge Rakoff examined the four factors of Section 107 of the Copyright Act in determining that the republication of the briefs in West’s and Lexis’ online databases was fair use.

For the first factor, “purpose and character of the use,” the court found the defendants’ use to be transformative for two reasons. First, Judge Rakoff noted the difference between White’s use of the brief – to provide legal services to his clients and secure specific legal outcomes in litigation – and the defendants’ use – creating an interactive legal research database. Rakoff also found that the defendants’ “processes of reviewing, selecting, converting, coding, linking, and identifying the documents” add something to the point of altering the character of the original briefs. Further,

while the use was commercial, the court found that the transformative nature of the use was enough to outweigh commercialism.

The second factor, “the nature of the copyrighted work,” also cut towards a finding of fair use. The briefs are “functional presentations of fact and law,” making their use more likely to be fair. Additionally, though the briefs were unpublished in some sense, the fact that they were intentionally made available to the public by filing them with the court diminished the relevance of any rationales for protecting unpublished works.

**Even though the defendants use the entirety of plaintiff’s work, “such copying was necessary to make the briefs comprehensively text searchable.”**

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Judge Rakoff found the third factor, “the amount and substantiality of the portion used in relation to the copyrighted work as a whole,” to be neutral. Even though the defendants use the entirety of plaintiff’s work, “such copying was necessary to make the briefs comprehensively text searchable.” Therefore, the court found that the defendants had “only copied what was reasonably necessary for their transformative use.”

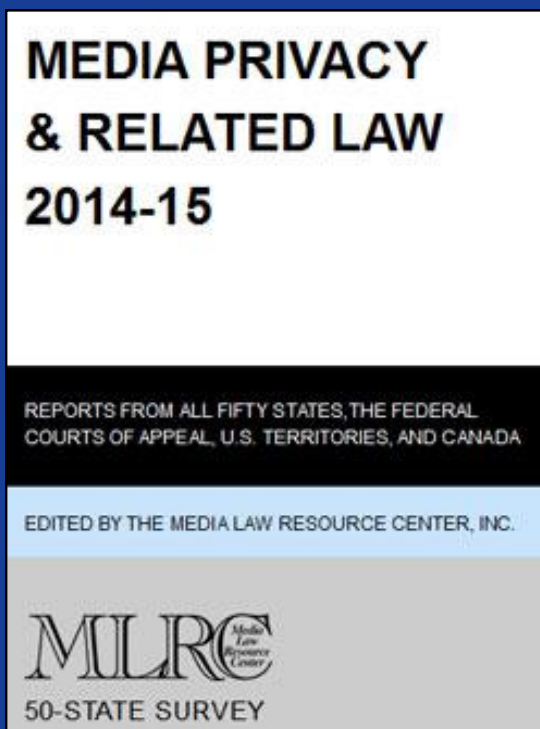
The fourth factor, “the effect of the use upon the potential market for or value of the copyrighted work,” weighed in favor of fair use because “West’s and Lexis’s usage of the briefs is in no way economically a substitute for the use of the

briefs in their original market: the provision of legal service for an attorney’s clients.” Additionally, no one had offered to license or buy plaintiff’s briefs or motions, and plaintiff had not sought to license or sell them.

*Plaintiffs were represented by Gregory A. Blue of Dilworth Paxson LLP, New York, NY, and Raymond A. Bragar of Brager, Wexler Eigel & Squires, P.C., New York, NY. West Publishing was represented by Benjamin Ely Marks, R. Bruce Rich, John Gerba, and Jonathan Bloom, of Weil, Gotshal & Manges, LLP. Reed Elsevier Inc. was represented by James Edward Hough, Cindy Paige Abramson, Craig Brian Whitney, of Morrison & Foerster LLP, New York, NY.*

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# Ninth Circuit Reinstates Rape Victim's Negligence Claim Against Modeling Website

## *Allegation That Website Failed to Warn Not Barred By Section 230*

A Ninth Circuit panel reinstated a negligence claim against a modeling industry website, holding that Section 230 was not applicable to plaintiff's claim because she was not seeking to hold the website liable as a "publisher or speaker" of third party content. *Doe No. 14 v. Internet Brands, Inc.*, No. 12-56638 (9<sup>th</sup> Cir. Sept. 17, 2014) (Schroeder, Clifton, Cogan, JJ.). Instead, the Court reasoned, plaintiff was attempting to hold the website liable for failing to warn her that third parties were targeting and luring victims who appeared on the site.

Plaintiff alleged that two rapists pretending to be talent scouts lured her to a fake audition in Florida where they drugged and raped her to create a pornographic video. She also alleged that the website operator was aware that multiple women had similarly been lured to Florida and victimized but failed to warn her or other users of the site. Defendant specifically denied the allegations, including that the assailants found plaintiff through the website.

The district court dismissed, holding the case was barred by the Communications Decency Act, 47 U.S.C. § 230(c) (2012). The Ninth Circuit panel reversed. The Court took no position on the viability of plaintiff's failure to warn claim, which requires a special relationship between the parties, but held the claim was not within the scope of immunity provided by Section 230.

### Section 230 Analysis

The Court panel explained that in general Section 230 protects websites from liability for material posted on the website by someone else. But here plaintiff "does not seek to hold Internet Brands liable as a 'publisher or speaker' of content someone posted on the Model Mayhem website, or

for Internet Brands' failure to remove content posted on the website."

Plaintiff's failure to warn claim would not require the website to remove any user content or otherwise affect how the site publishes its content. The website would just have to have warned users about what it knew of the rape luring scheme. Such a warning would be defendant's own content and thus would fall outside Section 230. According to the Court:

Jane Doe's failure to warn claim has nothing to do with Internet Brands' efforts, or lack thereof, to edit or remove user generated content. The theory is that Internet Brands should be held liable, based on its knowledge of the rape scheme and its 'special relationship' with users like Jane Doe, for failing to generate its own warning. Liability would not discourage 'Good Samaritan' filtering of third party content. The core policy of section 230(c), reflected in the statute's heading, does not apply, and neither does the CDA's bar.

The Court acknowledged that the website was in some sense an "intermediary" between plaintiff and her assailants as a "but for" cause of her injuries. But "Congress has not provided an all purpose get-out-of-jail-free card for businesses that publish user content on the internet."

*Plaintiff was represented by Jeffrey Herman and Stuart S. Mermelstein, Herman Law, Boca Raton, FL. Defendant was represented by Wendy E. Giberti, iGeneral Counsel, P.C., Beverly Hills, CA; and Patrick Fraioli, Ervin Cohen & Jessup LLP, Beverly Hills, CA.*

**"Congress has not provided an all purpose get-out-of-jail-free card for businesses that publish user content on the internet."**

# Judge Lifts Prior Restraint Barring Newspaper From Reporting On Pipeline Safety Report

## *Restraint Was Erroneously Entered Upon “Phantom” National Security Claims*

By Dennis R. Bailey

On September 23, Alabama Circuit Court Judge Robert C. Vance lifted a temporary restraining order barring the Montgomery Advertiser and Gannett from publishing information contained in a gas pipeline safety report. [\*Alabama Gas Corporation v. The Advertiser Company et al.\*](#) The Judge acknowledged that he erred in granting a TRO by relying on the gas company’s unsubstantiated claims that disclosure could cause terrorism and sabotage.

### Background

In May of this year Kala Kachmar, a reporter for *The Montgomery Advertiser*, made a routine open records request of the Alabama Public Service Commission for the written Distribution Integrity Management Program (DIMP) of Alabama Gas Corporation (“Alagasco”). The [190 page document](#) was emailed from the agency regulating the gas utility to the newspaper reporter in June “With the permission of the National Safety Transportation Board.”

About three months later, on Friday afternoon, September 12, 2014, and with no prior notice to the newspaper, Alagasco obtained an *ex parte* temporary restraining order enjoining the newspaper and Gannett from publishing any “non-public” materials in the DIMP document. In its filings, Alagasco asserted that the DIMP contained proprietary information and was “unlawfully obtained.” But the allegation that caught the attention of Judge Robert Vance of Birmingham was the bald assertion that the DIMP contained information of value to terrorists that if published would harm national security. It was the first time an Alabama newspaper had been subjected to a prior

restraint in the 143-year existence of The Alabama Press Association.

The background facts showed that prior to the issuance of the TRO and after learning the newspaper had been sent the DIMP, Alagasco on July 3, 2014, wrote counsel for the newspaper contending the PSC had improvidently released the DIMP, that it was proprietary, and that Alagasco would appreciate an opportunity to respond to any questions about

the DIMP before publication. As part of a national investigation into pipeline safety by *USA Today*, on August 20, 2014, Kachmar submitted several pointed questions to Alagasco that delved into the existence of old cast iron gas piping in areas served by Alagasco and the propensity for such pipes to leak. Nine days later Alagasco demanded the return of the DIMP and destruction of all emails concerning it by September 3, 2014.

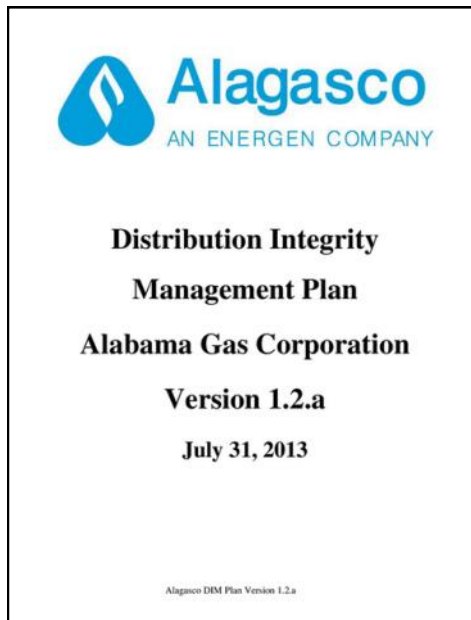
Gannett legal counsel responded on September 9, 2014, that the DIMP contained pipeline leak information that was a matter of public concern and that Gannett would not agree to return it or not publish information contained in it. The letter cited cases quoting the standard required for a prior restraint.

Four days later Alagasco obtained the TRO with a brief which failed to acknowledge the utility was seeking a prior restraint and failing to cite the heavy burden required to obtain a prior restraint.

### Motion to Lift Restraining Order

On Tuesday September 16, 2014, the newspaper filed a motion to dissolve the TRO. [\*Alabama Gas Corporation v. The Advertiser Company et al.\*](#) The motion included three

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basic grounds: (1) The order was an unconstitutional prior restraint on freedom of speech and of the press under the Alabama and U. S. Constitutions; (2) The order failed to comply with Alabama Rule of Civil Procedure 65 and (3) The Birmingham court lacked venue over The Advertiser Company which published the newspaper in Montgomery, Alabama. The venue challenge was eventually overruled by the court.

As part of the constitutional argument, the newspaper asserted that “claims of irreparable harm relating to the release of the report appear to be nothing more than hyperbole.” As support, the newspaper’s motion pointed out that the DIMP was freely released by the regulatory agency in Alabama and was not marked “Secret,” “Confidential” or “Proprietary.” Attached were DIMP reports from other companies which had been easily found on the internet. It was also noted that the rights-of-ways for gas pipelines are recorded in property records, the pipelines themselves are marked with warning signs and the utility will freely mark the precise locations as part of their 811 “Call Before You Dig” program.

Although the utility did not initially specify what information in the DIMP was non-public or sensitive, Alagasco eventually filed a redacted DIMP which removed pages showing the locations of “mains,” the point where large transmission lines feed the smaller distribution lines. However, investigation revealed that one of the three “mains” serving Montgomery was located in a field clearly visible from a major highway, the area was not fenced and the doors to the underground valves did not appear to even be locked.

The next day, September 17, 2014, Alagasco filed a motion “to respond and present evidence” at the hearing for preliminary injunction set for September 25. The newspaper responded the next day and stated:

“The current status quo is not a constitutional status quo. ‘Where the freedom of the press is concerned...the status quo is to publish news promptly that editors decide to publish. A restraining order disturbs the status quo and impinges on the exercise of editorial discretion.’”

“The status quo that has been created by the Temporary Restraining Order is an ongoing violation of freedom of the press. When the United States Supreme Court was petitioned by the *New York Times* and *Washington Post* to challenge judicial orders prohibiting publication of the information from the ‘Top Secret’ Pentagon Papers, the Court addressed the petition on an expedited basis and issued an opinion lifting the prior restraint in six days.”

The response quoted the *Carroll v. Princess Anne* decision which stated that while “[t]here is a place in our jurisprudence for ex parte issuance, without notice, of temporary restraining orders of short duration, but there is no place within the basic freedoms guaranteed by the First Amendment for such orders where no showing is made that it is impossible to serve or notify the opposing parties and to give them an opportunity to participate.”

The opposition concluded:

“It is therefore inexcusable and ironic that the Plaintiff claims it needs more time to have an opportunity to respond and present evidence to support a prior restraint of the press that has already been entered thereby disturbing the constitutional status quo of press freedom in this country.”

That same day, Judge Vance, in response to the motion to dissolve the TRO, set a hearing on that motion for September 22, 2014.

On September 19, 2014, the Alabama PSC released a statement that it released the DIMP because it had not been marked “proprietary” by Alagasco and the burden of doing so rested with the utility.

On September 22, 2014, immediately before the hearing on the motion, Alagasco filed a brief in opposition to the motion to dissolve. In it and at the hearing Alagasco argued that the TRO was not a “prior restraint” because the DIMP was unlawfully obtained by the newspaper. They argued that

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**The allegation that caught the attention of Judge Robert Vance of Birmingham was the bald assertion that the DIMP contained information of value to terrorists that if published would harm national security.**

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a regulation of the PSC required the newspaper to notify Alagasco that it was requesting the DIMP from the PSC before the DIMP was released. *The Advertiser's* failure to do so, Alagasco argued, took the matter out of the realm of "prior restraint" protection because prior restraint cases only protected lawfully obtained information.

Judge Vance immediately challenged that argument and referenced the Pentagon Papers decision where the top secret papers were apparently unlawfully leaked. Alagasco responded that the newspapers had done nothing wrong in that situation but that in this case, *The Montgomery Advertiser* had acted unlawfully by failing to submit the proper paperwork to Alagasco so that the utility could have objected to the release of the DIMP before it was turned over by the PSC.

Counsel for the newspaper made several arguments in response. The paper argued that the case did involve a prior restraint and that prior restraint cases were very rare by constitutional design. They pointed out that no Alabama appellate decision had ever upheld a prior restraint because Alabama's Constitution has broader protection for free expression than the U. S. Constitution and prohibits prior restraint of freedom of speech. In addition to the First Amendment's protection of freedom of speech and the press, the Alabama Constitution provides that "any person may speak, write, and publish his sentiments on all subjects, being responsible for the abuse of that liberty."

As an alternative, counsel argued that under federal authority prior restraints are allowed but only if there are specific facts presented that establish the publication will inevitably, directly and immediately harm a state interest of the highest order and that the government's interest is so great, so grave and so certain that it cannot be protected by any means other than a prior restraint. Counsel also argued that the TRO had procedural problems because it did not maintain the status quo of a free press deciding what and when to publish, that it was issued ex parte without notice in violation of Rule 65 and the *Carroll v. Princess Ann* decision and that the prohibition against publishing "non-public" information in the report was too vague.

But the main argument was focused on the fact that the filings of Alagasco failed to provide a single fact establishing

that the release of the DIMP presented a clear and present danger to national security. Furthermore, the actions of Alagasco, the PSC and NTSB in handling the DIMP were not consistent with that of entities handling a highly-sensitive document. It was not marked confidential, it was released by regulators of the industry familiar with its contents and after release it took Alagasco months to request its return which, perhaps not coincidentally, was just after Alagasco received pointed questions about its use of old cast iron pipes. To allay the judge's fears, counsel also argued that the location of pipelines is in the public domain.

As for the "unlawfully obtained" document argument, the newspaper argued that it was irrelevant whether or not the paper obtained the document legally. The only focus should be on whether publication of it presented a clear and present danger to national security.

To Judge Vance's credit, during the argument he took responsibility for entering the order without notice but pointed out that the affidavit supplied stated that publication of the report was "imminent." He promised a ruling by noon the next day because, as he stated, each day that passed was a further potential infringement on free expression.

Early the next morning, the newspaper responded to the brief filed at the hearing citing cases supporting the argument that even if the newspaper committed acts that were improper to obtain a document prior restraint standards still must be met. Shortly thereafter Alagasco released on its website a redacted version of the DIMP containing 173pages.

It also filed a "Motion to Clarify" the TRO by specifying the parts of the DIMP that could not be released and which parts could. Essentially, the Alagasco version redacted the location of records, the names of employees and removed 17 pages describing the distribution pipeline system and the general locations of gas mains.

Then, at 8:31 a.m., Judge Vance issued his order dissolving the TRO adding his own personal touch to prior restraint law. Primarily relying upon *CBS, Inc. v. Davis*, 510 U.S. 1315 (1994), Judge Vance cited the test that the "evil that would result from the reportage is both great and certain and cannot be mitigated by less intrusive measures." Then he stated, in his own words:

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**The newspaper asserted that "claims of irreparable harm relating to the release of the report appear to be nothing more than hyperbole."**

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“At this stage, the court cannot see such a clear and present danger. In its motion for a temporary restraining order, the plaintiff raised the danger of terrorism and sabotage if data within its Distribution Integrity Management Plan were publicly disclosed. While such possibilities might exist, they now appear to be only vague phantoms. On reflection, the court finds that it too readily focused on such ghosts in entering the Temporary Restraining Order sought by the Plaintiff.”

The day the order dissolving the TRO was entered, *USA Today* published its feature on national pipeline safety that months earlier had been the reason reporter Kachmar had made the original request. Linked in the on-line version was the complete 190-page Alagasco DIMP provided to Kachmar

by the Alabama PSC with only the names of Alagasco employees redacted. The article reported that a gas leak in Birmingham had, just months before, caused an explosion and death. It was believed the cause was a collapsed cast iron pipe.

Once the DIMP was published, Alagasco issued a strident press release critical of *USA Today* and stating that the media organization had rendered their fight to protect the DIMP document from falling into the hands of the public moot. Within minutes, Alagasco voluntarily dismissed their case and Judge Vance entered an order confirming the dismissal. The question of the safety of miles of cast iron pipes was now a matter for editors to publish without fear of the censorship that is politely called “prior restraint.”

*Dennis R. Bailey, a partner with Rushton, Stakely, Johnston & Garrett in Montgomery, AL, represented the newspaper and Gannett in this case.*



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520 Eighth Ave., North Tower, 20 Fl., New York, NY 10018  
[www.medialaw.org](http://www.medialaw.org) | [medialaw@medialaw.org](mailto:medialaw@medialaw.org)

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# Texas Court Strikes “Improper Photography” Statute as Facially Unconstitutional

By Grayson McDaniel

Analysis on Appeal

On September 17, 2014, in an 8-1 ruling, the Texas Court of Criminal Appeals struck down as facially unconstitutional the state’s improper photography statute. [Ex Parte Thompson](#).

## Background

On July 6, 2011, Ronald Thompson was arrested after he was caught recording women in bikinis without their consent. *Ex Parte Thompson*, 414 S.W.3d 872, 874 (Tex. App.—San Antonio 2013, pet. granted). Thompson was charged with twenty-six counts of improper photography or visual recording in violation of section 21.15(b)(1) of the Texas Penal Code, commonly known as the “improper photography” statute, which provides:

A person commits an offense if the person: (1) photographs or by videotape or other electronic means records, broadcasts, or transmits a visual image of another at a location that is not a bathroom or private dressing room: (A) without the other person’s consent; and (B) with intent to arouse or gratify the sexual desire of any person.

**The Court began its analysis by holding that photography is “inherently expressive,” and as such always falls under First Amendment protection, despite the State’s argument to the contrary.**

[TEX. PENAL CODE § 21.15\(b\)\(1\)](#).

Thompson filed a pre-trial writ of habeas corpus, arguing that the improper photography statute impermissibly regulated the content of speech and was both overbroad and vague, in violation of the First Amendment and Article I, Section 8 of the Texas Constitution. The Bexar County District Court denied his petition on the merits. Thompson appealed the decision, and the San Antonio Court of Appeals reversed, holding that the improper photography statute was facially unconstitutional.

The San Antonio Court of Appeals stated that the improper photography statute regulated the ability to take photographs, a constitutionally protected right, as well as an individual’s thoughts. *Thompson*, 414 S.W.3d at 877 (noting that by referencing a perpetrator’s “intent to arouse or gratify . . . sexual desires,” the statute “also restricts a person’s thoughts, which the U.S. Supreme Court has held is wholly inconsistent with the philosophy of the First Amendment” (internal quotation marks and citation omitted)).

The court analyzed the statute under intermediate scrutiny, deciding that it regulated photography in a content-neutral manner, “not favor[ing] one type of photograph over another.” *Thompson*, 414 S.W.3d at 878 (citing *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 642 (1994)). The court then held the statute to be impermissibly overbroad because it criminalized photographing or recording people in public, where they have no reasonable expectation of privacy.

The court concluded that section 21.15(b)(1) was void on its face and remanded to the trial court to enter an order dismissing all charges against Thompson on alleged violations of the statute. *Id.* at 881.

## Analysis on Discretionary Review

The Texas Court of Criminal Appeals granted discretionary review of Thompson’s case on November 27, 2013. Briefing was complete in early 2014 and the court heard oral argument on May 7, 2014, with Thompson giving some of his argument time to law professor Eugene Volokh, who represented amicus Reporters Committee for Freedom of the Press. On September 17, 2014, in an 8-1 ruling, the Texas Court of Criminal Appeals affirmed the Court of Appeals, striking down the improper photography statute as

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unconstitutional. Justice Keller authored the opinion. Justice Meyers dissented.

The Court began its analysis by holding that photography is “inherently expressive,” and as such always falls under First Amendment protection, despite the State’s argument to the contrary. *Ex Parte Thompson*, No. PD-1371-13, slip op. at 9, 12 (Tex. Crim. App. Sept. 17, 2014) (citing *Kaplan v. Calif.*, 413 U.S. 115, 119 (1973)). The act of taking a photograph—the “purposeful creation” of a protected form of expression—is also entitled to the same First Amendment protection as the photograph itself, the Court held. *Id.* at 14.

The State argued that the improper photography statute did not regulate protected content. It posited that because the statute’s specific intent element—only regulating photographs taken with the “intent to arouse or gratify ... sexual desire”—transformed it from a statute that regulated photography to one that regulated intent. *Id.* at 4 (describing the state’s argument that the statute merely “regulates a person’s intent in creating a visual record and not the contents of the record itself.”).

The Court rejected this argument, noting a prior holding that regulation of actions taken with specific intent to arouse or gratify sexual desire was not removed from First Amendment protection. *Id.* at 15-16 (citing *Ex Parte Lo*, 424 S.W.3d 10, 25-26 (Tex. Crim. App. 2013)).

The State then argued that the improper photography statute did not regulate protected speech because it only regulated photographs taken “without ... consent.” *Id.* at 4-5. The State contended that individuals consent to have anything they show or do in public photographed or recorded, and that the statute therefore only regulates photography of non-public content. Under the State’s theory, a photograph taken of a woman dancing in public would be taken with her implicit consent. It would not fall under the improper photography statute even if it was taken with the intent to arouse or gratify sexual desire. A photograph taken up a woman’s skirt at what was not publicly visible, however, would not be taken with the subject’s implicit consent and would be regulated by the statute.

The Court disagreed with the State’s underlying theory, that individuals implicitly consent to be photographed in public. Defining “consent” in this way, the Court reasoned, would give the word a different meaning than it has in other legislation, such as another part of the Texas Penal Code,

where it is defined as “assent in fact, whether express or apparent.” TEX. PENAL CODE § 1.07(a)(11). The Court stated that it was not the judiciary’s place to unilaterally broaden the definition of “consent.” *Thompson*, slip op. at 20-21.

The Court, having determined that Thompson’s conduct (a) was subject to First Amendment protection and (b) was regulated under the improper photography statute, turned next to the improper photography statute’s constitutionality.

Contrary to the Court of Appeals, which held that the statute was content-neutral and subject to intermediate scrutiny, the Court of Criminal Appeals determined that the regulations imposed by the statute were content-based and thus subject to strict scrutiny. *Id.* at 32. The Court’s analysis stemmed from the point made by *amici* that the improper photography statute regulates photography “of another.” TEX. PENAL CODE § 21.15(b)(1) (emphasis added). The Court decided that “another” meant that only photographs of people fall under the statute, not photographs of non-human content. The statute also “favored one type of photograph over another” because it only regulated photography of another taken with the specific intent to arouse or gratify sexual desire.

Content-based regulations, the Court stated, are “presumptively invalid” and rarely permissible. *Id.* at 33 (citing *Sorrell v. IMS Health*, 131 S. Ct. 2653, 2667 (2011)). The State’s asserted interest in protecting the privacy of the individuals photographed was, the Court stated, substantial, but was misplaced, as the statute regulated a much broader swath of conduct than would be needed to satisfy privacy concerns. The provision thus failed to satisfy strict scrutiny.

As a final measure, the Court addressed whether the statute was so overbroad as to be facially invalid. Describing the statute’s breadth as “alarming” and “breathtaking,” the Court held that it was, and affirmed the Court of Appeals’ decision that section 21.15(b)(1) was void on its face.

Justice Meyers dissented from the judgment, but did not write separately.

*Grayson McDaniel is an associate at Vinson & Elkins in Austin, TX. Defendant was represented by Donald H. Flanary III, Goldstein, Goldstein & Hilley, San Antonio, TX. The Reporters Committee for the Freedom of the Press filed an [amicus brief](#) arguing that the Texas statute was an impermissible content-based restriction on constitutionally protected speech.*

## Federal FOIA Reform Bill to Narrow Deliberative Process Privilege Introduced

Bipartisan legislation has been introduced in the U.S. Senate to curb the alleged abuse of the exemption to the Freedom of Information Act for documents that are exempt from discovery in civil and criminal litigation. Freedom-of-information advocates have called the 5 U.S.C. § 552(b)(5) exemption the “[withhold it because you want to](#)” exemption.

Senator Patrick Leahy, D-Vermont, along with Senator Jon Cornyn, R-Texas, have introduced the “[FOIA Improvement Act of 2014](#).” The senators’ proposal would create a public-interest balancing test for information agencies want to exclude from disclosure under Exemption 5. The test would mandate disclosure when the public interest in disclosure outweighs the agency’s interest in protecting records governed by the deliberative process privilege or the attorney work-product privilege. The balancing test would be more stringent for information protected by the attorney-client privilege: a compelling public interest in disclosure would have to outweigh the agency’s interest in nondisclosure.

The bill also would limit the application of the Exemption 5 to documents created more than 25 years ago. Federal agencies have used the exemption to withhold records created over 40 years ago or more, Politico [reports](#).

The bill also would codify a presumption of openness for government information, mandating that agencies only withhold information if the law prohibits disclosure or if it is reasonably foreseeable that disclosure would cause specific identifiable harm to an interest protected by a FOIA exemption.

The bill also clarifies that federal agencies are barred from charging search or duplication fees when they have not met the time limits for responding to FOIA requests or met the notice requirements of FOIA.

Open-government advocates [hope](#) the legislation will be passed in the Senate and could be reconciled in conference with FOIA reform [legislation](#) that was passed by the House of Representatives this past winter.

## MLRC UPCOMING EVENTS

### MLRC/NAA/NAB Media Law Conference

September 17-19, 2014 | Reston, VA

### MLRC Annual Dinner

November 12, 2014 | New York, NY

### DCS Annual Lunch & Meeting

November 13, 2014 | New York, NY

### MLRC/Southwestern Entertainment and Media Law Conference

January 15, 2015 | Los Angeles, CA

# Detroit Free Press Continues Mug Shot Battle in Sixth Circuit

## *DoJ Seeks En Banc Review to Overturn Circuit Precedent*

By **Herschel P. Fink and Paul R. McAdoo**

The long-running battle in the Sixth Circuit for access to mug shots under federal FOIA moved forward in July, with briefing being completed on whether the issue is of sufficient importance to warrant initial en banc consideration. See, e.g., [\*Detroit Free Press, Inc. v. U.S. Dept. Justice\*](#), No. 14-1670 (brief in opposition to rehearing en banc). The availability of mug shots under federal FOIA has been hotly contested in the Sixth Circuit for 20 years, with the Detroit Free Press having won repeated skirmishes against the U.S. Department of Justice and its Marshals Service.

In 1996 the Free Press won a decision in the Sixth Circuit affirming a district court opinion in a 1994 case, which held that persons currently charged with federal crimes, who had already appeared in court, had no privacy interest under federal FOIA in the release of their mug shots. Following contrary decisions in the 10<sup>th</sup> and 11<sup>th</sup> circuits in 2011 and 2012, the DOJ unilaterally decided in December, 2012 that it was free to ignore the Free Press precedent in the Sixth Circuit. The paper sued again last year, and won summary judgment in the Eastern District of Michigan earlier this year. The district court held that the 1996 appellate decision continued to control in the Sixth Circuit.

The DOJ appealed, and in June filed a petition for initial en banc consideration, notwithstanding that the Sixth Circuit had rejected en banc rehearing in 1996. On July 1, the Sixth Circuit requested a response from the Free Press, which it filed on July 12. In its response, the newspaper argued that the issue of whether any privacy interest attached to mug shots of persons currently being prosecuted, while of importance to the newspaper, nonetheless failed to rise to the level of “a question of exceptional importance” under the high bar set by FRAP 35, such that it would merit initial en

banc review, and that the mere fact that two circuits had recently disagreed with long-standing Sixth Circuit precedent was also insufficient reason.

The issue remains under consideration, and merits briefing has been suspended pending a decision.

This was not the first time that the DOJ had unilaterally refused to honor the Sixth Circuit precedent. In 2005 it claimed that an off-point Supreme Court ruling on the FOIA privacy exception was new justification to stop honoring mug shot FOIA requests. The Free Press sued again in the Eastern

District, and the DOJ, in response, abruptly withdrew its newly revised mug shot policy, and declared that it would again honor requests in the districts of the Sixth Circuit. It also claimed that the Free Press’ suit should be dismissed as moot. The district court agreed that it was moot, but nonetheless found that the suit had caused the change of policy, and awarded the

newspaper its attorney fees. A similar suit was also filed at that time by the Akron Beacon Journal in the Northern District of Ohio. The judge there refused to dismiss that suit, and awarded summary judgment to the newspaper, as well as attorney fees. There was no appeal by the DOJ back in 2005.

The pending Sixth Circuit appeal is being closely followed by news organization, as the DOJ has declared that it intends to carry its battle to the Supreme Court, should the Sixth Circuit decide not to disturb its precedent. The DOJ chose in 1996 not to challenge the Sixth Circuit’s en banc refusal in the Supreme Court. It also actively opposed certiorari review by the Supreme Court to resolve the Circuit split in the recent 11<sup>th</sup> Circuit case of *Karantalis v. Dep’t of Justice*, 635 F.3d 497 (11<sup>th</sup> Cir. 2011).

*Detroit Free Press is being represented by Herschel P. Fink, its Legal Counsel, of Detroit, who also represented the paper in the 1994 and 2005 cases, and Paul R. McAdoo,*

**The availability of  
mug shots under federal  
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Circuit for 20 years.**

# Presidential Privacy, CIA Records and Other Access Cases of Note

Former President George W. Bush and Vice President Dick Cheney have a privacy interest in their personal-research requests for archived Administration materials that outweighs the public interest in disclosure, the Second Circuit has ruled. [Cook v. National Archives & Records Admin.](#), No. 13-1228-cv (2d Cir. July 8, 2014) (Leval, Pooler, Chin, JJ.)

## Background

Reporter John Cook filed a FOIA suit against the National Archives & Records Administration to obtain Bush and Cheney's own record requests for their archived materials during the time those records were not yet publicly available.

Judge Denny Chin, writing for the panel, applied Exemption 6 to the Freedom of Information Act for personnel, medical and similar files "the disclosure of which would constitute a clearly unwarranted invasion of personal privacy."

The revelation of Bush's and Cheney's requests for archived materials would "reveal personal details—what they were thinking, considering, and planning as they transitioned back to private life after their years of service to the country ... The former officials have a significant interest in developing their ideas privately, free from unwanted public scrutiny," Chin wrote.

Chin also noted that archivists and librarians tend to have a policy against disclosing which materials requesting parties have sought, and that all 50 states and the District of Columbia protect the confidentiality of borrowers' use of public library materials.

In addition, disclosure of Bush and Cheney's record requests would not shed much light on how the National Archives responds to special access requests from former high ranking officials, Chin added. Thus Bush's and Cheney's privacy interests outweigh the public interest in disclosure.

**The former officials have a significant interest in developing their ideas privately, free from unwanted public scrutiny," Chin wrote.**

## Deliberate Process Privilege Protects CIA History

A divided D.C. Court of Appeals, 2-1, ruled this spring that the deliberative process privilege shields from public disclosure the fifth volume of the CIA's internal history of the Bay of Pigs fiasco and failed effort to oust Fidel Castro in the 1960's. [National Security Archive v. Central Intelligence Agency](#), No. 12-5201 (D.C. Cir. May 2014). Exemption 5 to FOIA protects the privileges the government could assert in civil litigation, including the deliberative process privilege for pre-decisional communications.

Even though four previous volumes authored by CIA Staff Historian Jack B. Pfeiffer have been released, Circuit Court Judge Brett M. Kavanaugh, writing the majority opinion, said that the draft of the fifth volume "is still a draft and thus still pre-decision and deliberative."

Among other things, the majority rejected the argument that the passage of time renders the due process privilege inapplicable to the Bay of Pigs history. "Premature release of privileged information would risk embarrassment of individuals who had put forth certain ideas on the understanding and assurance that the communications would remain confidential," Kavanaugh said.

In dissent, Circuit Judge Judith W. Rogers said there should not be a per se rule of Exemption 5 protection for draft agency histories. Instead, Rogers would have remanded for further proceedings requiring the CIA to demonstrate the deliberative process privilege would shield from disclosure a draft history about events that occurred fifty years ago. Rogers also wanted consideration of whether the passage of time affects the application of the exemption.

## California: Personal Devices & Public Records

The California Supreme Court has granted a petition for review on an issue of first impression: does the California

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Public Records Act apply to “written communications pertaining to city business, including email and text messages, which (a) are sent or received by public officials and employees on their private electronic devices using their private accounts, (b) are not stored on city servers, and (c) are not directly accessible by the city?” [City of San Jose v. Superior Court](#), S218066 (Cal. June 23, 2014).

The plaintiff sought to obtain all voicemails, emails or text messages sent or received on private electronic devices owned by the city of San Jose’s elected officials from a former mayor involved in downtown development.

The Court of Appeal, Sixth Appellate District, found that the state Records Act cannot be construed to impose the duty on a governmental agency to produce governmental-related information stored on personal electronic devices and accounts of elected officials and public-sector employees.

The lawyers for the plaintiff said in their petition for review that the intermediate appellate court “has provided a roadmap for government officials to keep significant or controversial documents hidden from the public eye. If it remains unchallenged, this roadmap will have statewide impact on the public’s constitutionally protected right to receive information about government activities.” Also at issue, for example, is a lobbyist attempting to influence votes on legislation.

**A business improvement district is a governmental agency subject to the New Jersey Open Public Records Act.**

### California: Access to On-Duty Police Officer Shootings

The California Supreme Court, 6-1, has ruled that the names of Long Beach police officers involved in shootings while on duty can be disclosed to the *Los Angeles Times*. [Long Beach Police Officers Association v. Long Beach](#), No. S200872 (Ca. May 29, 2014). The city and the union for the city’s police officers argued the officers’ names should not be disclosed because the officers and their families could face threats of violence.

The majority drew a distinction between disclosing the names of officers if linked to information in personnel records, including records generated from internal investigations, and from disclosing the names of officers if linked to records of factual information about an incident. “The particularized showing necessary to outweigh the public’s interest in disclosure was not made here, where the

union and the city relied on only a few vaguely worded declarations making only general assertions about the risks officers face after a shooting,” Retired Associate Justice Joyce L. Kennard wrote for the majority.

The court added that the names of officers do not have to be disclosed in every case and that further proceedings might show that the officers’ privacy and safety interests outweigh the public’s interest in access to public records.

### Colorado

Parties who prevail on their appeals after being denied access to public records are mandatorily entitled to costs and reasonable attorney fees, the Colorado Supreme Court, 5-2, ruled. [Benefield v. Colorado Republican Party](#), No. 11SC935 (Colo. June 30, 2014). The Colorado Republican Party sought access to surveys conducted by members of the Colorado House of Representatives of constituents.

The Colorado District Court interpreted “prevailing applicant” to mean a requester who prevails in litigation as a whole, while the Colorado Court of Appeals interpreted it to mean “any applicant who succeeds in acquiring, as the result of filing an application with the district court,” access to a record to which a records custodian denied access.

The majority of the Supreme Court agreed that an award of costs and attorney fees is mandated “in favor of any person” who obtains a district court order requiring access to public records. District courts, however, should only award the proportion of attorney fees and costs that are related to the records to which requesters actually win access, the majority said.

In dissent, Chief Justice Nancy E. Rice said she would hold trial courts have the discretion to consider whether requesters have prevailed on a “significant issue.” Otherwise, government agencies will be forced to litigate court costs and attorney fees any time access is denied to “a single record, regardless of how many records were requested and properly denied.”

### Connecticut

In a case of first impression, the Connecticut Supreme Court has ruled that state’s Freedom of Information Act does

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not compel law enforcement agencies to release full arrest reports while prosecutions are pending. [Commissioner of Public Safety v. Freedom of Information Commission](#), SC 19047 (Conn. July 15, 2014). Instead, law enforcement agencies are only obliged to release the name and address of the arrestee, the date, time and place of the arrest, the offense for which the person was arrested and one other piece of information: the arrest report, incident report, news release or other “similar report” of the arrest.

Justice Richard A. Robinson, writing for the court, said the freedom of information law is ambiguous but the history of the legislative debate showed the law was amended specifically to allow law enforcement agencies to utilize alternatives means of providing narratives of arrests besides full arrest reports.

### New Jersey

A business improvement district is a governmental agency subject to the New Jersey Open Public Records Act, the New Jersey Superior Court, Appellate Division, found in an unpublished decision. [Kennedy v. Montclair Center Corporation Business Improvement District](#), 2014 N.J. Super. Unpub. LEXIS 1654 (N.J. Super. App. Div. June 24, 2014).

The Montclair Center Corporation, a non-profit formed to manage the Montclair Center Special Improvement district, argued it is not a public agency because it was created by private individuals. But the appellate court disagreed, finding that the Montclair Township Council adopted an ordinance in 2002 to create the MCC.

The court cited several more reasons for why the MCC is a public agency: the MCC also is funded by more than \$460,000 in special assessments imposed on property owners in the central business district and the Township Council may approve or disapprove the MCC’s budget. The Township Council has the power to terminate the MCC and the MCC provides traditional public functions such as sanitation and security.

### Pennsylvania

In a case of first impression, the Pennsylvania

Commonwealth Court has ruled that the frontline agency for open-records appeals, the Office of Open Records, has the implied authority to conduct in camera reviews of documents to determine if they are exempt from disclosure because of the attorney-client privilege or the attorney work-product doctrine. [Commonwealth of Pennsylvania v. Center Township](#), No. 522 M.D. 2013 (Pa. Cmmw. June 24, 2014).

The township, which redacted portions of four month’s of attorney invoices that allegedly reference litigation services, argued that the Office of Open Records does not have jurisdiction to determine whether the attorney-client privilege or work-product doctrine applies to governmental records. Otherwise, the office would intrude upon the Pennsylvania Supreme Court’s exclusive power to regulate the practice of law.

The appellate court drew a distinction between having the authority to order the disclosure of government documents that implicate the practice of law and having the power to review whether requested governmental documents are covered by the attorney-client privilege, the work-product doctrine, or the ethics-based rule of confidentiality.

The court also held that the agency has the implied authority to conduct in camera reviews of records to determine whether evidentiary privileges apply to them. “In some instances, in camera review may be the only way that an appeal officer can assess, in a meaningful fashion, whether an agency has

met its burden of proving that a document is privileged by a preponderance of the evidence,” Judge Patricia A. McCullough wrote for the court.

### South Carolina

The South Carolina Supreme Court held that autopsy reports are “medical records” outside the scope of the state’s Freedom of Information Act. [Perry and Osteen Publishing v. Bullock](#), No. 2012-212669 (July 16, 2014). A reporter had sought the autopsy report issued in connection with a police shooting. The state FOI Act exempts from disclosure “medical records” but does not define the term. The Court held that “autopsy reports fit neatly with the general understanding of medical records.”

This result was consistent with long standing policy of the state Attorney General’s office that autopsy reports were

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**Autopsy reports are  
“medical records”  
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state’s Freedom of  
Information Act.**

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exempt medical records. A dissenting judge argued that autopsy reports should not be categorically exempt from disclosure, but could be released subject to redaction if necessary.

In a case of first impression, the South Carolina Supreme Court held that state's Freedom of Information Act is not violated by governmental meeting agendas being amended

during the middle of meetings. [Lambries v. Saluda City Council](#), No 27400 (S.C. June 18, 2014).

South Carolina's FOIA does not require agendas for regularly scheduled meetings nor prohibit the amendment of agendas for a regularly schedule meeting, Acting Justice James E. Moore said. "We find this is also the better public policy in light of the fact that a violation of FOIA can carry a criminal penalty," Moore added.

## MLRC UPCOMING EVENTS

### MLRC Annual Dinner

November 12, 2014 | New York, NY

### DCS Annual Lunch & Meeting

November 13, 2014 | New York, NY

### MLRC/Southwestern Entertainment and Media Law Conference

January 15, 2015 | Los Angeles, CA

### Legal Frontiers in Digital Media

May 14-15, 2015 | Palo Alto, CA

### MLRC London Conference

September 28-29, 2015 | London England