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AIDING AND ABETTING IN TORTURE: CAN THE ORCHESTRATORS OF TORTURE BE HELD LIABLE?

Cora Lee Allen*

“*The United States must continue its vigorous efforts to bring the practice of torture and other gross abuses of human rights to an end wherever they occur... In this new era, in which countries throughout the world are turning to democratic institutions and the rule of law, we must maintain and strengthen our commitment to ensuring that human rights are respected everywhere.”

- George H.W. Bush

I. INTRODUCTION

Can the children of a slain banana farmer recover in U.S. Courts against the multi-million-dollar American corporation convicted of funding and providing AK-47s to a paramilitary group, listed as a Foreign Terrorist Organization, who murdered their father? Can Chinese citizens recover against the American computer-programming corporation Cisco that understood that it was enabling the Chinese government to surveil its own citizens and persecute them for their religious beliefs?

The Torture Victim’s Protection Act (“TVPA”) is meant to do what its title suggests, give redress to those who have been injured through torture by allowing victims of certain international law violations, or their representatives, to bring a civil action against those responsible in United States federal district court after being properly served in the United States. However, it is rarely those who perform the torture directly that have claims brought against them. Those who perform the torture directly are often unknown, untraceable, are victims of torture themselves and will never be able to be served in the United States.

Many human rights advocates believe that those who enable and fund torture can and should be held accountable under the TVPA through the theory

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of aiding and abetting; however, this theory of liability has not yet been spoken to directly by the United States Supreme Court. The refusal of the court to answer this question has led to a split among federal circuit courts. This article submits that the TVPA and its companion statute, the Alien Tort Statute § 1350 (also called the Alien Tort Claims Act “ATCA”) allow for, and were meant to encompass aiding and abetting liability. These intentions are seen plainly in the terms and notes of the TVPA, which contemplate claims based on indirect theories of liability. This article will discuss the statutes plain language as well as the clear inferences of intent that can be drawn from the legislative histories of the respective statutes. It will begin with a brief history of the Alien Tort Statute (“ATS”) and how its sister statute, the TVPA, came about, as well as an explanation for how the two work together. From there the current circuit split as to aiding and abetting liability will be discussed, and finally, the article submits the multi-factor test enumerated in In Re Chiquita Brands that should be used when analyzing aiding and abetting liability.

A. The History of the ATS

Enacted in 1789, the ATS is a one sentence long statute that reads: “The district courts shall have original jurisdiction of any civil action by an alien for a tort only, committed in violation of the Law of Nations or a treaty of the United States.” The ATS was enacted as part of the First Judiciary Act, which established and set the structure for federal courts and conferred jurisdiction. For almost 200 years the ambiguous statute was essentially unused with one prominent legal scholar, Judge Henry Friendly describing it in 1975 as being a “legal Lohengrin; although it has been with us since the first Judiciary Act ... no one seems to know whence it came.”

In 1980, though, the statute took on a new life in Filartiga v. Pena-Irala, when the Second Circuit Court of Appeals read the statute to allow jurisdiction in an action between non-U.S. citizens for violations of customary international law.


law. Filartiga involved the kidnapping, torture, and eventual murder of a Paraguayan teen in retaliation for his father’s human rights activism. The man who conducted the torture, also a Paraguayan, Americo Norberto Pena-Irala, the Inspector General of Police in Asuncion, Paraguay fled to the United States after a criminal case was brought against him. The victim’s sister who was living in Washington D.C. on a visitor’s visa at the time (she later applied for permanent political asylum) was able to serve Pena and bring the action against him. The court held that whenever an alleged torturer was found and served within the United States, jurisdiction was proper under the ATS if the action was brought by an alien for a tort involving a violation of the law of nations, in this case, official torture. Each of the plaintiffs in Filartiga was awarded five million dollars in punitive damages and the defendant was deported. The court reasoned that this comported with Article III of the constitution because it the laws of nations have always been a part of the common law of the United States, thus, suits brought under the ATS do actually arise under the laws of the United States.

After it was brought out of hibernation in Filartiga, the ATS was the basis for a stream of claims for human rights abuses. The decision prompted debate from legal circles, and started a firestorm of law review articles. The ability to provide recourse to the victims of some of the worst atrocities committed on humanity in American courts was a source of pride for many human rights advocates. At first the claims were focused on individual persons who committed abuse on foreign lands. However, many of these cases ended up as default judgements against foreign defendants that would never be enforced.

The problem of default judgements was discussed in Xuncax v. Gramajo, a case involving allegations against the former defense minister of Guatemala (who at the time of the suit was attending Harvard University but refused to mount a defense to the charges) by indigenous Guatemalans for a multitude of brutal human rights abuses including torture and murder: “Answering [the] questions [before the court] has been made extraordinarily difficult because, while plaintiffs’ contentions have been presented with exceptional skill by

7. Filartiga v. Pena-Irala, 630 F.2d 876 (2d Cir. 1980).
8. Id. at *878
9. Id. at 855.
exceedingly competent counsel, defendant has offered no defense.” The court also remarked that “extended consideration [was] necessary to explore without adversarial assistance - the potential defenses available.”¹¹ Gramajo eventually graduated from Harvard, moved back to Guatemala and continued his refusal to cooperate with the courts.¹²

In the two decades after Filartiga, though most of the plaintiffs in ATS litigation were unable to recover by way of damages, human rights advocates still saw vindication as as being worth the expense of litigation.¹³ Filartiga also gave support to international scholars who advocated the use of American domestic courts to incorporate international law into American law.¹⁴

Eventually though, claims for damages, sometimes even punitive, were brought against multinational corporations alleged to have committed human rights abuses.¹⁵ During this time, the ATS was used to create a sort of universal civil jurisdiction for victims of serious international law violations, even if the crimes occurred wholly outside of the United States.¹⁶ Aside from some unpredictability with regard to the scope of violations covered and much debate within academic circles, a relatively consistent precedent was set after other federal courts began to adopt the Second Circuits holding and reasoning as a framework for their own ATS analyses.¹⁷ In the same year of the Filartiga decision, the American Law Institute even published a “tentative” draft of its Restatement (Third) of U.S. Foreign Relations Law that endorsed the Second Circuits decision regarding the domestic status of the law of nations.¹⁸


¹³ Ernest A. Young, Universal Jurisdiction, the Alien Tort Statute, and Transnational Public-Law Litigation After Kiobel, 64 DUKE L.J. 1023, 1051 (2015).

¹⁴ Id.

¹⁵ Id. at 1026.

¹⁶ Id.

¹⁷ Philip Mariani, Assessing the Proper Relationship Between the Alien Tort Statute and the Torture Victim Protection Act, 156 U. PA. L. REV. 1383 at *1390 (2008).

¹⁸ Ernest A. Young, Universal Jurisdiction, the Alien Tort Statute, and Transnational Public-Law Litigation After Kiobel, 64 DUKE L.J. 1023, 1050 (2015).
For example, in *Presbyterian Church of Sudan v. Talisman Energy, Inc.*, the court held that the ATS provided subject matter jurisdiction for a foreign cubed (cases in which there is a foreign plaintiff suing a foreign defendant for acts committed on foreign soil.)\(^{19}\) In that case the plaintiffs, who were residents of South Sudan, sued a Canadian oil company for working with the Sudanese government during a conflict in the country to remove the local population from areas around oil fields.\(^{20}\) The plaintiffs alleged that the actions became an ethnic cleansing and genocide done at the hands of the government as part of an agreement with the oil company. The South Sudanese plaintiffs claimed that the defendants collaborated to commit human rights abuses including extrajudicial killing, forcible displacement, war crimes, confiscation and destruction of property, kidnapping, rape, and enslavement. The mutually beneficial relationship would provide security for the oil fields for Talisman Energy and much needed capital for the Sudanese government to continue the conflict; what was described as a jihad aimed at the Islamization of the majority non-Muslim southern portion of the country. While it was dismissed on other grounds, the Southern District of New York held that the exercise of personal jurisdiction over the Canadian company was proper.\(^{21}\)

Similarly, in *Hilao v. Marcos*, the court reasoned that a broad construction of the “arising under” aspect of Article III of the United States Constitution was the correct reading, and found jurisdiction to be proper in the case even though it was foreign cubed.\(^{22}\) *Hilao* involved the torture and/or disappearance of tens of thousands of people on orders from the President of the Philippines, Ferdinand Marcos. The President eventually fled to the United States and the suit was commenced after he was served. The court said: “a suit as an alien for the tort of wrongful death, committed by military intelligence officials through torture prohibited by the law of nations, is within the jurisdictional grant of § 1350.”\(^{23}\)

Another famous foreign cubed case that was brought under the ATS is *Kadic v. Karadžić*, which stems from the Bosnian war that raged from 1992 through 1995. During that time, Radovan Karadžić, sometimes referred to as “the

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20. *Id.*

21. *Id.*

22. *Hilao v. Marcos (In re Estate of Marcos)*, 25 F.3d 1467, 1473 at *1474 (9th Cir. 1994).

23. *Id.*
butcher of Bosnia\textsuperscript{24} the defendant in the case, served as president of the self-proclaimed Bosnian-Serb Republika Srpska.\textsuperscript{25} In his time as president, he is alleged to have directly and through command committed atrocities against humankind including ethnic cleansing, rape, forced prostitution, forced impregnation, torture and genocide.\textsuperscript{26} After being served in Manhattan while on invitation from the UN in 1993, the case began its path to the 2\textsuperscript{nd} Circuit Court of Appeals.\textsuperscript{27} Karadžić argued that service of process was insufficient because he was visiting on invitation from the UN. The court disagreed because he was not served while he was in the well-defined confines of UN Headquarters when he was served, and because he was not a designated representative of any member of the United Nations.\textsuperscript{28} The Second Circuit found that jurisdiction was proper and that Karadžić could be held liable both in his personal and official capacities.\textsuperscript{29} \textsuperscript{30} This Second Circuit decision expanded the ATS in holding that State action is not always required for a violation of the law of nations, which lead to the inclusion of suits against multinational corporations for breaches of customary international law with respect to both human rights and environmental protection.\textsuperscript{31}

However, almost 25 years after \textit{Filartiga}, the court sharply limited the availability of the ATS to international human rights litigation in federal courts. The court stated that, “the door is still ajar” to such litigation, though “subject to vigilant doorkeeping.”\textsuperscript{32} In \textit{Sosa v. Alvarez-Machain}, the court took a

\begin{itemize}
\item\textsuperscript{25} Kadic v. Karadzic, 70 F.3d 232, 236 (2d Cir. 1995).
\item\textsuperscript{26} Id at 236-37.
\item\textsuperscript{28} Id.
\item\textsuperscript{29} Kadic v. Karadzic, 70 F.3d 232 at *236 (2d Cir. 1995).
\item\textsuperscript{30} Karadžić went into hiding in 1996 and was not found until 12 years later. In March of 2016 he was found guilty of genocide and sentenced to 40 years in prison after a long trial in the UN ad hoc International Criminal Tribunal for the Former Yugoslavia. (Tim Hume, Tiffany Ap & Milena Veselinovic, \textit{Radovan Karadzic Found Guilty of Genocide, Sentenced to 40 Years}, CNN, (March 24, 2016) http://www.cnn.com/2016/03/24/europe/karadzic-war-crimes-verdict/).
\item\textsuperscript{31} Curtis A. Bradley, \textit{The Alien Tort Statute and Article III}, 42 VA. J. INT’L L. 587, 589 (2002).
\item\textsuperscript{32} Sosa v. Alvarez-Machain, 542 U.S. 692, 762 (2004) (“Whereas Justice Scalia sees these developments as sufficient to close the door to further independent judicial recognition of actionable international norms, other considerations persuade us that the judicial power should
comprehensive look at the scant legislative history available for the ATS to
determine whether it was meant to be simply jurisdictional in nature or to
provide a cause of action. The case involved the abduction of a Mexican national
by another Mexican national on orders from the United States Drug
Enforcement Agency. After looking at the little evidence they had, the court
determined that when the ATS was enacted, it was intended to grant federal
courts jurisdiction over common law claims for a particular set of international
law violations, namely offenses against ambassadors, violation of safe conducts,
and piracy. The court reasoned that the intent of Congress when enacting the
statute is not inconsistent with it affording jurisdiction over comparable
violations of modern international law. In a concurrence, Justice Breyer
advised lower courts to take international comity into account when deciding to
whether to hear cases and to take practical consequences into consideration.

The ATS took another hit with regards to scope of liability in Kiobel v. Royal
Dutch Petro. Co. In Kiobel, Nigerian nationals sued Dutch, British, and Nigerian
corporations under the ATS alleging that the corporations aided and abetted the
Nigerian Government in committing violations of the law of nations in
suppressing demonstrations against the environmental effects of their
operations in Nigeria. The plaintiffs alleged that the police, aided by the
corporations, killed, beat, and arrested residents as well as destroyed property.
The case was dismissed and the Supreme Court ruled that an old cannon of
statutory construction, the presumption of extraterritoriality, applied to ATS
and therefore cases brought under it must “touch and concern” the United
States for jurisdiction to be proper. This effectively prohibited foreign cubed
cases from being brought under the ATS.

be exercised on the understanding that the door is still ajar subject to vigilant doorkeeping, and
thus open to a narrow class of international norms today.”)

33. Id. at 697.

34. Id. at n.19, (“Section 1350 was enacted on the congressional understanding that courts
would exercise jurisdiction by entertaining some common law claims derived from the law of
nations; and we know of no reason to think that federal-question jurisdiction was extended
subject to any comparable congressional assumption. Further, our holding today is consistent with
the division of responsibilities between federal and state courts after Erie, see supra, at 726, 729-
730, 159 L. Ed. 2d, at 750, 751-752, as a more expansive common law power related to 28 U.S.C. §
1331 [28 USCS § 1331] might not be.”).


37. Id. at 1664-73.
However, the Court did leave open a window for a variety of human-rights litigation under the ATS, and various concurring opinions, especially one from Justice Breyer, suggest that the universal-jurisdiction for those who are “hostis humani generis,” or an enemy of all mankind, is not a moot notion. Only concurring with the result and rejecting the presumption against extraterritoriality Justice Breyer an alternate analysis: “jurisdiction should lie under the ATS whenever “(1) the alleged tort occurs on American soil, (2) the defendant is an American national, or (3) the defendant’s conduct substantially and adversely affects an important American national interest.” Breyer went on to explain that an important national interest “includes a distinct interest in preventing the United States from becoming a safe harbor (free of civil as well as criminal liability) for a torturer or other common enemy of mankind.”

B. Enactment of the TVPA

After Filartiga breathed new life into the ATS, courts spent almost 10 years wrestling with the interpretation of the 200-year-old statute with minimal case law to help. Some judges questioned whether the ATS granted a cause of action for torture without an express grant from Congress. Some believed that the ATS should operate strictly as a jurisdictional basis and not as giving rise to a right to sue, and thought that treating the ATS as giving rise to a cause of action was an imposition by the judicial branch onto the toes of the legislative branch. Others believed that the ATS did operate as giving right to sue, that it provided both a forum and a cause of action, and required only a showing that the defendant’s actions operated as violating the law of nations.

38. Id. at 1671.


40. Id.


43. Id. (citing Judge Edwards in Tel-Oren v. Libyan Arab Republic, 233 U.S. App. D.C. 384, 726 F.2d 774 (1984) “the Second Circuit did not require plaintiffs to point to a specific right to sue under the law of nations in order to establish jurisdiction under [the ATS]; rather, the Second
A great example of this confusion is a case out of the DC Circuit Court of Appeals, Tel-Oren v. Libyan Arab Republic. Tel-Oren was brought by the families of Israeli citizens who were killed in an attack on a civilian bus against the Libyan Arab Republic, the Palestine Liberation Organization, the Palestine Information Office, the National Association of Arab Americans, and the Palestine Congress of North America.\textsuperscript{44} The interpretations of the ATS were so inconsistent that a per curium decision was handed down with three different concurring opinions which were in conflict with each other on a number of issues.\textsuperscript{45}

To resolve some of the confusion, in 1991 Congress passed the Torture Victim Protection Act ("TVPA") codified as a note to the ATS and provided an explicit basis for liability for official torture or extrajudicial killings committed in violation of the law of nations.\textsuperscript{46} President George H.W. Bush signed it into law in 1992. Unlike the ATS, the TVPA is long and detailed, and it provides a broader grant of jurisdiction because it allows United States citizens, as well as noncitizens, to bring claims. The TVPA allows:

\begin{quote}
[A]n individual who, under actual or apparent authority, or color of law, of any foreign nation, subjects an individual to: (1) torture will, in a civil action, be liable for damages to that individual; or (2) extrajudicial killing will, in a civil action, be liable for damages to the individual’s legal representative, or to any person who may be a claimant in an action for wrongful death.\textsuperscript{47}
\end{quote}

The term extrajudicial killing is defined as “a deliberate killing not authorized by a previous judgment pronounced by a regularly constituted court affording all of the judicial guarantees which are recognized as indispensable by civilized peoples.”\textsuperscript{48} Extrajudicial killing does not include executions carried out under

\begin{footnotes}
\item[48] Id.
\end{footnotes}
the authority of a foreign nation that do not violate international law.\textsuperscript{49} Torture is defined as:

\begin{quote}
[A]ny act directed against an individual in the offender’s custody or physical control by which severe pain or suffering (other than pain or suffering arising only from, inherent in, or incidental to lawful sanctions), whether physical or mental, is intentionally inflicted on that individual for such purposes as obtaining information or a confession from that individual or a third person, punishing that individual for an act that the individual or a third person has committed or is suspected of having committed, intimidating or coercing that individual or a third person, or for any reason based on discrimination of any kind.\textsuperscript{50}
\end{quote}

Additionally, the act provides a definition for “pain or suffering”:

“Pain or suffering” under the Torture Victim Protection Act refers to prolonged mental harm caused by or resulting from: (1) the intentional infliction or threatened infliction of severe physical pain or suffering; (2) the administration or application, or threatened administration or application, of mind-altering substances or other procedures calculated to disrupt profoundly the senses or the personality; (3) the threat of imminent death; or (4) the threat that another individual will imminently be subjected to death, severe physical pain or suffering, or the administration or application of mind-altering substances or other procedures calculated to disrupt profoundly the senses or personality.\textsuperscript{51}

Unlike the ATS\textsuperscript{52}, the TVPA includes an exhaustion of remedies requirement.\textsuperscript{53} The exhaustion of remedies requirement is an affirmative defense, with the burden of proof on the defendant giving the plaintiff the opportunity to rebut by showing that the local remedies were “ineffective,

\textsuperscript{49} Id. at 2a.

\textsuperscript{50} Id.

\textsuperscript{51} 28 U.S.C.A. § 1350 note, § 3(b)(2) (“court shall decline to hear a claim if the claimant has not exhausted adequate and available remedies in the place in which the conduct giving rise to the claim occurred.”).


unobtainable, unduly prolonged, inadequate, or obviously futile.\textsuperscript{54} The TVPA also includes a 10-year-statute of limitations that has been held to be tolled until the Defendant is the United States and personal jurisdiction can be obtained.\textsuperscript{55} In contrast to the ATS, the TVPA provides a federal cause of action to aliens and U.S. Citizens for certain claims of torture and extrajudicial killings, but contains no jurisdictional grant.\textsuperscript{56}

The TVPA was passed partially in response to the United Nations Convention against Torture and Other Cruel, Inhumane or Degrading Treatment or Punishment, which the United States ratified in 1990.\textsuperscript{57} The UN Convention is an international human rights treaty that requires states to take measures to prevent torture within their borders and territories and forbids states to extradite people to any country where there is reason to believe they will be tortured, to date it has been signed by 83 countries.\textsuperscript{58} In a letter to the senate seeking ratification of the convention, President Reagan wrote: “[r]atification of the Convention by the United States will clearly express United States opposition to torture, an abhorrent practice unfortunately still prevalent in the world today.”\textsuperscript{59} Because the United States made it clear in its materials attached to the convention that it was not intended to be self-executing\textsuperscript{60}, Congress passed the TVPA to remain in accordance with the convention.\textsuperscript{61} According to its legislative history, the TVPA was created to further the goals of the UN

\textsuperscript{54} Id. (quoting S.Rep. No. 102-249, at 9-10).

\textsuperscript{55} Jean v. Dorelien, 431 F.3d 776, 780 (11th Cir. 2005) (citing S. Rep. No. 102-249, at 7 and at 11 (“only defendants over which a court in the United States has personal jurisdiction may be sued”) and (“The statute of limitations should be tolled during the time the defendant was absent from the United States or from any jurisdiction in which the same or a similar action arising from the same facts may be maintained by the plaintiff, provided that the remedy in that jurisdiction is adequate and available.”)


\textsuperscript{57} Id.


Convention against Torture and Other Cruel, Inhuman or Degrading Treatment or Punishment by “making sure that torturers and death squads will no longer have a safe haven in the United States.” The TVPA further addressed the goals of the convention by providing the means for victims of torture to find civil redress.

C. The TVPA in Action

In *Chavez v. Carranza* the families and victims of extrajudicial killing and torture brought claims under the TVPA against El Salvador’s former Vice-Minister of Defense and Public Security, Colonel Nicolas Carranza, who exercised control over the security forces who committed crimes against humanity. The defendant lived in a number of different states, became a naturalized citizen, and was eventually served in Memphis, Tennessee. He was alleged to have “exercised command responsibility over, conspired with, or aided and abetted subordinates in the Security Forces of El Salvador, or persons or groups acting in coordination with the Security Forces or under their control, to commit acts of extrajudicial killing, torture, crimes against humanity, and cruel, inhuman or degrading treatment or punishment, and to cover up these abuses.” The district court found that jurisdiction was proper under the TVPA for the plaintiffs who were American citizens and that it was also proper for the El Salvadorians under the ATS and a trial ensued with Carranza eventually being found liable and each of the plaintiffs being awarded $500,000 in compensatory damages and $1 million in punitive damages. The Sixth Circuit affirmed in 2009. In another instance of the difficulty of collecting on judgements against individuals, in 2016 over 10 years after the initial trial, a motion to renew judgement was filed and granted where it was asserted that “[d]espite Plaintiffs’ sustained and diligent efforts to execute on the Judgment, only $441.03 has

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65. *Id.*


67. *Id.*

been collected to date from Defendant."69 The group who brought the suit, the Center for Justice and Accountability says that they have successfully garnished one of Carranza’s bank accounts.70

However, in 2012, in the same way that Kiobel sharply limited liability under the ATS, in Mohamad v. Palestinian Auth. the Supreme Court limited liability under the TVPA to natural persons as opposed to juridical ones.71 That case arose after the widow and sons of a Palestinian man, Azzam Rahim, born and raised on the West Bank who later became a naturalized U.S. citizen brought suit against the Palestinian Authority and the Palestinian Liberation Organization after he was kidnapped and killed by Palestinian Authority Intelligence officers.72 The term “individual” was not defined under the act, so the court defined it.73 The Court looked to the dictionary to determine the plain meaning and decided that the term “individual” could only mean human beings as opposed to juridical ones.74 Even while determining that as read in the TVPA the term “individual” meant only natural persons, the court did note that Congress possesses the power to define the word individual to include corporations, but before that can be assumed, there must be some indication that it meant to do so.75 Though he agreed with the courts judgement because the “legislative history of the statute makes up for whatever interpretive inadequacies remain after considering language alone,” Justice Breyer noted that the word “individual” is open to “multiple interpretations, permitting it, linguistically speaking, to include natural persons, corporations and other entities.”76 Although the Mohamad case dealt with organizations, it appears


70. Campaign of Violence Against Salvadoran Civilians, THE CENTER FOR JUSTICE AND ACCOUNTABILITY, “CJA and pro bono co-counsel continue to pursue collection of the $6 million judgment against Carranza. To date, we have successfully garnished one of Carranza’s bank accounts.” http://cja.org/what-we-do/litigation/chavez-v-carranza/.


73. Id.


75. Id. at 663.

that the Supreme Court intended its reasoning to apply to TVPA suits against corporations as well; less than a week after Mohamad they denied cert in a case bringing TVPA claims against a corporate defendant in Bowoto v. Chevron Corp., which involved the death and injury of protestors on one of the oil giant’s platforms.

D. The ATS and the TVPA are Separate and Distinct, but Not Fully Independent

Though the TVPA is in stark contrast with the ATS with regards to detail and length, there is still confusion as to how the ATS and the TVPA should or should not be read together. Congress seemed to understand the overlap of coverage from the ATS and the TVPA, but none of the legislative history for the TVPA spoke directly to the issue. The fact that the TVPA was codified as a note to the ATS allows one to make the inference that they are meant to interact.

Despite the confusion, generally Federal Courts have treated the TVPA as being supplemental to the ATS even though some arguments have been made that the TVPA should preclude a cause of action under the ATS. This means that as a general practice and as the majority rule, an ATS claim is separate and distinct from a TVPA claim and can be brought separately in the same case, as can be seen in Kadic v. Karadzic and Chavez v. Carranza cited above, though many of the causes of action will be overlapping.

Because the TVPA is so much more detailed than the ATS, courts have begun to try to read the some of the terms and requirements of the TVPA into the ATS analysis. For example, in Sosa v. Alvarez-Machain, the court stated in dicta that an exhaustion of remedies requirement, like the one in the TVPA

78. Bowoto v. Chevron Corp., 621 F.3d 1116, 1120 (9th Cir. 2010).
82. Id.
83. Id.
might be used as an affirmative defense in a certain type of ATS cases.\textsuperscript{84} Courts generally import the statute of limitations portion and the equitable tolling portion of the TVPA into ATS analysis, and generally will use the definitions of torture and extrajudicial killing included in the TVPA.\textsuperscript{85}

\section{II. DOES TVP ALLOW FOR AIDING AND ABETTING LIABILITY?}

As is obvious by the discussion above, many parts of both the ATS and the TVPA are incredibly ambiguous and begging to be fleshed out by the Supreme Court or Congress. Many of the ambiguities and the failure of the Supreme Court or Congress to provide guidance have resulted in splits among the federal circuit courts. One main example of a split when it comes to the TVPA is whether or not secondary liability can be sustained on a theory of aiding and abetting.\textsuperscript{86} After Kiobel limited the ATS to application only to natural persons, and Mohamad v. Palestinian Authority did the same for the TPVA, the next big question is about indirect liability. To human rights advocates it is imperative that aiding and abetting liability be upheld in the context of TVPA claims. This example of contention in interpretation is very important because most of the high-profile cases brought under the ATS and/or the TVPA involve liability for aiding and abetting. The significance of this issue becomes clear when thinking about the logistics of suing a poorly organized, illegal paramilitary group as opposed to the Western corporation officers who have been funding them to do the dirty work.

When it comes to the ATS, most courts have allowed for liability under an aiding and abetting theory, though there is a circuit split as to what standard should be used - purpose or knowledge.\textsuperscript{87} Courts have upheld aiding and abetting liability by pointing both to common law conceptions of indirect liability as well as international law conceptions of the theory.\textsuperscript{88} While general


\textsuperscript{85} \textit{Id.} at 650.


\textsuperscript{87} \textit{The Alien Tort Statute: Comments on Current Issues: C. Theories of Liability for Non-State Actors: To Proceed with Caution? Aiding and Abetting Liability Under the Alien Tort Statute}, 28 BERKELEY J. INT’L L. 604* (”It seems settled that aiding and abetting is actionable under the ATS and that international law provides the source for a cause of action.”)

rule remains that the ATS encompasses aiding and abetting liability, lower courts disagree as to what standard must be met to prove the mens rea for aiding and abetting. Some courts have required a specific intent or purposeful standard that must be met to prove liability; others only require a knowledge standard.

In 2005 Senator Dianne Feinstein introduced a bill into the Senate that would have answered the aiding and abetting question with regards to the TVPA and greatly reduced the ability of human rights advocates and victims to find recourse against those who have enabled their torture and/or the extrajudicial killing of a family member. The bill would have required those who are bringing a claim under either the ATS or the TVPA to have acted directly and with specific intent. Business groups lauded the amendment and its sponsor Senator Feinstein, but after much criticism from the human rights community and labor groups Senator Feinstein withdrew the amendment.

One of the initial questions regarding indirect liability is whether non-state actors can violate the law of nations. This question is closely related to the question of aiding and abetting liability and should be answered first. Kadic v. Karadzic answered the question of whether the law of nations can be violated by a non-state actor in the affirmative and most courts follow this standard. In answering this question, the Kadic court said: "We do not agree that the law of nations, as understood in the modern era, confines its reach to state action. Instead, we hold that certain forms of conduct violate the law of nations."
whether undertaken by those acting under the auspices of a state or only as private individuals."\(^{95}\)

A. The Second & Ninth Circuit Approach: The TVPA Does Not Allow for Aiding and Abetting Liability

Recently in Doe v. Cisco Sys., the Northern District of California followed precedent from the Ninth Circuit and ruled that the TVPA does not allow for aiding and abetting liability.\(^{96}\) The Cisco court relied on Bowoto v. Chevron Corp in which the court dismisses the concept of aiding and abetting liability for corporate defendants in just a single paragraph, stating:

> It [the TVPA] limits liability to “[a]n individual” who subjects another to torture. See 28 U.S.C. § 1350, note § 2(a). Even assuming the TVPA permits some form of vicarious liability, the text limits such liability to individuals, meaning in this statute, natural persons. The language of the statute thus does not permit corporate liability under any theory.\(^{97}\)

The court went on: “Had Congress intended for the court to interpret the term ‘individual’ so broadly as to include corporations, it would have included some evidence of this intent in the legislative history.” It is difficult to understand how the Bowoto court came to the conclusion that the TVPA does not support theories of vicarious liability after pouring over the legislative history of the TVPA, including the Senate report, but failed to notice the following sentence: “The legislation is limited to lawsuits against persons who ordered, abetted, or assisted in the torture.”\(^{98}\) Giving the court the benefit of the doubt, though, it did focus mainly on the legislative history of the TVPA as limiting liability to individuals as opposed to corporations, but did not really provide any substantive analysis as to aiding and abetting liability.\(^{99}\)

In a Second Circuit case, Sikhs for Justice v. Nath, the court says that the text of the TVPA is silent as to aiding and abetting and that not every silence is pregnant.\(^{100}\) The plaintiffs alleged that the defendant, Kamal Nath by and

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\(^{95}\) Kadic v. Karadzic, 70 F.3d 232 (2d Cir. 1995).


\(^{97}\) Bowoto v. Chevron Corp., 621 F.3d 1116 (9th Cir. 2010) (citing 28 U.S.C. § 1350, note § 2(a)).

\(^{98}\) S. Rep. No. 102-249, at 8.

\(^{99}\) Bowoto v. Chevron Corp., 621 F.3d 1116 (9th Cir. 2010).

through the ruling political party in India at the time, INC, committed various human rights violations, including acts of genocide, gang rape, torture, summary executions, and extra-judicial killings against non-U.S. resident Sikhs. Both Nath himself and the INC had significant ties to the United States, particularly New York State. The court reasoned that silence in the text of the TVPA should not be interpreted as granting and authorizing liability because if Congress intended to impose aiding and abetting liability it would have used the words aid and abet in the statutory text.\footnote{101} This logic is flawed because the drafters made it clear that the use of the word “individual” was not inadvertent and was used to prohibit claims against foreign states.\footnote{102} If the court wanted to prohibit indirect liability it would have made a note of it, just as it did regarding claims against foreign states.\footnote{103}

B. The Eleventh & Second Circuit Approach: The TVPA Does Allow for Aiding and Abetting Liability

More recently the Southern District of Florida held that \textit{In re Chiquita Brands Int’l, Inc. Alien Tort Statute & S’holder Derivative Litig.}, held that aiding and abetting liability is implicit within the TVPA, stating: “[T]heories of secondary liability under domestic law are available to support TVPA claims, with federal common law supplying the relevant standards.”\footnote{104} The court also discussed alternate theories of indirect liability like agency and conspiracy, and explains that they are available as avenues for liability under the TVPA.\footnote{105}

The United States Court of Appeals for the Eleventh Circuit has a history of being a hospitable forum for human rights advocates looking for redress. In one of the first cases in which indirect liability was found under the TVPA, \textit{Arce v. Garcia}, the plaintiffs were awarded a $54.6 million-dollar verdict including punitive and compensatory damages by a South Florida jury.\footnote{106} The jury awarded this sum even after hearing testimony from the two defendants who

\footnote{101} Id.

\footnote{102} See S. Rep. No. 102-249, at 8.

\footnote{103} See id.

\footnote{104} In re Chiquita Brands Int’l, Inc. Alien Tort Statute & S’holder Derivative Litig., No. 08-MD-01916-KAM, 2016 U.S. Dist. LEXIS 82741, at *391 (S.D. Fla. June 1, 2016) (relying on Doe v. Drummond Co., 782 F.3d 576 (11th Cir. 2015)).

\footnote{105} Id citing Doe v. Drummond Co., 782 F.3d 576 (11th Cir. 2015).

fully contested the allegations that they were responsible under a command theory for the gruesome acts of torture against the plaintiffs, Salvadorian citizens who later gained political asylum in the United States. 107 One of the defendants was the Director of the Salvadoran National Guard, the other, General Jose Guillermo Garcia, was the Minister of Defense at the time of the disappearance, killing, and torture of over 75,000 civilians during the Salvadoran Civil War. 108

However, even within the circuits that have determined that aiding and abetting liability should be allowed, there is still discord with regards to whether domestic or international law standards of indirect liability should be used. For example, in Doe v. Drummond, the 11th Circuit Court of Appeals uses a “knowing and substantial assistance” standard to establish aiding and abetting liability under the TVPA. 109 The same circuit uses command responsibility, an international legal doctrine codified in the Geneva Convention used most prominently in the Nuremburg and Tokyo proceedings after WWII, in Arce. 110 Use of the doctrine of command responsibility is also found domestically in United States Military proceedings. 111

The Second Circuit took a different approach entirely and requires that a defendant act “purposefully” rather than with just knowledge alone in Presbyterian Church of Sudan v. Talisman Energy, Inc., where they state that the standard is:

[P]urpose rather than knowledge alone. Even if there is a sufficient international consensus for imposing liability on individuals who purposefully aid and abet a violation of international law, . . . no such consensus exists for imposing liability on individuals who knowingly (but not purposefully) aid and abet a violation of international law. 112

In re Chiquita relied on the 11th circuit case, Doe v. Drummond Co., in allowing liability for aiding and abetting. In Drummond, the court rejected the notion that theories of liability found in international law should be used and

107. Id.
111. Id.
112. Presbyterian Church of Sudan v. Talisman Energy, Inc., 582 F.3d 244, 259 (2d Cir. 2009).
instead relied on theories of indirect liability found in federal common law.¹¹³ In *Drummond*, the court presents a comprehensive, highly persuasive argument for the use of theories of indirect liability that can be found in federal common law.¹¹⁴

International law does not determine the United States Court of Appeals for the Eleventh Circuit’s interpretation of the Torture Victim Protection Act of 1991 (TVPA), 28 U.S.C.S. § 1350 note. The TVPA and claims brought thereunder are governed by its language, its legislative history, and general principles of domestic law. Indeed, on the rare occasions when the Eleventh Circuit looks to general principles of international law for guidance as to what a theory of liability or statutory definition requires, the court does so only because the TVPA itself implicitly or explicitly incorporated those principles from international law. In other places, the legislative history instead directs the court to domestic law; the court is told to apply principles of liability under U.S. civil rights laws, in particular 42 U.S.C. § 1983, in construing under color of law as well as interpretations of actual or apparent authority derived from agency theory in order to give the fullest coverage possible.

The court points specifically at the legislative history of the TVPA noting that it calls for the use of domestic law with regards to agency theory when determining whether there was actual or apparent authority.¹¹⁵

C. The Legislative History Makes it Clear that Aiding and Abetting Liability was Intended to be Part of the TVPA

Unlike its counterpart, the ATS, the TVPA is accompanied with an extensive legislative history. The legislative history, in particular the Senate Report makes it very clear that the authors intended the act to encompass indirect liability. For example:

The legislation is limited to lawsuits against persons who ordered, abetted, or assisted in the torture. It will not permit a lawsuit against a former leader of a country merely because an isolated act of torture occurred somewhere in that country. However, a higher official need not have personally performed or ordered the abuses in order to be held liable. Under international law, responsibility for torture, summary execution, or disappearances extends beyond the person or

¹¹³. Doe v. Drummond Co., 782 F.3d 576 (11th Cir. 2015).
¹¹⁴. *Id.*
¹¹⁵. *Id.*
persons who actually committed those acts—anyone with higher authority who authorized, tolerated or knowingly ignored those acts is liable for them.\textsuperscript{116}

It is almost bewildering to think courts that claim to have spent ample time examining the legislative history of the TVPA have either failed to notice this section of the Senate Report or simply have disregarded it in the interest of powerful corporations. The legislative history gives a very strong indication that the TVPA was meant to codify the \textit{Filártiga} decision and expand the cause of action to American Citizens.\textsuperscript{117}

The court in \textit{Sikhs for Justice} dismissed the plaintiff’s argument that there “is no indication that Congress intended to preclude this form of liability under the TVPA,” retorting with “neither is there any affirmative intention in the statute.”\textsuperscript{118} The court guesses at the legislative intent behind the TVPA through a one sentence analysis of what the court did not say, when they simply could have looked to the Senate Report to find what the legislators did say and what the real intent was.

Opinions on the merits of looking to legislative history are not consistently held amongst jurists, but a 2012 survey of 137 congressional staffers from both parties, both chambers of Congress, and spanning multiple committees found legislative history to be the most important tool of both drafting and interpretation to the staffers, after actual statutory text.\textsuperscript{119} This was overwhelmingly true for both Democrat and Republican respondents with 92% saying legislative history is useful for courts.\textsuperscript{120} Textualist like the late Supreme Court Justice Antonin Scalia argue that legislative history is not a good tool for the interpretation of an ambiguous statute because of the practical realities of how statutes are drafted. However, the same survey found that “many of the assumptions on which this critique relies are unfounded.”\textsuperscript{121}

\textsuperscript{116} S. REP. 102-249, 9.


\textsuperscript{120} \textit{Id}.

\textsuperscript{121} \textit{Id}.
Aside from blatantly stating that the TVPA encompasses liability against those who have abetted or ordered torture, the Senate Report for the TVPA also cites to several international agreements that contemplate liability for those not directly responsible for the torture. The report cites to the UN Convention Against Torture and Other Cruel, Inhuman or Degrading Treatment or Punishment, in particular Article 4(1), which says:

*Each State Party shall ensure that all acts of torture are offenses under its criminal law. The same shall apply to an attempt to commit torture and to an act by any person which constitutes complicity or participation in the torture.*

The Senate Report also discusses the Inter-American Convention to Prevent and Punish Torture, specifically Article 3:

*The following shall be held guilty of the crime of torture: (a) A public servant or employee who, acting in that capacity, orders, instigates or induces the use of torture, or directly commits it or who, being able to prevent it, fails to do so.*

In the legislative history, the drafters are careful to note that they used the term “individuals” when referring to those who can be held liable under the TVPA to preclude cases against foreign states. The business community has lauded this interpretation, but do not use the same logic when discussing aiding and abetting. The fact that the drafters specifically noted that they did not want foreign states to be sued, but said nothing about precluding liability for aiding and abetting is strong evidence of their intent. If the authors wanted to preclude liability for aiding and abetting they would have made a note of it, and pointed it out when discussing the fact that the use of “individual” was not inadvertent.

### III. Conclusion

#### A. What Should SCOTUS Do if Presented With This Issue?

The Supreme Court should create a bright line rule explaining the standard for indirect liability under the TVPA. The TVPA and claims brought under it should be governed by its language, its legislative history, and general principles

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123. *Id.*
124. *Id.*
of domestic law. It makes sense for the Court to apply a consistent standard for the TVPA rather than allowing the circuits to utilize existing requirements for indirect liability, though even that would be better than the current confusion. Either way, the Supreme Court should make it clear that federal common law theories of indirect liability, including conspiratorial liability, agency, command responsibility and ratification are available to those suing under the TVPA. This furthers the goals of the TVPA to domesticate international prohibitions against torture.

Guidance as to the elements of command responsibility can be gained from looking to international law, because “legislative history makes clear that Congress intended to adopt the doctrine of command responsibility from international law as part of the [TVPA].”\textsuperscript{126} Common law theories can be supplemented by theories of indirect liability found in international law at the discretion of the court, but those international law theories should not be persuasive. For example, courts should look to principles of international law for inquiry into the exhaustion of remedies requirement because it is necessary to do so for the analysis of whether remedies have been exhausted in the country in which the alleged human rights abuse occurred.

American courts have spent hundreds of years defining standards for common law conspiracy and indirect liability; it makes sense to continue to utilize these standards in TVPA litigation. Courts should be very careful when considering theories of indirect liability derived from international norms because this can be seen as expanding liability so much as to create a new tort, which would be a huge judicial overreach.\textsuperscript{127} However, it may be appropriate for a theory of command responsibility to be imported from international law, because it is also recognized domestically in military matters. The elements of command responsibility should be:

1. The direct perpetrators of the unlawful acts were subordinates of the defendant commander;

2. The defendant commander knew (actual knowledge) or should have known (constructive knowledge) that his troops were committing, had committed, or were about to commit abuses; and

\textsuperscript{126} Ford ex rel. Estate of Ford v. Garcia, 289 F.3d 1283, 1289 at 1286 (11th Cir. 2002).

3. The defendant commander failed to take steps to prevent or punish criminal conduct by subordinates.\textsuperscript{128}

A \textit{mens rea} requirement of “knowledge” should be imported into TVPA analysis. In \textit{Chiquita}, this requirement was met by a showing that the Chiquita officers continuously approved payments to the terrorist groups knowing that the “violent deaths of thousands of civilians in the banana-growing regions of Colombia would be at least a collateral by-product of its support, if not an intended result.”\textsuperscript{129} The argument that the Chiquita officers had knowledge is furthered by the benefits they received from the targeted terrorization of those sympathetic with labor movements.

The \textit{actus reus} element of aiding and abetting should be “sufficient acts of substantial assistance.”\textsuperscript{130} The plaintiffs in \textit{Chiquita} satisfied this by showing that each of the individual defendants made affirmative decisions to implement, continue and conceal support for the terrorist organization with knowledge that the funding would go towards the human rights abuses and murders of civilians.\textsuperscript{130} The decision making from within the United States directing substantial amounts of money and material support to the terrorist organization to continue an increasingly intensifying terror campaign satisfied the \textit{actus reus} element of aiding and abetting liability.\textsuperscript{131}

The goals in mind during the creation of the TVPA cannot be met unless it allows for aiding and abetting liability. Support for the allowance of aiding and abetting liability for ATS claims and by extension TVPA claims is bi-partisan. The Administrations of Presidents Carter, Clinton, and George H.W. Bush have all voiced support for litigation under the ATS, even in instances involving corporate aiding and abetting liability.\textsuperscript{132} The support from the executive branch is strengthened by the support from Congress, which is seen in the notes to the TVPA. Fears that our court systems will be inundated with people bringing ATS or TVPA cases are unfounded, even with indirect liability available to potential plaintiffs, it will still be very difficult to get past the pleadings stage.


\textsuperscript{129} In re Chiquita Brands Int’l, Inc. Alien Tort Statute & S’holder Derivative Litig., No. 08-MD-01916-KAM, 2016 U.S. Dist. LEXIS 82741, at *391 (S.D. Fla. June 1, 2016).

\textsuperscript{130} Id. at *1119.

\textsuperscript{131} Id.

After coming to the maddening conclusion that corporations are people when it comes to making political contributions, but not when it comes to being held accountable for the rape, murder, and torture of thousands native population who hindered profits by simply existing; the court would render the TVPA as essentially useless if indirect liability is unavailable. The legislative history to the TVPA has made it clear that this was not the intention of the authors.\textsuperscript{133} The \textit{Chiquita Case} is an excellent example of why aiding and abetting liability is necessary to the function of the TVPA. The fact that the officers continued to fund the terrorist organization even after being warned both by in house and outside council as well as the Justice Department because profits literally took priority over human life make it clear how complicit they were in the torture and murder of thousands.

TRUMPED BY FALSE ENDORSEMENT: MUSICIANS STILL MIGHT HAVE INTELLECTUAL PROPERTY RIGHTS TO PROHIBIT POLITICIANS FROM USING THEIR SONGS DESPITE COPYRIGHT LICENSES

Elizabeth Long*

I. INTRODUCTION

In perhaps one of the most divisive campaigns to date, President Donald Trump has proven he is no stranger to criticism. Among the critics are those in the music industry who have publicly denounced his use of their songs during his campaign.

In May 2015, The Rolling Stones asked Donald Trump to stop playing their songs at his campaign events. After effectively sealing the Republican nomination on May 3, Trump played the Stones’ hit Start Me Up as he left the stage following a victory speech. However, the band said in a statement: “The Rolling Stones have never given permission to the Trump campaign to use their songs and have requested that they cease all use immediately.” Trump is known to be a fan of the Stones and has previously played You Can’t Always Get What You Want, Sympathy for the Devil, and Brown Sugar at campaign events.

In June 2015, Neil Young criticized Trump for using his song Rockin’ in the Free World when Trump launched his U.S. presidential campaign. Young stated “Donald Trump was not authorized to use Rockin’ in the Free World in his presidential candidacy announcement.” The statement went on to indicate that Young supports Vermont Senator Bernie Sanders, an independent and one

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2. Id.

3. Id.


5. Chilton, supra note 1.

6. Id.
of the most outspoken liberals in Congress for the 2016 Democratic presidential nomination.\(^7\)

A Trump campaign spokeswoman replied that Trump’s team paid for the legal right to play Young’s recording during the launch of his campaign through a license agreement with American Society of Composers, Authors and Publishers (ASCAP).\(^8\) She added, “[n]evertheless, we won’t be using it again—there are plenty of songs to choose from. Despite Neil’s differing political views, Mr. Trump likes Neil very much.”\(^9\)

In October 2015, after Trump used Steven Tyler’s song *Dream On*, Tyler’s attorney stated “Trump for President does not have our client’s permission to use *Dream On* . . . because it gives the false impression that he is connected with or endorses Mr. Trump’s presidential bid.”\(^10\) Trump later tweeted “[e]ven though I have the legal right to use Steven Tyler’s song, he asked me not to. [I] have [a] better one to take its place!”\(^11\)

Similarly, in 2012, Mitt Romney stopped using K’naan’s song *Wavin’ Flag* even though Romney’s reps insisted they had permission through blanket licenses purchased from ASCAP and BMI (Broadcast Music Inc.).\(^12\) The Somali-Canadian musician’s song, featuring vocals from Will.i.am and David Guetta, gained popularity in the wake of the 2010 earthquake in Haiti and then took off even more when Coca-Cola used a version of it as the anthem of the FIFA World Cup in South Africa.\(^13\) When Romney played it during a victory rally in Florida, K’naan was deluged with Twitter messages accusing him of selling out to a conservative politician.\(^14\) The musician threatened legal action against the Romney campaign, explaining, “I’m for immigrants. I’m for poor people, and

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\(^7\) Id.

\(^8\) Id.

\(^9\) Id.


\(^11\) Id.


\(^13\) Id.

\(^14\) Id.
they don’t seem to be what [Romney’s] endorsing.”15 Again, though Romney had acquired a license to play the song, he stopped using it out of respect for K’naan’s views.16

This brings up an interesting question: though political candidates, such as Trump and Romney, paid for a license to play a musician’s song, could the musician nevertheless have a legal claim against the politician for such use? While Trump might be the worst repeat offender,17 politicians using musicians’ songs in campaigns and musicians getting upset over that use is nothing new.18 What might be a new concept, however, is the fact that though the politician correctly uses the song under copyright law—i.e., buys a license—the musician can still have legal remedies to prevent the politician from using the song.19 Specifically, while the musician might try to bring causes of action under copyright infringement, right of publicity, and/or false endorsement theories, the musician could very well assert a successful cause of action through a false endorsement claim. False endorsement sounds in trademark law where the celebrity owns a trademark, and the celebrity does not want that mark to be

15. Id.

16. Id.


18. For example, Tom Petty sued Michele Bachmann for her use of American Girl; Sam Moore sued Barack Obama for his use of Hold On! I’m Coming, and Bruce Springsteen sued Ronald Reagan’s 1984 Campaign for using Born in the U.S.A. Tom Petty’s War on Michele Bachmann, THE DAILY BEAST (Nov. 29, 2011, 11:00 PM), http://www.thedailybeast.com/articles/2011/06/29/tom-petty-against-michele-bachmann-springsteen-against-ronald-reagan-musicians-vs-politicians.html. Though lawsuits over song use are relatively new, politicians have used music in their campaigns as early as the late 1800s: Andrew Jackson used the song The Hunters of Kentucky; Abraham Lincoln used The Battle Cry of Freedom; and Franklin Roosevelt used Happy Days are Here Again. See Jennifer L. Elgin, Copyrights and Campaigns, CAMPAIGNS AND ELECTIONS (May 29, 2012), https://www.campaignsandelections.com/campaign-insider/copyrights-and-campaigns.

19. Using Music in Political Campaigns: What You Should Know, ASCAP.COM, https://www.ascap.com/about/legislation/advocacy-resources/using-music-in-political-campaigns-what-you-should-know.aspx (explaining that while campaigns can be in compliance with copyright law because either the venue has a proper “public performance” license or the campaign has obtained a public performance license from ASCAP (the industry licensing service), the campaign can still be criticized or even sued by an artist for playing his or her song at an event).
falsely associated with someone or something other than the celebrity. Another article addressing this topic considered whether the musician might have a cause of action under trademark law but looked at whether the particular song used by the politician could be considered a trademark in and of itself to give rise to the musician’s false endorsement claim. However, the article ultimately concluded that a “song-mark” protection theory was not viable, and, even if it was, it would be preempted by copyright law. This article, however, considers a false endorsement cause of action where the celebrity’s identity is the equivalent of the mark—not the particular song. This is really distinct from trademark in a song. Also, while a false endorsement claim is similar to a right of publicity claim, the false endorsement claim derives from federal law. Therefore, unlike right of publicity, false endorsement might not be so easily preempted by copyright law.

Part I of this article discusses the background of copyright law as it relates to this issue. Parts II and III look at false endorsement and right of publicity causes of action, respectively. Part IV discusses preemption issues with the right of publicity and copyright law. This article concludes in part V that while the musician might very well assert both right of publicity and false endorsement causes of action, if the politician has a license to use the song, the musician’s right of publicity claim will likely be preempted and as a result fail. But the musician could still assert a false endorsement cause of action and be successful.

II. BACKGROUND

Congress enacted the Copyright Act to define and protect the rights of copyright holders. Under the Copyright Act, a copyright is defined as “a
limited monopoly that protects original works of authorship fixed in a tangible medium of expression. For example, photos, videos, music, artwork, and text are all works protected by copyright law. The copyright owner is said to have a “bundle of exclusive rights” including the right to control the reproduction, distribution and adaptation of his or her creative expression.

While copyright fixes on any tangible medium of original authorship (registered or unregistered), a registered work with the U.S. Copyright Office provides the copyright holder with a variety of benefits apart from an unregistered work, including the ability to sue for infringement. Because the copyright holder has the right to control the work (e.g., a song), a person seeking to use the work or song needs to get a license from the copyright holder or else face a copyright infringement action. A copyright infringement action challenges the unauthorized use of a song or recording. At the most basic level, there are two elements to copyright infringement: (1) ownership of the copyright by the plaintiff and (2) copying by the defendant.

There are two different copyrights implicated by a song—the musical composition and the sound recording. A musical composition consists of music, including any accompanying words. The author of a musical composition is generally the composer, and the lyricist, if any. A sound recording, on the other hand, results from the fixation of a series of musical, spoken, or other sounds. The author of a sound recording is the performer whose performance is fixed, or the record producer who processes the sounds and fixes them in the


25. Id. (listing eight general categories of copyrightable works: (1) literary works; (2) musical works, including any accompany words; (3) dramatic works; (4) choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures; (7) sound recordings; and (8) architectural works).


27. 17 U.S.C. § 412 (providing that registration is a prerequisite to certain remedies for infringement).


31. Id.

32. Id.
final recording, or both. Copyright in a sound recording is not the same as, or a substitute for, copyright in the underlying musical composition.

Two organizations—ASCAP (American Society of Composers, Authors, and Publishers) and BMI (Broadcast Music Inc.)—are the industry leaders for the management of music copyrights. These organizations issue public performance licenses to venues wishing to publicly use the song and collect and distribute royalty fees for members. ASCAP and BMI also police copyrights by monitoring public performances and bring actions against alleged infringers.

Whether the copyright owner can bring a copyright infringement claim against the politician is straightforward. The candidate either has a license to use the song or not. Assuming the candidate pays for the license from ASCAP or BMI, there shouldn’t be a copyright issue. A license is a license.

For example, when Trump’s team stated they “paid for the legal right to play the recording” of Young’s Rockin’ in the Free World through a license agreement from ASCAP, the legal right referred to is a copyright license. In other words, assuming Trump secured a license to use the song recording, Young could not sue Trump for copyright infringement (or at least he would not be successful). However, even if the politician properly licenses the artist’s music, he still might face resistance from musicians who do not wish to be

33. Id.
34. Id.
37. Id.
39. Id.
40. Id.
41. Id.
42. Chilton, supra note 1 (emphasis added).
associated with the candidate.\(^{43}\) In this context, it is possible that such a musician may not be able to claim copyright infringement but could argue that the use of a particular song creates a false association of sponsorship under the Lanham Act.\(^{44}\) Simply put, if the public thinks the politician’s use of the song means the musician supports the campaign, the musician can sue for false endorsement.

### III. FALSE ENDORSEMENT AS A CAUSE OF ACTION

False endorsement is a cause of action under Section 43(a) of the Lanham Act.\(^{45}\) False endorsement occurs when a person’s identity is connected with a product or service in such a way that consumers are likely to be misled about that person’s sponsorship or approval of the product or service.\(^{46}\)

“A false endorsement claim based on the unauthorized use of a celebrity’s identity alleges the **misuse** of a **trademark** . . . such as visual likeness, vocal imitation [as well as actual voice], or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff’s

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44. *Id.*

45. Lanham Act, 15 U.S.C. § 1125(a)(1) (2012). In 1946, Congress passed the Lanham Act, which defines federal trademark protection and trademark registration rules. See 15 U.S.C. §§ 1051–1127. The Lanham Act is based on Congress’s ability to regulate goods traveling through interstate commerce under the Commerce Clause of the U.S. Constitution. U.S. Const. Art. I, § 8, cl. 3 ("The Congress shall have power to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes."). Thus, like copyright, false endorsement sounds in federal law. But whereas copyright is derived from the Copyright Clause, false endorsement derives from the Commerce Clause of the U.S. Constitution.

sponsorship or approval of the product.” In such a case, the “mark’ at issue is the plaintiff’s identity.”

Section 43(a) of the U.S. Lanham (Trademark) Act forbids false designations of origin, false descriptions, and dilution. It covers false association (also called false implied endorsement) in the following terms:

(1) Any person who, on or in connection with any goods or services . . .
. uses in commerce any word, term, name, symbol, or device . . . or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion . . . or to deceive as to the affiliation, connection, or association of such person with another person, or as to the . . . sponsorship, or approval of his or her goods, services, or commercial activities by another person, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

To prove a violation of section 43(a)(1)(A) in a false endorsement case, a plaintiff must show that: (1) its mark is legally protectable; (2) it owns the mark; and (3) the defendant’s use of the mark to identify its goods or services is likely to create confusion concerning the plaintiff’s sponsorship or approval of those goods or services.

47. Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1110 (9th Cir. 1992) (emphasis added) (imitation of singer’s unique voice used in radio commercial advertising Dorito Chips); see also, Wendt v. Host Int’l, Inc., 125 F.3d 806 (9th Cir. 1997) (animatronic robotic figures resembling actors in Cheers television program used to advertise chain of airport bars modeled on Cheers set); Abdul-Jabbar v. General Motors Corp., 85 F.3d 407 (9th Cir. 1996) (athlete’s name and accomplishments used in television advertisement for Oldsmobile automobiles); White v. Samsung Elecs. America, Inc., 971 F.2d 1395 (9th Cir. 1992) (female robot bearing resemblance to television celebrity, Vanna White, turning letters in what appeared to be the “Wheel of Fortune” game show set in television commercial advertising electronics products); Allen v. Nat’l Video, Inc., 610 F. Supp. 612 (S.D.N.Y. 1985) (photograph of Woody Allen look-alike in national advertising campaign for video club).

48. Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 626 (6th Cir. 2000) (emphasis added); But cf., Podlas, supra note 20, at 2 (considering whether music can function as a singer trademark, ultimately concluding that while, in theory, a song-based trademark could exist, in practice it would either fail to acquire the appropriate secondary meaning or be precluded—if not preempted—by copyright law).

49. The Lanham Act includes two different bases of liability: false association (§ 43(a)(1)(A)) and false advertising (§ 43(a)(1)(B)). “False association” includes false representations concerning the origin, association, or endorsement of goods or services through the wrongful use of another’s distinctive mark, name, trade dress, or other device, and “false advertising” includes false representations in advertising concerning the qualities of goods or services. Waits, 978 F.2d at 1108.

goods or services.\textsuperscript{51} This third prong regarding likelihood of confusion is typically the controlling issue in a false endorsement claim.\textsuperscript{52} Before going through the likelihood of confusion analysis involving the hypothetical case of Neil Young v. Donald Trump, however, it is necessary to address the first prong—whether the mark is legally protectable.

\textit{A. Legal Protectability of the Mark}

In the hypothetical case of Young v. Trump, the “mark” at issue would be Young’s identity. Again, the Lanham Act’s section 43(a) expressly prohibits the use of any symbol or device that is likely to deceive consumers as to the association, sponsorship, or approval of goods or services by another person. Courts have given the terms “symbol or device” broad interpretation to include distinctive sounds and physical appearance.\textsuperscript{53} False endorsement claims, including those premised on the unauthorized imitation of an entertainer’s distinctive voice, are cognizable under section 43(a).\textsuperscript{54}

In \textit{Waits v. Frito-Lay, Inc.}, for example, Tom Waits sued Frito-Lay after Frito-Lay aired a commercial featuring a singer’s voice that sounded remarkably similar to Waits’ unique voice.\textsuperscript{55} Waits has a raspy, gravelly singing voice, described by one fan as “like you’d sound if you drank a quart of bourbon, smoked a pack of cigarettes and swallowed a pack of razor blades. . . . Late at night. After not sleeping for three days.”\textsuperscript{56} Waits achieved both commercial and critical success in his musical career.\textsuperscript{57} He was the subject of numerous magazine and newspaper articles appearing in such publications as \textit{Time},

\begin{thebibliography}{99}
\bibitem{52} \textit{See Landham}, 227 F.3d at 626; Wynn Oil Co. v. Thomas, 839 F.2d 1183, 1186 (6th Cir. 1988).
\bibitem{53} \textit{See generally Waits}, 978 F.2d 1093 (affirming judgment for plaintiff, Tom Waits, on false implied endorsement claim for use in a snack-food commercial of a singer who imitated plaintiff’s gravelly singing style praising defendant’s product); \textit{see also White v. Samsung Elecs. America, Inc.}, 971 F.2d 1395 (9th Cir. 1992) (holding there was genuine issue of material fact precluding summary judgment as to false implied endorsement claim brought by Vanna White, the hostess of the “Wheel of Fortune” game show, for use in an advertisement for VCRs of a look-alike caricature robot endorsing defendant’s product).
\bibitem{54} \textit{See generally Waits}, 978 F.2d 1093.
\bibitem{55} \textit{Id.} at 1096-97.
\bibitem{56} \textit{Id.} at 1097.
\bibitem{57} \textit{Id.}
\end{thebibliography}
Newsweek, and the Wall Street Journal. But Waits did not do commercials. He had a consistent policy of refusing to endorse major products, rejecting many lucrative offers. Moreover, Waits’ policy was a public one: in magazine, radio, and newspaper interviews he had expressed his philosophy that musical artists should not do commercials because it detracts from their artistic integrity.

Among Waits’ claims against Frito-Lay was one for false endorsement, upon which he prevailed. Frito-Lay aired the commercial nationwide, and Waits, having heard it during his appearance on a Los Angeles radio program, was shocked. He realized “immediately that whoever was going to hear [it] and obviously identify the voice would also identify that he in fact had agreed to do a commercial for Doritos.” On Waits’ false endorsement claim under the Lanham Act, the court held that “a celebrity whose endorsement of a product is implied through the imitation of a distinctive attribute of the celebrity’s identity [...] has standing to sue for false endorsement.” Thus, Waits’ voice was so distinctive as to develop trademark significance in his own vocal sound. His voice was part of his distinctive musical identity—his mark—and in the context of a false endorsement claim, the court found it was legally protectable. Extending this rationale to our hypothetical, a court could likely find that Young’s voice (or Mick Jagger’s or Steven Tyler’s) is a legally protectable mark.

On the other hand, a case where the court did not consider distinctive musical identity a legally protectable mark was Oliveira v. Frito-Lay, Inc. In

58. Id.
59. Id.
60. Id.
61. Id.
62. See id. at 1110-11.
63. Id. at 1098.
64. Id.
65. Id. at 1110 (emphasis added).
that case, Astrud Gilberto claimed she had trademark rights in her vocal performance of the song *The Girl from Ipanema*. 68 Frito-Lay used the song in a television commercial for potato chips. 69 Gilberto claimed she had become identified by the public with the recording and that she had acquired trademark rights in the song, requiring the advertiser to obtain her consent. 70 Because Frito-Lay did not do that, Gilberto claimed that the use of the song falsely implied that she endorsed Frito-Lay.

Though the Second Circuit rejected Gilberto’s false endorsement claim, it stated that a musical composition can serve as a trademark for goods or services—it just cannot serve as a trademark “for itself.” 71 Thus, the court concluded that an artist’s “signature performance” cannot establish a trademark signifying that artist. 72 “[T]o use a well-known example, . . . Bob Seger’s performance of the song *Like a Rock*, [as] the long-running musical backdrop for Chevrolet truck commercials, can function as a trademark for Chevy. But Seger’s performance cannot be a trademark for the song ‘Like a Rock’ or for the artist, Seger.” 73 The Second Circuit explained this rule was necessary to vindicate the rights of those who lawfully acquired a license to use the copyrighted work. 74 If the false endorsement claim could trump this license, this could upset reasonable commercial expectations. 75 Frito–Lay, for example, had spent more than $200,000 to acquire, under the copyright laws, a license and synchronization rights from the record owners of *The Girl from Ipanema*. 76

The *Oliveira* court, however, concluded that it would not be unthinkable for trademark law to grant a performing artist trademark protection in his or her signature performance, but such an expansion of trademark law would require legislative action. 77 Additionally, though the court ruled that Frito-Lay’s use of

68. *Id.* at 57-58.
69. *Id.*
70. *Id.* at 59.
71. *Id.* at 61-62 (emphasis added) (citing EMI Catalogue P’ship v. Hill, Connors, Cosmopolos Inc., 228 F.3d 56, 64 (2d Cir. 2000)).
72. *Id.* at 62.
74. *See Oliveira*, 251 F.3d at 63.
75. *Id.*
76. *Id.* at 58.
77. *Id.* at 62-63.
the song had not taken Gilberto’s persona to imply that she endorsed the product, it acknowledged other cases, including Waits, where a performing artist’s “persona” was protected against a false implication of an endorsement.\textsuperscript{78}

This article’s author does not argue that a court must recognize an artist’s signature performance as a trademark for the artist to succeed on his false endorsement claim against the politician. Again, it is the artist’s persona—his identity—that is the mark giving rise to his false endorsement claim. There are many pieces of support that warrant such a claim, and Waits is not so far off base from our hypothetical.

First, Waits’ identity—his mark—was in jeopardy through Frito-Lay’s use of his voice (albeit by an imitator) precisely because Waits had projected an image as being against commercial endorsements. Similarly, many of the musicians whose songs are used in political campaigns project certain images that do not go hand-in-hand with what the politician is endorsing. For example, when Trump used Sir Elton John’s hit song \textit{Rocket Man} at rallies, John lashed out, stating “I don’t really want my music to be involved in anything to do with an American election campaign. I’m British . . . I’m not a Republican in a million years. Why not ask Ted f***ing Nugent? Or one of those f***ing country stars? They’ll do it for you.”\textsuperscript{79} Added one of John’s spokespeople, “[a]ny use of [Elton’s] music should not be seen as an endorsement of Donald Trump.”\textsuperscript{80} Likewise, singer K’naan sought to secure his image immediately after Romney used his song \textit{Wavin’ Flag}. K’naan took to Twitter to voice his displeasure, stating “Yo @mittromney I am K’naan Warsame and I do not endorse this message.”\textsuperscript{81} K’naan also explained, “I’m for immigrants. I’m for poor people, and they don’t seem to be what he’s endorsing.”\textsuperscript{82} Clearly, these musicians have a certain persona (their mark) that they are trying to protect. Again, it’s the \textit{identity} that is at issue—not just a single one-time performance as was the case in \textit{Oliveira}.

\textsuperscript{78} Id. at 62.

\textsuperscript{79} See Chilton, supra note 17. Trump had also used other songs of John’s at rallies including \textit{Tiny Dancer}. Id.

\textsuperscript{80} Id.


\textsuperscript{82} See Chao, supra note 12.
Furthermore, Waits’ distinct voice was a part of his identity—his mark—that was misused by Frito-Lay, thereby falsely associating that part of Waits’ identity with Frito-Lay’s commercial. In Midler v. Ford Motor Co.—a case remarkably similar to Waits—the Ninth Circuit addressed how voice can be inherent to one’s identity, stating:

[a] voice is as distinctive and personal as a face. The human voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone. At a philosophical level it has been observed that with the sound of a voice, ‘the other stands before me.’ . . . [T]hese observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity.83

Thus, courts have found that a voice is intertwined, if not synonymous, with the celebrity’s identity. That identity is the celebrity’s “mark” in the context of a false endorsement claim. Certainly Sir Elton John’s identity is readily revealed by his distinct voice, as would be many voices of the musicians referenced in this article.

Again, another article addressing this topic considered whether the musician might have a cause of action under trademark law against the politician, but it considered the issue under a “song-mark” protection theory.84 In other words, the article contemplated whether a particular performance or song could be considered a trademark, thereby protecting the musician associated with the song or performance.85 However, such was already contemplated by the Oliveira court, which found that a single signature song, considered alone, cannot form the basis of a false endorsement claim.86


84. Podlas, supra note 20, at 22–3 (addressing whether a political campaign’s use of a song without the permission of its performer infringes on any trademark rights of the performer).

85. See id. at 2 (concluding that while, in theory, song-based trademark could exist, in practice, it would either fail to acquire appropriate secondary meaning or be precluded—if not preempted—by copyright law).

While the article discussing “song-mark” protection acknowledges **Waits** as well as a similar case from the Third Circuit, *Facenda v. N.F.L. Films, Inc.*, it states “[i]t is important to keep in mind that these decisions did not grant the performer a trademark in a song . . . [Rather, they] allowed an established commercial service to be marked with a distinctive sound (voice) recognized by the public as designating that performer’s services.” However, voice is part of the musician’s identity, and trademark protection under the Lanham Act includes goods and services.

The article continues, “[a]lthough a unique voice like Facenda’s or [Waits’], recognizable independent of context or the foundational copyrighted work, can serve as a mark, it does not mean that most voices can. These plaintiffs were well-known vocal performers with unique vocal qualities.” But well-known vocal performers are precisely who we are concerned with. Most politicians are not using unheard of songs by unheard of artists. Indeed, popular artists complaining about the politicians’ use of their songs is a reoccurring theme from year to year. Moreover, Sir Elton John, The Rolling Stones, Adele, and Neil Young are all well known with unique vocal qualities. Their voices, after all, are what helped catapult them to fame.

The article concludes, “with ‘Autotune’ and contemporary production techniques, today’s singers are often indistinguishable or recognized in relation to a record rather than due to some unusual vocal quality. Therefore, voice alone is not presumptively distinct, and even when it is, that does not prove audience recognition.” However, Autotune could actually weigh in favor of the musician asserting a false endorsement claim. Autotune can help *imitators* sound more like the musician, which would place our hypothetical directly on par with **Waits** and **Midler**. We are not necessarily concerned about the musician using Autotune as we are with the imitators using it.

As evidenced, false endorsement is quite different from trademark in a single song. For false endorsement, the celebrity’s identity is the equivalent of

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87. 542 F.3d 1007, 1023-25 (3d Cir. 2008) (finding that genuine issues of material fact existed as to whether professional football league defendants’ use of recordings of narrator’s “legendary” voice in cable-television production about football video game was likely to cause confusion among consumers regarding narrator’s sponsorship or approval of the game, precluding summary judgment on Lanham Act claim for false endorsement).

88. Podlas, supra note 20, at 17-18.

89. Id. at 18.

90. See supra notes 17-18.

91. Podlas, supra note 20, at 18.
the mark—not the particular performance or song. Considering Waits, Midler, and Facenda, even if the politician’s song use was singular, the plaintiff-musician’s false endorsement claim might still prevail when the musician’s voice is truly distinct.

Additionally, the context of the politician’s use might weigh in favor of the musician’s false endorsement claim. In Beastie Boys v. Monster Energy Co., for example, Monster created a four-minute promotional video that aired on YouTube. The video consisted of footage from an event Monster sponsored called “Ruckus in the Rockies.” The footage included a road trip to Lake Louise, scenes from a snowboarding competition, and an after-party. Monster’s green logo was ubiquitous in the video, appearing on apparel, snowboarding ramps, banners that surrounded the snowboarding course, and cans of Monster energy drinks. The Beastie Boys’ music was also ubiquitous as the video’s soundtrack consisted of excerpts from five Beastie Boys songs. The video did not contain any voice-overs, narration, or interviews—the Beastie Boys’ music, which filled all but 32 seconds of the video, was the “main aural event.”

The Beastie Boys brought claims against Monster for copyright infringement and false endorsement. After a jury found for The Beastie Boys on both claims, Monster moved for judgment as a matter of law for a new trial. Monster, relying upon Oliveira, argued that the jury was not permitted to consider the use of the Beastie Boys’ copyrighted music in the video and instead should have been limited to considering only the video’s textual use of the band’s name and a name of a Beastie Boys member “MCA.” These textual snippets, contended Monster, were not enough to support a finding of false endorsement. The United States District Court for the Southern District of New York, however, disagreed. It stated, “a jury could easily conclude that Monster used the Beastie Boys persona to suggest, misleadingly, that the band

93. Id. at 428.
94. Id.
95. Id.
96. Id.
97. Id. at 427.
98. Id.
99. Id. at 450-51.
100. Id. at 451.
was endorsing Monster Energy. The ubiquity of the band’s music ‘unquestionably br[ought] to mind’ the Beastie Boys, and the use of the names ‘Beastie Boys’ and ‘MCA’ in the credits drove the point home."\(^{101}\) Therefore, the court found there was sufficient evidence to establish the Beastie Boys’ false endorsement claim.\(^{102}\)

Furthermore, in refuting Monster’s argument on the merits, the court found that Oliveira and its progeny did not bar a finding of false endorsement.\(^{103}\) The court reasoned that The Beastie Boys did not base their claim of false endorsement on Monster’s use of a single Beastie Boys song in an advertisement.\(^{104}\) Instead, Monster’s promotional video incorporated a variety of elements referencing the Beastie Boys—extensive excerpts from not one but five songs, a textual reference to the Beastie Boys, and another reference (“RIP MCA”) to the well-known stage name of one of the band’s three members.\(^{105}\) The Beastie Boys contended—and the court agreed—that the use of these elements, “synergistically and in combination, associated the band with Monster and its products in the minds of viewers of the video, constituting an endorsement.”\(^{106}\) The court stated, “[a]lthough Oliveira precludes an artist from claiming false endorsement based solely on the use of a single song, that decision does not speak to the circumstance in which such use is claimed to be one part of a broader effort to falsely convey an endorsement by the artist of a product or company.”\(^{107}\)

Thus, when looking at the context of the defendant’s use, as the court did in Beastie Boys, we can see how the plaintiff-musician’s false endorsement claim might be strengthened. Again, the Beastie Boys court considered not only Monster’s use of The Beastie Boys’ songs in the video, but also the fact that the video contained more than one Beastie Boys song as well as a reference to a band member’s name. Similarly, Trump not only has used popular musicians’ songs in his campaign, but he has used more than one song by a particular artist or band. For example, Trump used The Rolling Stones’ songs You Can’t Always

\(^{101}\) Id. at 450 (citing Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 205 (2d Cir. 1979)).

\(^{102}\) Id.

\(^{103}\) Id. at 452.

\(^{104}\) Id. at 453.

\(^{105}\) Id.

\(^{106}\) Id.

\(^{107}\) Id. (emphasis added).
Get What You Want, Sympathy for the Devil, and Brown Sugar at campaign events.\textsuperscript{108} Likewise, Trump used multiple songs of Sir Elton John’s including Rocket Man and Tiny Dancer at rallies.\textsuperscript{109} Furthermore, just as Monster referred to a band member’s name in its video, Trump’s team referred to Sir Elton John’s name in its campaign, stating that John would be performing at Trump’s inauguration.\textsuperscript{110} Not surprisingly, John went public to confirm that he would not, in fact, be performing at Trump’s inauguration.\textsuperscript{111}

Trump’s repetitive song use is not unique to him either. Indeed, politicians favor using certain songs over and over as the songs almost become “themes” of their campaigns. Such use is certainly not a one-time situation, as was the case in Oliveira. Multiple uses and reference to the celebrities’ names were sufficient in distinguishing Beastie Boys from Oliveira, and it could very well be sufficient for our hypothetical. In other words, when the politician’s use is but one part of a broader effect that associates the musician with his campaign, we see how the musician’s identity can be implicated. Accordingly, when such use is present, it is not a stretch for the musician to claim that the politician is falsely associating his identity as an endorser of the candidate.

Moreover, unlike with traditional false advertising claims, the celebrity need not be a competitor of the defendant to assert a false endorsement claim.\textsuperscript{112} To have standing under the Lanham Act, the Ninth Circuit declared, “the plaintiff need not be in actual competition with the alleged wrongdoer.”\textsuperscript{113} “Rather, the ‘dispositive question’ in determining standing is whether the plaintiff ‘has a reasonable interest to be protected against false advertising.’”\textsuperscript{114} The Ninth Circuit concluded that, “like a trademark holder, an actor has a ‘reasonable interest’ in having his work product properly identified with his name, and therefore the plaintiff has standing under section 43(a).”\textsuperscript{115} In our case, “musician” can just as easily be inserted in the place of “actor” because the

\textsuperscript{108} Henderson, supra note 4.  
\textsuperscript{110} Id.  
\textsuperscript{111} See id.  
\textsuperscript{112} See Waits v. Frito-Lay, Inc., 978 F.2d 1093, 1108 (9th Cir. 1992).  
\textsuperscript{113} Id. (citing Smith v. Montoro, 648 F.2d 602, 607 (9th Cir. 1981)).  
\textsuperscript{114} Id. (citing Smith v. Montoro, 648 F.2d 602, 608 (9th Cir. 1981)).  
\textsuperscript{115} Id.
artist-musician has the same reasonable interest as the actor does in having his work product identified with his name. Thus, our plaintiff-musician does not need to be in direct competition with the politician to assert a false endorsement claim. This standing component only solidifies the fact that the musician has a mark that warrants legal protection.

B. Likelihood of Confusion

With the musician’s mark legally recognized, the next step in assessing whether he has a successful false endorsement claim against the politician is determining whether a likelihood of confusion exists. In other words, would the politician’s use of the mark likely confuse or mislead the public into thinking that the musician endorses the politician. Again, in the ordinary false endorsement claim, this is the controlling issue.

To assess likelihood of confusion, the Ninth Circuit considers and weighs the following factors: (1) the level of recognition the plaintiff has among the segment of the society for whom the defendant’s product is intended (also called the strength of the plaintiff’s mark); (2) the relatedness of the plaintiff’s fame or success to the defendant’s product; (3) the similarity of the likeness used by the defendant to the actual plaintiff; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant’s intent on selecting the plaintiff; and (8) likelihood of expansion of the product lines.

Although these are all factors that are appropriate for consideration in determining whether likelihood of confusion exists, they are not necessarily of equal importance, nor do they necessarily apply to every case.

116. See Commerce Nat’l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc., 214 F.3d 432, 437 (3d Cir. 2000) (listing the three prongs of a false endorsement claim under § 43(a) of the Lanham Act). In regard to the second prong (ownership of the mark), it is readily assumed that the celebrity owns his own identity or persona.

117. See Landham v. Lewis Galoob Toys, Inc., 227 F.3d 619, 626 (6th Cir. 2000); Wynn Oil Co. v. Thomas, 839 F.2d 1183, 1186 (6th Cir. 1988).

118. Downing v. Abercrombie & Fitch, 265 F.3d 994, 1007-08 (9th Cir. 2001).

119. Other circuits have adopted a modified version of the Ninth Circuit’s eight-factor Downing test. See, e.g., Facenda v. N.F.L. Films, Inc., 542 F.3d 1007, 1020, 1025 (applying a modified version of the Downing test. “[W]e hold that the Downing factors retain the substance of Lapp while appropriately tailoring the language to false endorsement claims.” The application of the Downing factors is a question of fact.).

120. Downing, 265 F.3d at 1008.
Going back to Waits, the jury listened to numerous Tom Waits recordings. The jury also listened to a recording of the Doritos commercial in which the Tom Waits impersonator delivered a “hip” endorsement of SalsaRio Doritos: “It’s buffo, boffo, bravo, gung-ho, tally-ho, but never mellow. . . . try ‘em, buy ‘em, get ‘em, got ‘em.” The jury also considered the fact that the Doritos commercial was targeted to an audience that overlapped with Waits’ audience—males between the ages of 18 to 35 who listened to the radio. Finally, evidence of actual consumer confusion existed because numerous witnesses testified that they actually believed it was Tom Waits singing in the commercial. Accordingly, this evidence sufficiently supported the jury’s finding that the commercial would likely mislead consumers into believing that Waits endorsed SalsaRio Doritos.

In our case, a jury could likewise find likelihood of confusion because of the strength of the musicians’ marks. “Mark” means the “celebrity’s persona,” and its “strength” refers to “the level of recognition the celebrity enjoys among members of society.” If the politician directs his campaign to a segment of the public who does not know the musician, then that segment could not be confused as to whether the musician is endorsing the politician. Conversely, if the musician is well-known, the possibility of a likelihood of confusion arises. There is little doubt that a jury would find that Sir Elton John, Adele, Neil Young, and all of the other musicians mentioned in this article have “strong marks.” They all have enjoyed tremendous world-wide success in the music industry and are recognized in many segments of the public—including those segments where the politicians direct their campaigns.

Also weighing in the musician’s favor is the third factor—the similarity of the likeness used by the defendant to the actual plaintiff. The jury in Waits considered this factor and found confusion existed because the imitator

122. Id.
123. Id.
124. Id.
126. Id. (citing Academy of Motion Picture Arts v. Creative House, 944 F.2d 1446, 1455 (9th Cir. 1991)).
127. See id.
128. See id.
sounded just like Waits. But the musician in our hypothetical has an even stronger case than Waits did because the politician is using the recording that contains the actual musician’s voice.

Next, and perhaps most importantly, there is evidence of actual confusion. In an action brought under section 43(a) of the Lanham Act for trademark infringement, a plaintiff need not provide proof of actual confusion—he need only show likelihood of confusion.129 However, “there can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion.”130 While “very little proof of actual confusion would be necessary to prove the likelihood of confusion, an almost overwhelming amount of such proof would be necessary to refute such proof.”131 With the ever-increasing popularity and innovativeness of social media, it would not be difficult for the musician to prove actual confusion—one need only look to the social media feeds. As noted above, K’naan complained that he “got a flood of Twitter messages from people who assumed . . . that [he] was now a supporter of Mitt Romney’s campaign.”132

Additionally, even where the public is aware of the celebrity’s opposition to the defendant, actual confusion sometimes still exists. In Waits, before Frito-Lay aired the spot, its ad agency mentioned how Waits actually was known to have a publicly avowed policy against doing commercial endorsements and had expressed his disapproval of artists who did.133 Despite the ad company having this knowledge, and despite Frito-Lay executives expressing legal concerns to their attorney, Frito-Lay aired the commercial nationwide.134 Though Waits’ disassociation with ad endorsements was widely known, the jury still found that a likelihood of confusion existed as to whether Waits endorsed the Doritos product.

Similarly, Sir Elton John, Neil Young, and K’naan all have made their particular political viewpoints publicly known. These musicians are known

131. Id. (quoting Savin Corp. v. Savin Grp., 391 F.3d 439, 459 (2d Cir. 2004) ).
134. Id.
world-wide and have thousands of social media followers. Fans of musicians nowadays might have even more insight into the musicians’ likes and dislikes given the musician-to-fan connectivity inherent to social media forums. Fans can send messages directly to the musician to which the musician can respond or not respond. The musicians also can post daily messages regarding their music as well as their personal beliefs. Nonetheless, actual confusion from their fan-base can still abound, as noted by K’naan. The musicians’ followers have noted and can continue to note their actual confusion in real-time on the musicians’ social media pages. These fan posts might very well serve as the modern-day surveys typically used by plaintiffs who wish to prove actual confusion. Regardless of the method used to capture the public’s comments, it is evident that actual confusion does exist in this context.

The “marketing channels used” factor could also weigh in favor of a likelihood of confusion. The usual analysis for this factor focuses on whether the defendant used marketing channels in which the plaintiff’s endorsements are likely to appear. In other words, would the products the plaintiff actually endorsed be marketed through the same channels and media that the defendant used? Political campaign events, including debates and ads, are broadcast on national news channels—stations that also might air concerts wherein the musician performs. Though radio is the musician’s typical marketing channel, this does not detract from the fact that the politician can still use marketing channels shared by the musician.

Finally, the factor concerning “defendant’s intent” helps tip the scales in the musician’s favor. The relevant question is whether the defendant “intend[s] to profit by confusing consumers” concerning the endorsement of the defendant’s product. In White v. Samsung Electronics America, Inc., for example, Vanna


136. Facenda v. N.F.L. Films, Inc., 542 F.3d 1007, 1025 n.10 (3d Cir. 2008) (citing White v. Samsung Elecs. America, Inc., 971 F.2d 1395, 1400 (9th Cir. 1992) (focusing on the extent to which products the plaintiff actually endorsed were marketed through the same channels and media in which the defendant’s alleged unauthorized use of the plaintiff’s likeness occurred)).


138. See White v. Samsung Elecs. America, Inc., 971 F.2d 1395, 1400 (9th Cir. 1992) (citing Toho Co., Ltd. v. Sears, Roebuck & Co., 645 F.2d 788 (9th Cir. 1981)).
White, the hostess of the popular game show “Wheel of Fortune,” brought, among other things, a false endorsement claim against Samsung.\textsuperscript{139} Samsung had produced an advertisement using a robot dressed in a wig, gown, and jewelry that resembled White’s hair and dress.\textsuperscript{140} “The robot was posed next to a game board [that] was instantly recognizable as the Wheel of Fortune game show set, in a stance for which White is famous.”\textsuperscript{141} The court found that while Samsung might have intended to spoof Vanna White and “Wheel of Fortune,” that did not preclude the possibility that Samsung also intended to confuse consumers regarding endorsement.\textsuperscript{142} The court reasoned:

the robot ad was one of a series of ads run by [Samsung,] which followed the same theme. Another ad in the series depicted Morton Downey Jr. as a presidential candidate in the year 2008. Doubtless, defendants intended to spoof presidential elections and Mr. Downey through this ad. Consumers, however, would likely believe, and would be correct in so believing, that Mr. Downey was paid for his permission and was endorsing Samsung products. Looking at the series of advertisements as a whole, a jury could reasonably conclude that beneath the surface humor of the series lay an intent to persuade consumers that celebrity Vanna White, like celebrity Downey, was endorsing Samsung products.\textsuperscript{143}

Here, Trump repeatedly has used songs by Elton John and The Rolling Stones throughout his campaign. Trump even suggested that John would sing at his inauguration.\textsuperscript{144} Also, a politician such as Trump might intend to appeal to an audience that doesn’t typically support him (i.e., Democrats). A song by a liberal artist such as Elton John or even by a younger artist such as Adele might make Trump appear “hip” and appeal to a younger, liberal audience. Thus, a jury could find that the defendant-politician has an intent in selecting a particular musician’s song.

Though the remaining factors not analyzed might not weigh in favor of likelihood of confusion, they don’t have to. Again, this element of a false endorsement claim is fact-based where a jury considers the totality of the

\begin{itemize}
  \item[139.] Id. at 1399.
  \item[140.] Id. at 1396.
  \item[141.] Id.
  \item[142.] Id. at 1400-01.
  \item[143.] Id. at 1401.
  \item[144.] Brucculieri, supra note 109.
\end{itemize}
The factors used to assess likelihood of confusion are not necessarily of equal importance, nor do they necessarily apply to every case. The likelihood of confusion finding in Waits was supported by the strength of the mark, similarity of the marks (or similarity of the likeness used by the defendant to the actual plaintiff), evidence of actual confusion, marketing channels used, and intent in selecting marks. The same can be said here thereby further supporting the plaintiff-musician’s false endorsement claim. However, the defendant-politician can assert various defenses.

C. Defenses to a False Endorsement Claim

False endorsement defenses include the following arguments: free speech protects the the use, the goods or services are not being used in commerce as required under the Lanham Act, or the politician and musician are not in direct competition with each other.

First, free-speech interests protected under the First Amendment may be a defense to a claim of false endorsement. “Where the defendant has articulated a colorable claim that the use of a celebrity’s identity is protected by the First Amendment, the likelihood of confusion test is not appropriate because it fails to adequately consider the interests protected by the First Amendment.” In Rogers v. Grimaldi, for example, Ginger Rogers, the surviving member of one of the most famous duos in show business history, brought suit against the producers and distributors of a movie titled Ginger and Fred. The film was not about Ginger Rogers and Fred Astaire, but about two fictional Italian cabaret performers who imitated Rogers and Astaire and became known in Italy as “Ginger and Fred.” Rogers asserted claims under section 43(a) of the Lanham Act. The Second Circuit began its analysis by noting that “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection.” The court concluded that “[b]ecause

146. Downing v. Abercrombie & Fitch, 265 F.3d 994, 1008 (9th Cir. 2001).
147. See Waits, 978 F.2d at 1111.
148. J. THOMAS McCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 5:31 (2d ed. 2017) (citing Brown v. Elec. Arts, Inc., 724 F.3d 1235, 1239 (9th Cir. 2013) (“Section 43(a) protects the public’s interest in being free from consumer confusion about affiliations and endorsements, but this protection is limited by the First Amendment, particularly if the product involved is an expressive work.”)).
149. ETW Corp. v. Jireh Pub., Inc., 332 F.3d 915, 926 (6th Cir. 2003).
150. See generally Rogers v. Grimaldi, 875 F.2d 994 (2d Cir. 1989).
151. Id. at 997.
overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.\(^\text{152}\)

From this case came the “Rogers test,” which most courts use when analyzing a free speech defense to a false endorsement charge.\(^\text{153}\) Under this test, “an accused use of plaintiff’s identity in an expressive work, such as a movie or song, will be immune as expressive free speech unless it has ‘no artistic relevance’ to the underlying work or, if there is artistic relevance, the accused use ‘explicitly misleads as to the source or the content of the work.’”\(^\text{154}\)

But the Sixth Circuit has cautioned: “[T]he First Amendment cannot permit anyone who cries ‘artist’ to have carte blanche when it comes to naming and advertising his or her works, art though it may be.”\(^\text{155}\) In Browne v. McCain, for example, the plaintiff Jackson Browne’s Lanham Act claim prevailed against the First Amendment defense of Senator John McCain.\(^\text{156}\) Browne, a singer and songwriter, is closely associated with liberal causes and Democratic political candidates.\(^\text{157}\) His public support for the Democratic Party and President Barack Obama is well known, having performed at rallies for Democratic candidates.\(^\text{158}\) Browne released an album in 1977 titled Running on Empty, which contained a composition of the same name.\(^\text{159}\) The album was a success, reaching platinum status seven times over, and Browne became famously associated with the album and composition.\(^\text{160}\)\(^\text{161}\) McCain, a Republican, decided to use a portion of the composition in a campaign commercial, which was viewable on YouTube and television and cable networks.\(^\text{162}\) But neither Senator McCain, the Ohio Republican Party, nor the Republican National Committee received a license or

\(\text{152}\) Id. at 998.

\(\text{153}\) McCarthy, supra, at § 5:31 (citing Rogers, 875 F.2d at 999).

\(\text{154}\) Id.

\(\text{155}\) Id. (citing Parks v. LaFace Records, 329 F.3d 437, 447 (6th Cir. 2003)).

\(\text{156}\) See generally 611 F. Supp. 2d 1073 (C.D. Cal. 2009).

\(\text{157}\) Id.

\(\text{158}\) Id.

\(\text{159}\) Id.


\(\text{161}\) Id.

\(\text{162}\) Id. at 1076.
permission from Browne, who owns a federally registered copyright in the composition.\(^{163}\)

Since the commercial first appeared on television and the Internet, Browne received numerous inquiries expressing concern about McCain’s use of the composition.\(^{164}\) Browne argued that the commercial falsely suggested his sponsorship, endorsement, or association with Senator McCain and the Republican Party, “when nothing could be further from the truth.”\(^{165}\) As a result, Browne sued McCain, the Ohio Republican Party, and the Republican National Committee on August 14, 2008 for (1) copyright infringement, (2) vicarious copyright infringement, (3) violation of the Lanham Act (false association or endorsement), and (4) violation of California common law right of publicity.\(^{166}\)

Senator McCain argued that the court should dismiss Browne’s Lanham Act claim because (1) the Lanham Act applies only to commercial speech, and (2) the First Amendment and artistic relevance test bar the claim.\(^{167}\) The District Court for the Central District of California, however, disagreed.\(^{168}\) The court first recognized that the Lanham Act applies to noncommercial (i.e., political) and commercial speech.\(^{169}\) “Indeed, the Act’s purpose of reducing consumer confusion supports application of the Act to political speech, where the consequences of widespread confusion as to the source of such speech could be dire.”\(^{170}\) Thus, the court rejected Senator McCain’s argument that the Lanham Act applies only to commercial speech.\(^{171}\)

The court then rejected Senator McCain’s contention that Browne could not state a claim under the Lanham Act because the commercial was an expressive work thus barring the claim under the First Amendment and artistic relevance.
The court reasoned that “in the Ninth Circuit, a Lanham Act claim based on use of a mark in an artistic work is analyzed under the Second Circuit’s Rogers artistic relevance test, which was developed to address the competing interests of the First Amendment’s protection of artistic works and trademark protection.” Under Rogers, “an artistic work’s use of a trademark that otherwise would violate the Lanham Act is not actionable [1] ‘unless the use of the mark has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless it explicitly misleads as to the source or content of the work.’” Thus, neither the First Amendment nor the Rogers test barred Browne’s Lanham Act claims.

Additionally, the Browne court rejected McCain’s argument that Browne could not state a claim under the Lanham Act because he had not shown actual use in commerce. The court noted that “the Lanham Act’s reference to use ‘in commerce’ does not require a plaintiff who asserts a claim under section 43(a)(1)(A) to show that the defendant actually used the mark in commerce.” Rather, this reference “actually ‘reflects Congress’s intent to legislate to the limits of its authority under the Commerce Clause’ to regulate interstate commerce.” The interstate commerce component only requires a party to show that the defendant’s conduct “affects interstate commerce, such as through diminishing the plaintiff’s ability to control use of the mark, thereby affecting the mark and its relationship to interstate commerce.” Therefore, the “‘scope of “in commerce” as a jurisdictional predicate of the Lanham Act is broad and has a sweeping reach.”

Finally, as discussed infra at part II.A., the plaintiff does not have to be in direct competition with the defendant to bring a false endorsement claim.

173. Id. (citing Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 902 (9th Cir. 2002)).
174. Id. (citing E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc., 547 F.3d 1095, 1099 (9th Cir. 2008)).
175. Id. at 1079-80.
176. Id. at 1079 (citing United We Stand America, Inc., 128 F.3d at 92).
177. Id.
178. Id. (citing Stauffer v. Exley, 184 F.2d 962, 964–67 (9th Cir. 1950)).
A false endorsement claim that is based on the unauthorized use of a celebrity’s identity is a type of false association claim. It “alleges the misuse of a trademark, i.e., a symbol or device such as a visual likeness, vocal imitation, or other uniquely distinguishing characteristic, which is likely to confuse consumers as to the plaintiff’s sponsorship or approval of the product.”

Therefore, “actual competition” is not required for standing. Rather, standing “extends to a purported endorser who has an economic interest akin to that of a trademark holder in controlling the commercial exploitation of his or her identity.”

In sum, the plaintiff-musician can bring a false endorsement claim against the defendant-politician because the “mark” at issue is his identity. Not only is this mark legally protectable, but the public could likely be confused as to whether the musician endorses the politician when the politician misappropriates that mark. Furthermore, the politician has standing to bring his claim, which likely will not be barred by the politician’s defenses. But what about right of publicity as a cause of action?

IV. RIGHT OF PUBLICITY AS A CAUSE OF ACTION

Right of publicity is a state-based right that everyone possesses. It is best defined as “the inherent right of every human being to control the commercial use of his or her identity.” What originally was known as a “right to privacy”—i.e., the right to be left alone—now, the right of publicity is not so much about being left alone as it is about recognizing the right of a person to control the use of his or her persona.

181. Id. at 1110.

182. Id. (citing Allen v. Nat’l Video, 610 F. Supp. 612, 625, 628 (S.D.N.Y. 1985) (celebrity’s interest in the marketing value of his identity is similar to that of a trademark holder, and its misuse through evocation of celebrity’s persona that creates likelihood of consumer confusion as to celebrity’s endorsement is actionable under Lanham Act)).


184. Id.

185. The right of publicity sprang up out of the common law. Two law review articles, one by Samuel D. Warren and Louis D. Brandeis and another by Professor William Prosser, were particularly influential in shaping the origins of the right of publicity. See Samuel D. Warren & Louis D. Brandeis, The Right to Privacy, 4 HARV. L. REV. 193 (1890) (calling for judicial recognition of a “right to be let alone”); see Prosser, Privacy, 48 CALIF. L. REV. 383 (1960) (identifying four privacy interests: (1) intrusion upon the plaintiff’s seclusion or solitude, or into his private affairs; (2) public disclosure of embarrassing private facts about the plaintiff; (3) publicity that places the plaintiff in a false light in the public eye; and (4) appropriation, for the defendant’s advantage, of the plaintiff’s name or likeness.). Professor Prosser’s theory of the “four torts” worked its way
To establish this cause of action, the plaintiff must prove (1) the validity of his or her right of publicity; and (2) that this right has been infringed upon by the defendant(s). Because right of publicity is a state-based right derived from the common law, its elements to prove the second prong of this test vary from state to state. Generally, though, to establish a common law right of publicity claim or the appropriation of a name or identity, a plaintiff must show “(1) the defendant’s use of the plaintiff’s identity; (2) the appropriation of plaintiff’s name or likeness to defendant’s advantage, commercially or otherwise; (3) lack of consent; and (4) resulting injury.”

Though the right of publicity elements above speak in terms of an appropriation of plaintiff’s “name or likeness,” right of publicity is not so confined. Right of publicity claims have been successful in cases where the defendant appropriated the plaintiff’s identities without using the obvious means of using the plaintiff’s name or likeness. In *Motschenbacher v. R.J. Reynolds Co.*, for example, R.J. Reynolds had used a photograph of

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187. See supra notes 185-87 and accompanying text.

188. See White v. Samsung Elecs. America, Inc., 971 F.2d 1395, 1397 (9th Cir. 1992) (quoting Eastwood v. Superior Court, 149 Cal. App. 3d 409 (Cal. App. 2d Dist. 1983) superseded by statute on other grounds as recognized by KNB Enters. v. Matthews, 78 Cal. App. 4th 362, 367 (Cal. App. 2d Dist. 2000)). Courts have more recently been following the definition and elements in the Restatement, which requires the plaintiff to prove that: (1) defendant, without permission, has used some aspect of identity or persona in such a way that plaintiff is identifiable from defendant’s use; and (2) defendant’s use is likely to cause damage to the commercial value of that persona. Thus, under the Restatement version, a plaintiff is not required to show that the defendant obtained a commercial advantage. Additionally, the Restatement version more specifically states that the injury is to the commercial value of the persona whereas the injury for appropriation is left open-ended as to whether the damages are commercial or to the psyche. Nevertheless, if a fact pattern satisfies one version, it should also satisfy the other version of the test. See Thomas Phillip Boggess V, *Cause of Action for an Infringement of the Right of Publicity*, 31 Causes of Action 2d 121.

189. Prosser recognized that right of publicity cases involved one of two basic factual scenarios: name appropriation, and picture or likeness appropriation, but had only looked at case law to that date. *White*, 971 F.2d at 1397 (citing Prosser, *Privacy*, 48 CAL.L.REV. 383, 401-02, nn. 156-57).

190. *White*, 971 F.2d at 1397.

191. See id. at 1398.
Motschenbacher’s race car in a television commercial.\textsuperscript{192} Although Motschenbacher appeared to be driving the car in the photograph, his features were not visible.\textsuperscript{193} However, the markings on the car were not only peculiar to Motschenbacher’s cars, but they caused some people to think the car in question was Motschenbacher’s and to infer that the person driving the car was Motschenbacher.\textsuperscript{194} Even though R.J. Reynolds had not appropriated Motschenbacher’s name or likeness, the Ninth Circuit held that Motschenbacher’s California right of publicity claim should reach the jury.\textsuperscript{195}

In \textit{Midler v. Ford Motor Co.}, a former back-up singer to Bette Midler was hired to record \textit{Do You Want to Dance}?—a song made famous by Midler.\textsuperscript{196} Ford Motor Co. instructed the back-up singer to imitate Midler’s voice as closely as possible for a radio commercial.\textsuperscript{197} The ad agency had properly acquired the rights to the song from the copyright holder and did not use either Midler’s name or picture in the advertisement.\textsuperscript{198} The district court held that there was “no legal principle preventing imitation of Midler’s voice” and granted summary judgment for Ford.\textsuperscript{199} The Ninth Circuit, however, disagreed, holding that even though the defendants had not used Midler’s name or likeness, Midler had stated a claim for violation of her California common law right of publicity. The court reasoned that “the defendants . . . for their own profit in selling their product did appropriate part of her identity” by using a Midler sound-alike and that to impersonate Midler’s voice was akin to pirating her identity.\textsuperscript{200}

In \textit{Carson v. Here’s Johnny Portable Toilets, Inc.}, the defendant-corporation Here’s Johnny Portable Toilets had marketed portable toilets under the brand name “Here’s Johnny”—Johnny Carson’s signature “Tonight Show” introduction—without Carson’s permission.\textsuperscript{201} The district court had dismissed

\begin{footnotesize}
\begin{itemize}
\item 192. See generally 498 F.2d 821 (9th Cir. 1974).
\item 193. Id. at 822.
\item 194. Id. at 827.
\item 195. Id.
\item 196. See generally 849 F.2d. 460 (9th Cir. 1988).
\item 197. Id. at 461.
\item 198. Id. at 462.
\item 199. Id.
\item 200. Id. at 463-64.
\item 201. 698 F.2d 831, 832-33 (6th Cir. 1983).
\end{itemize}
\end{footnotesize}
Carson’s Michigan common law right of publicity claim because the defendants had not used Carson’s “name or likeness.”\textsuperscript{202} In reversing the district court, the Sixth Circuit found “the district court’s conception of the right of publicity . . . too narrow” and held that the right was implicated because the defendant had appropriated Carson’s identity by using, \textit{inter alia}, the phrase “Here’s Johnny.”\textsuperscript{203}

Thus, “it is not important \textit{how} the defendant has appropriated the plaintiff’s identity, but \textit{whether} the defendant has done so.”\textsuperscript{204} What is important is that the defendants’ actions “directly implicate the commercial interests[,] which the right of publicity is designed to protect.”\textsuperscript{205} Because a celebrity’s identity can have value, the celebrity should be able to protect that interest through a right of publicity. That right is invaded when the celebrity’s identity is commercially exploited, whether or not his “name or likeness” is used.\textsuperscript{206}

The musician, therefore, could assert his right of publicity and even be successful in stopping the politician from appropriating his identity. First, it should not matter that the politician is only playing the song and thereby not using the musician’s name or likeness. Under the aforementioned case law, right of publicity claims can involve more than the obvious use of the musician’s name or likeness.

Second, by using the musician’s song, the politician directly implicates commercial interests the musician is trying to protect. Musicians tend to feel they have a certain image to uphold—an image that helps sell albums. And when a Republican candidate, for example, uses a liberal musician’s song, the musician could feel his image is in jeopardy. As noted in \textit{Waits}, “the jury could have inferred from the evidence that the commercial created a public impression that Waits was a hypocrite for endorsing Doritos. Moreover, it also could have inferred damage to his artistic reputation, for Waits had testified that ‘part of my character and personality and image that I have cultivated is that I do not endorse products.’”\textsuperscript{207} Again, Sir Elton John expressed similar complaints as Waits when Trump used John’s hit song \textit{Rocket Man} at rallies.

\begin{itemize}
\item \textsuperscript{202} \textit{Id.} at 835.
\item \textsuperscript{203} \textit{Id.} at 835–37.
\item \textsuperscript{204} \textit{White v. Samsung Elecs. America, Inc.}, 971 F.2d 1395, 1398 (9th Cir. 1992).
\item \textsuperscript{205} \textit{Id.}
\item \textsuperscript{206} \textit{Id.} (quoting \textit{Carson}, 698 F.2d at 835).
\item \textsuperscript{207} \textit{Waits v. Frito-Lay, Inc.}, 978 F.2d 1093, 1104 (9th Cir. 1992).
\end{itemize}
stating “I don’t really want my music to be involved in anything to do with an American election campaign. I’m British . . . I’m not a Republican in a million years.”208 Likewise, K’naan’s public statement after Romney used his song Wavin’ Flag further illustrates how the musician is protecting a commercial interest: “I’m for immigrants. I’m for poor people, and they don’t seem to be what he’s endorsing.”209 Indeed, reputational damages have been awarded in right of publicity cases.210 Thus, it is evident that the musician has an interest that may be protected from the politician’s exploitation of that identity. As the Ninth Circuit has noted, “[c]onsiderable energy and ingenuity are expended by those who have achieved celebrity value to exploit it for profit. The law protects the celebrity’s sole right to exploit this value whether the celebrity has achieved her fame out of rare ability, dumb luck, or a combination thereof.”211

Though a right of publicity argument might work for the musician, this is only true when the politician has not properly acquired a copyright license to use the song. The same does not necessarily hold true for when the politician has acquired a license. Again, this article’s focus is on when the politician has in fact obtained a copyright license to use the song, what intellectual property rights does the musician nonetheless have. And when the politician has a license to use the song, the musician’s state-based right of publicity claim could very well be preempted by federal copyright law.

V. PREEMPTION ISSUES WITH RIGHT OF PUBLICITY

Federal copyright law naturally intersects with the state-based right of publicity. Again, a copyrighted work can include, for example, a photograph. However, the subject matter of the photograph—the person in the photograph—is not protected under copyright law. Rather, it is just the photograph that is protected. The subject of that photograph finds his or her protection in the right of publicity. Thus strikes the conflict between the rights of the copyright owner and the rights of the subjects of those copyrighted works, giving rise to preemption issues.212

208. Chilton, supra note 17.
209. See Chao, supra note 12.
211. White, 971 F.2d at 1399.
212. See Laws v. Sony Music Entm’t, Inc., 448 F.3d 1134, 1145 (9th Cir. 2006) (“[o]n the one hand, we recognize that the holder of a copyright does not have ‘a license to trample on other
Courts use a two-part test to determine whether a state law claim is preempted by the Copyright Act ("the Act"). First, does the subject matter of the state law claim fall within the subject matter of copyright described in sections 102 and 103 of the Act (art, music, etc.)? If so, is the state law right asserted equivalent to those described in section 106 of the Act (right to people’s rights.’ On the other hand, however, the right of publicity is not a license to limit the copyright holder’s rights merely because one disagrees with decisions to license the copyright.”).


(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.


(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

216. Laws, 448 F.3d at 1137.


Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:
If the answer to both of these questions is yes, then the state law claim is preempted.\footnote{219}

In the situation where Trump obtained a license to use Young’s Rockin’ in the Free World, Young’s hypothetical right of publicity claim would be preempted by copyright law. This is because the subject matter of Young’s claim—a sound recording—falls directly under the subject matter that is copyrightable under section 102.\footnote{220} This is the simple answer. However, we should look at exactly why that is so and the key that the license or lack thereof actually plays.

Cases where plaintiffs’ right of publicity claims were not preempted by copyright law are distinguishable from the hypothetical case involving Trump and Young. Again, in our hypothetical, Trump has a license to the sound recording and Young loses on his right of publicity claim due to copyright preemption. In \textit{Midler}, though, the Ninth Circuit held that Midler’s vocal misappropriation claims under California common law were not preempted by copyright law.\footnote{221} In \textit{Midler}, the subject matter at issue was her voice (even though it was not actually \textit{her} voice). Ford did not have a license to use Midler’s

\begin{itemize}
\item (1) to reproduce the copyrighted work in copies or phonorecords;
\item (2) to prepare derivative works based upon the copyrighted work;
\item (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
\item (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
\item (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
\item (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.
\end{itemize}

\footnote{218} See Laws, 448 F.3d at 1137-38.

\footnote{219} Sections 301(a) and (b) of Title 17 of the Copyright Act describe when the Act preempts legal and equitable rights granted by state common law or statute. Congress explained that “[t]he intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright that extend to works, within the scope of the Federal copyright law.” H.R. REP. No. 94-1476, at 130 (1976); see also Maljack Prods. v. GoodTimes Home Video Corp., 81 F.3d 881, 888 (9th Cir. 1996).

\footnote{220} See note 216.

\footnote{221} See generally \textit{Midler} v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988).
vocal recording of *Do You Want To Dance*? Rather, Ford’s ad agency, Young & Rubicam, only had a license from the copyright holder to use the song. But because Ford was directly after Midler’s voice as that is where it would draw its commercial value, Ford sought a sound-alike who perfectly mimicked Midler’s voice. Ford therefore appropriated Midler’s image through the use of “her voice.” Utilizing the two-part test, the Ninth Circuit reasoned that voice is not a subject matter that is protectable by copyright.

It stands to reason then that had Ford obtained a license to use Midler’s vocal recording of *Do You Want To Dance*, Midler’s common law claim would have failed. This is because the subject matter would have not been “voice” but a “vocal recording”—the same subject matter as in our Trump/Young scenario—and the specific subject matter protectable by copyright found under section 102 of the Copyright Act. In other words, voice and vocal recordings are two different things. Once the voice becomes fixed in a tangible medium, it is a vocal recording, which is a subject matter that is copyrightable. Thus, if Ford actually had a copyright license to use the vocal recording, Midler’s right of publicity claim would have been preempted. But because Ford did not obtain a copyright license to the vocal recording and used what essentially was Midler’s voice, Midler’s right of publicity claim was not preempted. Thus, whether the defendant has a license is key.

Another case where the plaintiff’s right of publicity claim was not preempted by copyright law is *Downing v. Abercrombie & Fitch*. In *Downing*, the defendant clothing company purchased a photograph depicting a group of surfers in a surfing competition that took place approximately 30 years prior to the lawsuit. The names of the surfers were handwritten at the bottom of the photograph. Abercrombie used the photo in its catalogue that featured surf-style clothing. The surfers brought state law right of publicity claims, but Abercrombie argued that federal copyright law preempted their claims. The

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222. *Id.* at 462.

223. *Id.; see also supra* notes 30-34 and accompanying text (discussing the two different copyrights implicated by a song—the musical composition and the sound recording).


225. *Id.* at 462 (“A voice is not copyrightable. The sounds are not ‘fixed.’ What is put forward as protectable here is more personal than any work of authorship.”).

226. 265 F.3d 994, 1004 (9th Cir. 2001).

227. *Id.* at 1000.

228. *Id.*
Ninth Circuit Court of Appeals rejected Abercrombie’s argument, holding “it is not the publication of the photograph itself, as a work of creative authorship, that is the basis for [the surfers’] claims, but rather, it is the use of the [surfers’] likenesses and their names . . .” Claims for misappropriation of a person’s “name or likeness” are not preempted by the Copyright Act, “notwithstanding the fact that [such] names or likenesses are embodied in a copyrightable photograph.”

“Where a defendant in a right-of-publicity claim obtained a copyright in a work featuring the plaintiff, courts must separate legitimate exploitations of what Congress intended to be a copyright holder’s exclusive rights from particular uses that infringe the right of publicity.” Otherwise, few copyright holders would be safe from suits by performers who agreed to appear in the holders’ works. In other words, a right of the copyright holder (e.g., right to play a vocal recording) needs to be separated from a use that would infringe on the plaintiff’s right of publicity; the two should not somehow be bundled into one. Going back to our hypothetical, the defendant-politician Trump is the copyright holder as he obtained a license to play the sound recording featuring the plaintiff-musician Young. If Trump did not have a license, Young (assuming him to be the copyright holder) could obviously claim copyright infringement. But because Trump does have a license, thereby precluding Young’s copyright infringement claim, Young should not then be allowed to repackage his would-be copyright infringement claim into a right of publicity claim. Young should not be able to transform the subject matter—vocal recording—into something else to somehow make it fit under a right of publicity claim. Vocal recording is a specific copyrightable subject matter, and if the plaintiff attempts to repackage, he will face preemption under the Copyright Act.

The Third Circuit, in Fleet v. CBS, Inc., refuted this “repackaging” of a copyright infringement claim into a right of publicity claim. In Fleet, copyright law did preempt the plaintiffs’ right of publicity claim was preempted by copyright law. Fleet involved a right-of-publicity claim by actors seeking to prevent a movie-distribution company from distributing a film in which they

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229. Id. at 1003.
230. Id. at 1004.
232. Id. (citing J. THOMAS McCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 11:55, at 817 (2d ed. 2017) (“[W]hen another reproduces a recorded performance in an expressive, non-advertising medium, this should not be the concern of right of publicity law.”)).
The actors had contracted away their rights in the film, but had not received compensation. They apparently hoped to obtain leverage in seeking payment by enjoining distribution of the film. The California Court of Appeals held that the actors’ claim was preempted, stating that “a party who does not hold the copyright in a performance captured on film cannot prevent the one who does from exploiting it by resort to state law.”

Likewise, the Ninth Circuit Court of Appeals, in Laws v. Sony Music Entertainment, Inc., evaluated singer Debra Laws’ claims that Sony had violated her right of publicity. Sony used a sample of one of her recordings in a song by Jennifer Lopez and LL Cool J. A third party, Elektra Asylum Records, owned the copyright in the original sound recording that featured Laws. Elektra granted Sony a license to use the sample in the J. Lo–LL Cool J song. Laws’ recording contract with Elektra gave Elektra the right to grant licenses, subject to contractual conditions. In that context, whether Laws authorized the sample license was a contract issue between Laws and Elektra. But Laws sued Sony, the end user of the sample. Laws alleged misappropriation of her name and voice. Applying the first prong of the two-part preemption test, the court found that Laws’ master recordings fell clearly within section 102 because that section includes “sound recordings.”

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234. Id. at 1914.
235. Id. at 1914.
236. See id. at 1924.
237. Id. at 1923.
238. Laws v. Sony Music Entm’t, Inc., 448 F.3d 1134, 1135–36 (9th Cir. 2006).
239. Id.
240. Id. at 1136.
241. Id.
242. Id.
243. See id. at 1143 (“To the extent that Laws has enforceable, contractual rights regarding the use of Elektra’s copyright, her remedy may lie in a breach of contract claim against Elektra for licensing [her song] ‘Very Special’ without her authorization.”).
244. Id. at 1136.
245. Laws v. Sony Music Entm’t, Inc., 448 F.3d 1134, 1139 (9th Cir. 2006); Copyright Act, 17 U.S.C.A § 102(a) (West, Westlaw through P.L. 115-22) (Section 102 of the Act extends copyright protection to “original works of authorship fixed in any tangible medium of expression . . . From
preemption, however, Laws contended that the subject matter of a copyright claim and a right of publicity claim are substantively different. She argued that “a copyright claim protects ownership rights to a work of art, while a right of publicity claim concerns the right to protect one’s persona and likeness.” Sony argued that “the subject matter of a right of publicity in one’s voice is not different from a copyright claim when the voice is embodied within a copyrighted sound recording.” Once a voice becomes part of a sound recording in a fixed tangible medium, Sony reasoned, it comes within the subject matter of copyright law. In resolving the competing arguments, the court looked to its prior cases of Midler and Sinatra v. Goodyear Tire & Rubber Co. and concluded that Sony had the winning argument.

In Sinatra, Nancy Sinatra sued Goodyear Tire over its advertising campaign that featured These Boots Are Made for Walkin’. Goodyear had obtained a license from the copyright holder for the use of music, lyrics, and arrangement of the composition. Goodyear subsequently used the music and lyrics in its ads, which were sung by unknown vocalists. The Ninth Circuit noted that Sinatra’s “complaint is not that her sound is uniquely personal; it is that the sound in connection with the music, lyrics and arrangement [that] made her the subject of popular identification, ought to be protected. But as to these latter copyrightable items, she had no rights.” Though the Ninth Circuit decided Sinatra prior to passage of the modern-day preemption provision in section 301, it nonetheless ruled that the Copyright Act impliedly preempted Sinatra’s state law claim. To be clear, Goodyear’s license was for the song composition—

which they can be . . . reproduced, . . . either directly or with the aid of a machine or device.” That section defines a “work of authorship” to include “sound recordings.” 17 U.S.C.A. § 102(a)(7) (West, Westlaw through P.L. 115-22).

246. Laws, 448 F.3d at 1139.
247. Id. (emphasis added).
248. Id.
249. Id.
250. See id. at 1139-41 (citing Midler v. Ford Motor Co., 849 F.2d 460, 462 (9th Cir. 1988); Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711, 716 (9th Cir. 1970)).
251. Id. at 1139.
252. Laws v. Sony Music Entm’t, Inc., 448 F.3d 1134, 1139 (9th Cir. 2006).
253. Id.
254. Id. at 1139-40 (quoting Sinatra, 435 F.2d at 716).
255. Id. at 1140 (citing Sinatra, 435 F.2d at 717-18).
subject matter also found under section 102 of the Act—and Goodyear’s use was in accordance with that license. Goodyear did not utilize sound-alikes as the defendant did in *Midler*. Therefore, Goodyear did not appropriate Sinatra’s voice or any other thing outside the scope of section 102. Sinatra did not have a winning copyright infringement argument because Goodyear acted within the scope of its copyright license. Sinatra could not then repackage her would-be copyright infringement claim into a right of publicity claim. Again, the license held by Goodyear played a key role in determining a preemption outcome.

On the other hand, again, in *Midler*, Midler’s right of publicity claim was not preempted by copyright law. The defendant-advertising agency did not acquire a license to use Midler’s recording of *Do You Want To Dance*. Instead, it had obtained a license from the song’s copyright holder—a license that did not allow for Midler’s vocal recording—and used a “sound alike” to imitate Midler’s voice for commercial use. Midler prevailed against preemption because the “thing” misappropriated, Midler’s voice, was not copyrightable. The court stated “[a] voice is not copyrightable. The sounds are not ‘fixed.’ What is put forward as protectable here is more personal than any work of authorship.” The *Laws* court found Laws’ voice misappropriation claim to be “plainly different” from the claims in *Midler* because the “thing” in *Laws* (vocal recording) fell within the subject matter of copyright. Sony was not imitating *Very Special* as Laws might have sung it. It did not need to because it had the license to a portion of the vocal recording *Very Special* as sung by Debra Laws. Therefore, the license was in accordance with the use, and the subject matter under that license fell within the scope of copyrightable subject matter. Consequently, Laws’ right of publicity claim was preempted by copyright law.

Thus, if there is an impermissible use of the subject’s image, including but not limited to, her name, likeness (*Downing*), or voice (*Midler*), the plaintiff’s right of publicity claim will not be preempted by copyright law. On the other hand, if there is permissible use of a sound clip (*Laws*), performance (*Fleet*), or

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256. *Id.*

257. *Id.*

258. *Laws v. Sony Music Entm’t, Inc.*, 448 F.3d 1134, 1140 (9th Cir. 2006).

259. *Id.*

260. *Id.* at 1140-41; see also *Brown v. Ames*, 201 F.3d 654, 658 (5th Cir. 2000) (“The crucial difference between [this case and Daboub v. Gibbons, 42 F.3d 285 (5th Cir. 1995)] is that in *Daboub* the basis of the misappropriation claim . . . was the song itself, bringing it within section 301’s ambit, whereas here the basis of the misappropriation claim was defendants’ use of plaintiffs’ names and/or likenesses.”).
the tangible medium as a whole (*Sinatra*), the plaintiff will be preempted by copyright law.

*Laws* is particularly instructive in determining whether copyright law preempts a musician’s right of publicity claim against the politician. Sony obtained a license to use the sample that featured Laws’ voice. In other words, Sony had a license to use the *vocal recording*, which is a category that falls squarely within copyrightable subject matter. Thus, preemption prevailed. Likewise, if Trump obtains a copyright license to use the vocal recording of Young’s *Rockin’ in the Free World*, Young should not be able to successfully assert a right of publicity claim against Trump. Young could, but his claim would be preempted by federal copyright law. The entirety of the allegedly misappropriated vocal performance is contained within the copyrighted medium—the sound recording. If, however, the campaign obtained a license to only the song and had a singer at the rally imitate the singer’s voice (not likely), then the artist might have a viable claim as seen in *Midler* because then the misappropriated subject matter is the voice, which is not copyrightable. The “subject matter” of a right of publicity claim is not a particular picture, song, or photograph of the plaintiff.261 “Rather, what is protected by the right of publicity is the very identity or persona of the plaintiff as a human being.”262 The sound recording alone is not the likeness.

VI. CONCLUSION

A politician who has paid for a license under copyright law to use a musician’s song is not immune from a musician’s intellectual property claim. While there certainly are policy reasons to allow the bona fide license purchaser to use the song in accordance with the license, there are also reasons against allowing such use. Reasons against the use find support in a false endorsement claim. Under a false endorsement cause of action, the mark at issue is the musician’s identity. This concept is different from trademark in a singular song or performance, which has been rejected by courts. Identity can be comprised of the artist’s unique voice, which might also coincide with strong viewpoints of the artist. Courts have certainly recognized that distinct vocal identity can give rise to a legally protected mark. Particularly, the context of the politician’s use might strengthen the musician’s claim. If, for example, the politician continually uses a musician’s song, plays multiple songs by the same musician, and even discusses the musician by name in reference to support of that campaign, the


262. Id.
musician could have a strong false endorsement claim. Furthermore, the public is likely to be confused as to whether the musician endorses the politician. Indeed, actual confusion—the factor usually the most dispositive—exists in this context and is particularly evident through social media.

While a right of publicity claim is similar to a false endorsement claim—perhaps even the common law equivalent to the federal false endorsement claim—it fails to provide the musician adequate protection due to copyright preemption. First, the musician who complains in this context does so because it is his particular sound recording being played—the sound recording with his distinct voice on it. He does not want the politician to misappropriate his voice, and so he cries violation of right of publicity. But when the politician does in fact have a copyright license to use this sound recording, the musician’s cries become stifled. This is so because the Copyright Act’s subject matter expressly includes “sound recordings.” If the musician is using the license in accordance with its terms, federal copyright law preempts the state-based right of publicity. Conversely, because false endorsement sounds in federal law the same way copyright law does, it is not preempted like its right of publicity counterpart.

Though Trump and other politicians may properly acquire a license, musicians obviously feel protective over their work and don’t want their well-crafted images placed in jeopardy. Trademarks are the owners’ pledge of consistent quality and a means for conveying a certain status to consumers, all of which helps businesses promote their products and services.\textsuperscript{263} Nowadays, if that status is called into question, the public might expect the musician to publicly denounce the politician’s use to maintain the musician’s integrity. And if the musician doesn’t, his fans might wonder—does he actually support \textit{that guy}? In the absence of a public denouncement via Twitter, the artist stands to lose credibility with his fans. Should a public denouncement be necessary? Can’t the musician instead rely on intellectual property remedies to prevent the politician’s use from happening? Even after The Rolling Stones repeatedly expressed dismay over Trump playing their song \textit{You Can’t Always Get What You Want}, Trump continued to play it, and it even played after he was announced the President-elect.\textsuperscript{264} The song, after all, had become Trump’s theme song. But with more and more musicians complaining from year to year, the Lanham

\begin{footnotesize}
\begin{itemize}
\item \textsuperscript{263} Natalie J. Spears & S. Roberts Carter III, \textit{This is My Brand: Litigating Product Image}, \textit{Litig.} 31 (2005).
\end{itemize}
\end{footnotesize}
Act’s false endorsement provision just might be the musician’s ace in the hole to trump Trump. It will be interesting to watch.
(DON’T) LIE TO ME: CAN FALSE POLITICAL STATEMENT LAWS BE REHABILITATED AFTER THE SIXTH CIRCUIT’S SUSAN B. ANTHONY LIST RULING?

Clay Sabourin*

ABSTRACT

To put it mildly, laws criminalizing false political statements have proven to be controversial.¹ In the wake of the Supreme Court of the United States’ ruling in U.S. v. Alvarez, several state statutes which punish false statements made regarding candidates running for public office have been deemed unconstitutional.² As vividly exemplified by the Sixth Circuit’s recent holding in Susan B. Anthony List v. Driehaus and the Eighth Circuit’s holding in 281 Care Comm. v. Arneson, this invalidation trend does not appear to be stalling any time soon.³ Despite the apparent inevitable demise of many current formulations of false political statement laws, it is important to examine exactly why these laws have been deemed to fail on constitutional grounds. Furthermore, the question is begged as to what, if anything, can be salvaged from these laws, and is there any value in doing so? This note aims to explore recent and historical developments regarding false political statement laws, giving special attention to Supreme Court decisions. Ohio’s struggles with false political statement laws are additionally explored in-depth. This note concludes with a compilation of deficiencies that have consistently been found regarding false political statement laws, and a proposal for improvement through new legislation.

I. INTRODUCTION

Over a dozen states still have some form of law which criminally punishes the making of certain false statements about candidates or ballot issues during

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¹ See generally Rickert v. State, 168 P.3d 826, 827 (Wash. 2007).


³ See 281 Care Comm. v. Arneson, 766 F.3d 774, 796 (8th Cir. 2014) (referencing Minnesota’s reporting statute); see also Susan B. Anthony List, 814 F.3d at 476.
the course of an election. Typically, violators are subject to thousands of dollars in fines, jail-time, or both. Minnesota, Massachusetts, Washington, and Ohio have all had laws found unconstitutional in the last decade. Though all false political statement laws invariably differ in language and thoroughness to some degree, the core elements remain essentially the same. For example, Wisconsin’s law which criminalizes false political statements, aptly titled “False Representations Affecting Elections”, states succinctly “[n]o person may knowingly make or publish, or cause to be made or published, a false representation pertaining to a candidate or referendum which is intended or tends to affect voting of an election.” (emphasis added). The inclusion of the qualifier “knowingly” was no doubt in recognition of the Supreme Court’s New York Times rule, which requires a scienter equating to “actual malice” to punish many false statements. This standard was thought to be constitutionally sufficient for nearly fifty years, and continues to endure in other areas of law. However, recent Supreme Court and federal circuit decisions have cast serious doubts on the extent to which the addition of this language insulates false political statement laws from invalidation. Additionally, the breadth of these statutes has proven problematic, as the intermediaries by which false political statements are made, typically media and advertisers, are subject to criminal penalties in equal force as the party from which the statement originated.

False political statement laws are usually coupled with some form of statute delineating the process of reporting alleged violations, typically to some state administrative election commission, and have in-turn drawn judicial ire of their


6. See Susan B. Anthony List, 814 F.3d at 476.


10. See Susan B. Anthony List, 814 F.3d at 476.

An example of this is Ohio’s reporting statute, which states “[u]pon the filing of a complaint with the Ohio elections commission, which shall be made by affidavit of any person, on personal knowledge, and subject to the penalties for perjury, or upon the filing of a complaint made by the secretary of state or an official at the board of elections, setting forth a failure to comply with or a violation of any provision in [any of Ohio’s false political statement statutes].” (emphasis added). Several courts have specifically expressed concerns regarding provisions which allow any person, not just elected public officials, to file a complaint with state election commissions. Furthermore, it has been noted that the ability to lodge complaints against persons who are alleged to have violated the statutes, regardless of whether criminal charges are ever brought, may be wielded as a tool of oppression by political rivals seeking nothing more than to force the alleged violator to divert time, energy, and money to defending what may ultimately be a bogus or trivial allegation before an election commission. This disquieting reality is further enhanced by the fact that the vast majority of these allegations are not resolved by election commissions before the conclusion of that particular election period, let alone proceeding to a court of law for formal adjudication.

II. DO FALSE POLITICAL STATEMENT LAWS HAVE VALUE?

It would appear that false political statement statutes, under current formulations, are at the very least perceived to be largely deficient. These statutes may ultimately result in harsh punishments far out-weighing any actual harm, are ripe for abuse motivated by political machinations, and could result in serious “chilling effects” on open political discourse. This begs the question; if these laws are so riddled with problems, are they even worth saving? While certainly imperfect, the spirit of these laws is laudable at the core, and with extensive renovation can serve their intended purpose—preserving the integrity

12. See Lucas, 34 N.E.3d at 1255 (“[T]he statute may be manipulated easily into a tool for subverting its own justification”).


14. See Susan B. Anthony List, 814 F.3d at 470 (referencing Ohio’s reporting statute); see also 281 Care, 766 F.3d at 778 (8th Cir. 2014) (referencing Minnesota’s reporting statute).

15. See generally Lucas, 34 N.E.3d at 1255 (speculating on the possible mischievous applications of the Massachusetts law at issue).


17. See id.; see also Rickert, 168 P.3d at 831 (specifically referencing “procedural defects” in Washington’s statute which could “chill” political speech).
and fairness of elections. There is no reason to quietly accede in the extinction of false political statement laws without a word said in defense of the nearly departed, simply “stand[ing] on the dock and wav[ing] goodbye”.

While unpopular opinions, sharp criticism, and even some degree of nastiness serve the function of informing the public on matters related to democratic choices, outright falsehoods have no significant utilitarian value. The discretion of individuals to fabricate often-convincing lies—with nigh absolute impunity—obfuscates the ability of citizens to make informed decisions. Deliberate misinformation is certainly a significant contributing factor to public mistrust of otherwise veracious information during election season. It is not much of a stretch to assume that some individuals, recently unfettered from the restraints of punishment for knowingly or recklessly disseminating false political information, could brazenly take ever more liberty composing untruthful narratives to suit particular political ends. Rather than simply abandoning the notion that legislation can alleviate the very real prospect of systematic public misinformation generated by false political statements, perhaps what is needed is a re-examination of how these laws can be more narrowly-tailored to serve their legitimate, original purposes. The first step in this process is understanding the historical development and criticism of false political statement laws.

III. Early Jurisprudence and Emerging Standards

A. New York Times, Garrison, and “Actual Malice”

The starting point for Supreme Court false political statement analysis is New York Times v. Sullivan and the soon after Garrison v. State of Louisiana. Decided in 1964, the case was firmly embedded against the backdrop of the civil rights movement. The “false statements” at issue – political in nature but not

18. Util. Air Regulatory Grp. v. E.P.A., 134 S. Ct. 2427, 2446 (2014) (referring to an unwillingness to let the Environmental Protection Agency have unfettered regulatory discretion, but the phrase seems apt here).

19. See generally Garrison v. State of Louisiana, 379 U.S. 64, 75 (1964); see also U.S. v. Alvarez, 132 S. Ct. 2537, 2552 (2012) (Breyer, J., concurring) (“Such false factual statements are less likely than are true factual statement to make a valuable contribution to the marketplace of ideas.”).


21. See Richman, supra note 11, at 686.

directly related to an election – were included in an editorial advertisement published in the New York Times.\(^\text{23}\) The advertisement had been paid for and provided on behalf of an African-American right-to-vote and student movement, but the suit had been brought against the New York Times as publisher.\(^\text{24}\) The respondent who alleged the harm from the advertisement was the elected commissioner of Montgomery, Alabama, who was not named in the advertisement, other than his assertion that the word “police” referred to him as citizens “knew” he had the ability to direct their conduct.\(^\text{25}\)

Entitled “Heed Their Rising Voices”, the advertisement described the plight of certain African-American college students who were engaging in non-violent protests in Alabama being subjected to a “wave of terror” by the police.\(^\text{26}\) “The first statement at issue was the description of college students singing “My Country, Tiss of Thee” on the Alabama State Capitol Building steps, after which student leaders at the demonstration were arrested and expelled by the Alabama Board of Education.\(^\text{27}\) In response, a number of demonstrators engaging in reactive protests on the campus of Alabama State College were “ringed” by armed police, who lobbed tear-gas into the crowd in order to disperse them.\(^\text{28}\) The advertisement continued by stating that “the entire student body” was locked out of the campus dining hall after refusing to re-register with the college, “in an attempt to starve them into submission.”\(^\text{29}\) The second statement dealt with Dr. Martin Luther King, Jr., which vividly recounted the responses to his calls for “peaceful protests” which included “intimidation and violence”, specifically the bombing of his home, which nearly killed his wife and young daughter.\(^\text{30}\) The advertisement then gave a litany of charges and arrests against Dr. King, including speeding, loitering, and now “‘perjury’ — a felony under which they could imprison him for ten years.”\(^\text{31}\)

\(^{23}\) Id.
\(^{24}\) Id. at 256-57.
\(^{25}\) Id. at 288.
\(^{26}\) Id. at 256.
\(^{27}\) Id. at 259.
\(^{28}\) Sullivan, 376 U.S. at 259.
\(^{29}\) Id. at 257.
\(^{30}\) Id.
\(^{31}\) Id. at 258.
The Supreme Court held that both sections of the advertisement were not accurate characterizations of the events in Alabama. First, the student leaders who were expelled for singing “My Country, Tiss of Thee” were dismissed for a separate incident; a sit-in at the lunch counter of the Montgomery County courthouse. Second, the students involved in the reactive protests of the student leaders’ expulsion by the Board of Education were not punished by Alabama State College for refusal to re-register with the college, but rather for boycotting classes “on a single day.” Furthermore, the Court found no credible evidence that the dining hall was ever padlocked “on any occasion,” and the only students who were refused service had “neither signed a preregistration application or requested temporary meal tickets.” The “ringing” event was also found to be a significant mischaracterization. The Court concluded that the proffered criminal history of Dr. King was also exaggerated, and the events all occurred prior to the Respondent being elected as city commissioner.

The instructions given by the trial judge, and affirmed by the Alabama Supreme Court on appeal, informed the jury that the statements in the advertisement were “libelous per se,” creating a presumption of malice, and that so long as the statements were made “of and concerning” the respondent the jury could award both general and punitive damages. The jury returned a verdict against the New York Times for $500,000. The Supreme Court of the United States, while taking umbrage with some the particulars of the Alabama state law and its application, decided to make its ruling couched in more general constitutional considerations. The Court began by stating that erroneous statements are an “inevitable” by-product of open political debate, and as such are afforded a measure of “breathing space . . . needed to survive.” To meet this end, the Court surmised requiring the defense of “an erroneous statement . . . honestly made” was as essential for proof as that of “guilty knowledge” regarding the statement. The Court concluded by holding that under the First and Fourteenth Amendments “a public official [is prohibited] from recovering damages for a defamatory falsehood relating to his official conduct unless he

32.  *Id.* at 259.
33.  *Id.*
35.  *Id.* at 262.
36.  *Id.* at 254.
37.  *Id.* at 271-72 (quoting N.A.A.C.P. v. Button, 371 U.S. 415, 433 (1963)).
38.  *Id.* at 278 (quoting Smith v. California, 361 U.S. 147 (1959)).
proves that the statement was made with ‘actual malice’—that is, with knowledge that it was false or with reckless disregard of whether it was false or not.”  

The Court, applying the newly-formulated “actual malice” standard to the present case, found that the Alabama law could not stand if all that was required was a “presumption of malice”, as a demonstration of “actual malice” was required. The only thing in the Court’s view that had been proven was “at most a finding of negligence [of the New York Times] in failing to discover the misstatements” not equating to recklessness, and as such the evidence was constitutionally insufficient to support the lower court’s ruling. The Court further expressed serious skepticism regarding whether the advertisement’s use of the words “they” and “police” could reasonably be perceived as relating to the Respondent.

The newly formulated “actual malice” standard was met with immediate criticism in renowned textualist Justice Hugo Black’s concurring opinion. While agreeing with the majority on the ultimate reversal of the judgement against the New York Times, he lamented that the “malice” standard was “[even as defined by the Court] an elusive, abstract concept, hard to prove and hard to disprove” and instead would base the ruling exclusively on “absolute, unconditional” First Amendment immunity of the New York Times, in its capacity as the media, to publish criticisms of public officials.

Several months after New York Times v. Sullivan, the Court applied the “actual malice” standard in Garrison, a case involving the alleged criminal defamation by the District Attorney of New Orleans against eight Parish District Court judges during a press conference. The alleged defamatory statements included various accusations of “inefficiency, laziness, and excessive vacations” by the judges. The District Attorney further openly questioned the motives of the judges in refusing to authorize expenses for undercover police vice work,

39. Id. at 279-80.
40. Sullivan, 376 U.S. at 283.
41. Id. at 287-88.
42. Id. at 288.
43. Id. at 293 (Black, J., concurring).
44. See generally Garrison, 379 U.S. at 65-67 (discussing District Attorney of New Orleans’ public comments regarding behavior of local judges).
45. Id. at 65-66.
stating this “[made] clear where [the judges] sympathies lie,” which in the Court’s view implied some form of racketeering influence on the judges.46

The Court began by stating that the “New York Times rule” was applicable to the imposition of criminal sanctions involving statements against official conduct of public officials.47 The Louisiana statute had a prominent quirk; it did not require that a statement be intended to inflict “harm through falsehood” to impose criminal penalties, it merely required “an intent to inflict harm.”48 A truthful statement, made with “ill-will or reckless disregard”, was equally punishable as the knowingly false statement made with “malice”. The Court locked-down the recently established New York Times rule or “actual malice” standard by stating that the only criticisms of public officials able to be punished, criminally or civilly, are those that are false and made with a “knowing or reckless disregard of the truth.”49 Justice Brennan concluded by offering the Court’s rationale for holding only knowing or recklessly made false statements about public officials as legally cognizable:

Although an honest utterance, even if inaccurate, may further the fruitful exercise of the right of free speech, it does not follow that the lie, knowingly and deliberately published about a public official, should enjoy a like immunity . . . for the use of a known lie as a toll is at once at odds with premises of democratic government and with the orderly manner in which economic, social, or political change is to be effected . . . hence the knowingly false statement and the false statement made with reckless disregard of the truth, do not enjoy constitutional protection.50

For nearly fifty years, “actual malice” was the applicable standard for false statement laws.51

B. Washington’s False Political Statement Law Falls First

Though a number of cases dealing with false political statement laws managed to find their way to the Supreme Court, the statutes largely survived

46. Id. at 66.
47. Id. at 67.
48. Id. at 73.
49. Id. at 78.
50. Garrison, 379 U.S. at at 75.
51. See Rickert, 168 P.3d at 843 (Wash. 2007) (Madsen, J., dissenting).
judicial scrutiny notwithstanding certain auxiliary aspects found to be unconstitutional. However, prior to the veritable sea change post-Alvarez, only one state statute was deemed unconstitutional in toto. Though not decided by the Supreme Court of the United States, Washington’s *Rickert v. State* was in hindsight a harbinger of trouble to befall false political statement laws nationally.

The Washington statute was not unique. It called for punishment for sponsoring “with actual malice a statement constituting libel or defamation per se [in] [p]olitical advertising or an electioneering communication that contains a false statement of material fact about a candidate for public office.” The majority opinion opened by referring to the law on its face as a “censorship scheme” whereby the government had illegitimately assumed the role of “guardianship of the public mind.” While acknowledging that other state courts had upheld these statutes, the majority concluded “such holdings should be neither admired nor emulated.”

The court first asserted that the *New York Times* “actual malice” line of cases dealt only with “defamatory statements”, and absent this select category of unprotected speech the law was subject to “strict scrutiny” as it extends to constitutionally-protected political speech. Strict scrutiny, as the name would suggest, is not an easy standard to overcome. It creates a presumption the law is unconstitutional, and requires a significant, “compelling” governmental interest, and the statute then must be narrowly-tailored to further that interest. While conceding the state has some interest in preventing false political statements, the salient criticism by the majority was that the law was ill suited to advance its asserted purpose; preserving the integrity of the election process. In the majority’s view, the statute was both under- and over-inclusive.

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53. *WASH. REV. CODE. ANN.* § 42.17A.335(1)(a) (West 1999).


55. *Id.* (citing *Pestrak*, 926 F.2d at 573).

56. *Id.* at 828 (quoting *Rickert v. State*, 119 P.3d 379 (2005)).


as it only applied to statements made against a candidate, not those made by the candidate themselves or their supporters.\textsuperscript{59} Furthermore, the majority took serious objection to the fact the enforcement was done via a governmental agency composed of unelected officials, who not only reviewed the alleged false statements, but had the power to impose certain sanctions.\textsuperscript{60} These officials, appointed by the governor, could plausibly use their \textit{de facto} prosecutorial discretion to punish only political rivals, resulting in a marked “chilling effect” on open political discourse.\textsuperscript{61} After holding the law unconstitutional, the majority concluded with the axiom “the best remedy for false or unpleasant speech is more speech, not less speech.”\textsuperscript{62}

In a lengthy dissent, one judge flatly concluded that “[Washington’s statute] infringes on no First Amendment rights.”\textsuperscript{63} The majority through its invalidation of the statute had essentially signed “an invitation to lie with impunity.”\textsuperscript{64} Refocusing the application of the \textit{New York Times} test, the dissent urged that calculated, knowing falsehoods are categorically unprotected speech that do nothing but subvert the electoral process.\textsuperscript{65} Furthermore, Supreme Court precedent indicated that “actual malice”, rather than “strict scrutiny”, was the appropriate standard and thus the analytical framework relied upon by the majority was faulty from its outset.\textsuperscript{66} Even if the court was at liberty to choose its own analytical framework, the dissent urged that the “actual malice” standard was a difficult test to pass, and only knowing or reckless material falsehoods, established by clear-and-convincing evidence, would suffice.\textsuperscript{67}

C. Changes Abound; Alvarez and Shifting Scrutiny

Despite the largely anomalous \textit{Rickert} ruling, state false political statement laws were fairly ubiquitous and generally accepted until \textit{Alvarez}, which proved

\begin{itemize}
  \item \textsuperscript{59} \textit{Id.} at 831.
  \item \textsuperscript{60} \textit{Id.}
  \item \textsuperscript{61} \textit{Id.}
  \item \textsuperscript{62} \textit{Id.} at 832.
  \item \textsuperscript{63} \textit{Id.} at 833 (Madsen, J., dissenting).
  \item \textsuperscript{64} \textit{Rickert}, 168 P.3d at 833.
  \item \textsuperscript{65} \textit{Id.}
  \item \textsuperscript{66} \textit{Id.} at 834.
  \item \textsuperscript{67} \textit{Id.}
\end{itemize}
to cast serious doubt on the constitutionality of many state statutes.\textsuperscript{68} Alvarez was a somewhat remarkable case to herald the recent invalidating wave of false political statement jurisprudence, as the factual background was a wholly distinct arena of false speech involving military honors.\textsuperscript{69} Though not regarded as a direct analytical framework for reviewing false political statement laws, many of the federal circuit cases which followed directly referenced Alvarez as informing their decisions.\textsuperscript{70} Perhaps more than anything else, the case exemplified growing judicial skepticism regarding false statement laws generally.\textsuperscript{71}

Besides being factually distinct, Alvarez was beset by a common Supreme Court issue concerning precedent; a “fragmented” court consisting of a four-justice majority, a two-justice concurrence, and a three-justice dissent.\textsuperscript{72} The case dealt with the Stolen Valor Act, a federal law that punished individuals making false claims of receiving military honors.\textsuperscript{73} Opening the majority opinion, the respondent was described in less-than flattering terms.\textsuperscript{74} Justice Kennedy began “Xavier Alvarez, the respondent here, lied when he said that he played hockey for the Detroit Red Wings and that he once married a starlet from Mexico. But when he lied in announcing he held the Congressional Medal of Honor, respondent ventured onto new ground; for that lie violates a federal criminal statute.”\textsuperscript{75} The statute called for criminal sanctions against any person who falsely represented themselves as having received any decoration or medal reserved for the Armed Forces of the United States.\textsuperscript{76} A subsection stated that the punishment was enhanced when the false claim regarded the Congressional

\textsuperscript{68} See Zhang, supra note 4, at 19.

\textsuperscript{69} See generally Alvarez, 132 S. Ct. at 2537(discussing the factual underpinnings of the case leading to appeal).

\textsuperscript{70} See generally Susan B. Anthony List, 814 F.3d at 471 (discussing Ohio’s false political statement statutes); see also 281 Care Comm., 766 F.3d at 781 (discussing Minnesota’s statute).

\textsuperscript{71} See generally Zhang, supra note 4, at 29 (noting judicial skepticism following the Alvarez decision).

\textsuperscript{72} See Marks v. United States, 430 U.S. 188, 193 (1977) (“[W]hen a fragmented Court decides a case and no single rationale explaining the result enjoys the assent of five Justices, the holding of the Court may be viewed as that position taken by those Members who concurred in the judgments on the narrowest grounds.”).


\textsuperscript{74} Alvarez, 132 S. Ct. at 2542.

\textsuperscript{75} Id.

Medal of Honor, ramping up the punishment to up to one year of imprisonment in addition to a fine.\textsuperscript{77} Quite notably, the law contained no specific mens rea requirement; there was no mention of \textit{New York Times}’ “actual malice” standard. Furthermore—though obviously an issue of prosecutorial discretion and evidence—the law was not restricted to publicly made false statements.\textsuperscript{78}

The Respondent challenged the statute as a “content-based suppression of pure speech” in violation of the First Amendment, falling outside the normal purview of categories of expression where content regulation by the State is permissible, including false political statements laws.\textsuperscript{79} The majority opinion then dealt a serious blow to what seemed to be a common interpretation of Supreme Court jurisprudence, and in-turn false political statement laws; “[t]he Court has never endorsed the categorical rule the Government advances: that false statements receive no constitutional protection.”\textsuperscript{80} The Court then turned to the statute itself, expressing concern that the law allowed the government to decree certain speech a criminal offense, and thus garnered unflattering Orwellian comparisons.\textsuperscript{81} The law “cast a chill” that ran afield of the First Amendment.\textsuperscript{82}

The majority then advanced the appropriate standard to evaluate the law; nearly insurmountable strict scrutiny.\textsuperscript{83} Justice Kennedy thoroughly explored the aim of Stolen Valor Act—protecting the integrity of military honors and their recipients—and concluded it was most-assuredly a strong state interest.\textsuperscript{84} However, this was to no avail as the restriction must be “actually necessary”, with a direct causal link with the restriction on behavior and the injury to be prevented.\textsuperscript{85} Protecting military honors from being diluted due to false claims

\textsuperscript{77} \textit{Alvarez}, 132 S. Ct. at 2543.

\textsuperscript{78} \textit{Id.} at 2547 (“[T]he statute would apply with equal force to personal, whispered conversations within a home.”).

\textsuperscript{79} \textit{Id.} at 2543 (Justice Kennedy expressed that restrictions under this category were “the most difficult to sustain.”).

\textsuperscript{80} \textit{Id.} at 2545.

\textsuperscript{81} \textit{Id.} at 2547 (referencing the “Oceania Ministry of Truth” from George Orwell’s Nineteen Eighty-Four).

\textsuperscript{82} \textit{Id.} at 2548.

\textsuperscript{83} \textit{See Alvarez}, 132 S. Ct. at 2552 (Breyer, J., concurring) (“[strict scrutiny implies] near automatic condemnation.”).

\textsuperscript{84} \textit{Id.} at 2549.

\textsuperscript{85} \textit{Id.} (quoting \textit{Brown v. Entm’t Merch. Ass’n}, 131 S. Ct. 2729, 2734 (2011)).
was not enough to support laws that burden core speech.\textsuperscript{86} Furthermore, the majority posited that counter-speech would work equally or more effectively than formal governmental intervention.\textsuperscript{87} Indirectly echoing the penultimate sentence of the \textit{Rickert} majority, Justice Kennedy prescribed that best cure for false speech is speech that is true.\textsuperscript{88} The dissent of Justice Alito, joined by Justices Scalia and Thomas, largely took exception to the majority’s assertion that punishing falsehoods such as the present one had any “chilling” effect on free speech, and a “long line of cases” make it clear that free speech does not encompass falsehoods which cause real harm and serve no legitimate purpose.\textsuperscript{89}

In a notable concurrence by Justice Breyer joined by Justice Kagan, it was conceded that the Stolen Valor Act indeed ran afoul of constitutional safeguards, but suggested a different analytical approach. The appropriate test was rather that of “intermediate” or “proportional” scrutiny, where the law must be demonstrated as working speech-related harm out of proportion to its asserted utility.\textsuperscript{90} In Justice Breyer’s view, there was not a significant chance a law that curtailed the making of false statements regarding easily verifiable facts was a disservice to the public’s “marketplace of ideas,” and that false factual statements are not particularly worthy of judicial or constitutional protection.\textsuperscript{91} Nonetheless, the law was over-broad as it punished privately made statements in the same manner as public statements.\textsuperscript{92} The chilling effects of the statute were undeniable without a clear \textit{mens rea}, though this could nonetheless reasonably be assumed as part of a \textit{prima facie} case.\textsuperscript{93} In dicta, Justice Breyer noted that false statement statutes in political contexts caused particular difficulty, as statements concerning elections were far more likely to cause a behavioral difference—altering voting patterns—than that of the present statute.\textsuperscript{94} False political statement laws could also more easily result in

\textsuperscript{86} See \textit{id}. at 2549 (rejecting the Government’s “common sense” argument).

\textsuperscript{87} \textit{id}. at 2550.

\textsuperscript{88} \textit{id}.

\textsuperscript{89} \textit{Alvarez}, 132 S. Ct. at 2557 (Alito, J., dissenting).

\textsuperscript{90} \textit{id}. at 2551 (Breyer, J., concurring).

\textsuperscript{91} \textit{id}. at 2552.

\textsuperscript{92} \textit{id}. at 2555 (lamenting that the statute applies with equal force to “barstool braggadocio.”).

\textsuperscript{93} \textit{id} (Breyer, J., concurring).

\textsuperscript{94} \textit{id}. at 2556.
censorship, and thus the statutes must be more narrowly tailored than others.\textsuperscript{95} Despite the questionable precedential fit, the aftermath of the decision proved to be swift and significant for false political statement laws.

D. The Beginning of the End for False Political Statement Laws

Massachusetts and Minnesota’s political statement laws fell within three years of \textit{Alvarez}. The first to be struck down was Minnesota’s statute. Taking up \textit{281 Care} after a remand to the district court, the Eighth Circuit began with the proposition that the first step of analysis for false speech regulation was to determine the appropriate level of scrutiny.\textsuperscript{96} Laws which implicate First Amendment speech concerns, if regulating the actual content of a protected class of speech, are “content-based prohibitions” and thus subject to some level of heightened scrutiny.\textsuperscript{97} Despite being a common interpretation for nearly half a decade, false speech enjoyed no categorical First Amendment protection.\textsuperscript{98} Statutes seeking to curtail false political speech now faced the undesirable possibility of being subjected either to intermediate or strict scrutiny. And as \textit{Alvarez} did not provide a clear precedent from which lower courts could draw the appropriate standard, courts were left to either use the strict standard espoused by the majority against the Stolen Valor Act—which was not a law concerning political speech—or rely on Justice Breyer’s concurrence which recommended an intermediate level of scrutiny for “other” false statement laws.\textsuperscript{99}

The Minnesota statute at-play did not punish false political statements about a person, rather it prescribed sanctions, upon review by a state administrative agency, the making of false statements about proposed ballot initiatives.\textsuperscript{100} Two “grassroots advocacy organizations” opposing certain school-funding levies attacked the constitutional propriety of Minnesota’s false political statement law.\textsuperscript{101} Among the provisions that drew the ire of the appellants

\textsuperscript{95} \textit{Alvarez}, 132 S. Ct. at 2556 (“I recognize that in some contexts, particularly political contexts, such a narrowing will not always be easy to achieve.”).

\textsuperscript{96} \textit{See} 281 Care Comm., 766 F.3d at 774. The 8th Circuit initially remanded to the district court upon finding complainants had demonstrated standing and ripeness.

\textsuperscript{97} \textit{Id.} at 782.

\textsuperscript{98} \textit{See} Rickert, 168 P.3d at 843 (Madsen, J., dissenting).

\textsuperscript{99} \textit{See} Marks, 430 U.S. at 193; \textit{see also} Alvarez, 132 S. Ct. at 2552 (Breyer, J., concurring).

\textsuperscript{100} \textit{See} 281 Care Comm., 766 F.3d at 777.

\textsuperscript{101} \textit{Id.}
were the ability of any person to lodge a complaint, and the only enforcement mechanism being a mandatory misdemeanor prosecution upon referral by the agency.\textsuperscript{102} The district court determined that the appropriate level of scrutiny was intermediate, as espoused by Justice Breyer in \textit{Alvarez}.\textsuperscript{103} Nevertheless, the district court elected to use a strict scrutiny analysis as a means of demonstrating that the Minnesota statute was constitutional even against the heaviest scrutiny, and upheld the law.\textsuperscript{104}

The Eighth Circuit disagreed with the district court’s understanding of \textit{Alvarez}, stating that \textit{Alvarez} dealt with non-political statements and was thus was not controlling in the present case.\textsuperscript{105} Applying strict scrutiny, the court found that “no amount of narrow-tailoring” could support the statute in its current form. The court largely swept aside the degree of “legitimate” state interest as irrelevant, as even if that element was satisfied the statute still did not pass constitutional muster.\textsuperscript{106} Specifically, the court viewed the statute as simultaneously overbroad and under-inclusive, and it was not the least-restrictive means of attaining its alleged goal of fair and informed elections.\textsuperscript{107} The “anyone-can-report” aspect of the statute was ripe for mischief, and even though “commonsense” would dictate that this law would help preserve the integrity of the election process, “commonsense” is not enough to overcome the rigors of strict scrutiny.\textsuperscript{108} Furthermore, counter-speech in the form of correcting falsehoods by supplying truthful information could be an equal or greater force for protecting the democratic process.\textsuperscript{109}

\textit{281 Care} was not an anomaly. Applying strict scrutiny, the Supreme Judicial Court of Massachusetts struck-down the State’s own false political statement law in \textit{Commonwealth v. Lucas}.\textsuperscript{110} There, a political action committee published

\begin{itemize}
  \item \textsuperscript{102} See 281 Care Comm., 766 F.3d at 778 (holding MINN. STAT. ANN. § 211B.06 (West 2014) unconstitutional).
  \item \textsuperscript{103} See 281 Care Comm. v. Arneson, 638 F.3d 621, 636 (8th Cir. 2011).
  \item \textsuperscript{104} 281 Care Comm., 766 F.3d at 779.
  \item \textsuperscript{105} Id. at 783 (“Alvarez is not the ground upon which we tread.”).
  \item \textsuperscript{106} Id. at 787 (“We concede that regulating falsity in the political realm definitely exemplifies a stronger state interest than, say, regulating the dissemination and content of information generally . . . .”).
  \item \textsuperscript{107} Id. at 788.
  \item \textsuperscript{108} Id. at 790.
  \item \textsuperscript{109} Id. at 793.
  \item \textsuperscript{110} Lucas, 34 N.E.3d at 1245.
\end{itemize}
brochures that contained verifiably false statements against an incumbent state representative, accusing him of personally making $140,000 from taxpayer money while “protecting sex-offenders.”\textsuperscript{111} Reprising a salient criticism of modern false political statement rulings, the Supreme Judicial Court of Massachusetts took serious exception the statute’s reporting mechanism, which allowed any party to file a complaint.\textsuperscript{112} Furthermore, the statute did not apply exclusively to false political statements in public, as it was equally applicable to “friends engaging in a spirited political discussion in a local pub.”\textsuperscript{113} The statute could likewise be used for political gamesmanship just as easily as for its intended purpose.\textsuperscript{114} Facing the label of “presumptively invalid” stemming from strict scrutiny, the law was deemed unconstitutional under the First Amendment.\textsuperscript{115} The Court concluded by offering the now proverbial judicial statement that the cure for false speech is true speech.\textsuperscript{116}

IV. Ohio’s Saga as a Microcosm of the Struggle with False Political Statement Laws

With actual malice now relegated to a supporting role in false political statement jurisprudence, a brief case study serves to further demonstrate the evolution of these laws. Ohio serves as a model example, due to its long-line of false political statement cases and its quadrennial role as America’s political bellwether.\textsuperscript{117}

A. First Iteration of ORC; Pestrak & McIntyre

The appropriate starting point for Ohio’s history is Pestrak v. Ohio Elections Comm’n, decided by the Sixth Circuit in 1991.\textsuperscript{118} Walter Pestrak was a candidate for the office of Trumbull County Commissioner, seeking to unseat the

\textsuperscript{111} Id.
\textsuperscript{112} Id. at 1247.
\textsuperscript{113} Id. at 1255 (referencing McIntyre, 514 U.S. at 351).
\textsuperscript{114} Id. at 1248.
\textsuperscript{115} Id.
\textsuperscript{116} Lucas, 34 N.E.3d at 1256.
\textsuperscript{118} See generally Pestrak v. Ohio Elections Comm’n 926 F.2d 573 (6th Cir. 1991).
incumbent holding the same position.\footnote{Id. at 575.} Pestrak placed a number of newspaper advertisements accusing the incumbent of “various illegal acts,” which the court found to be demonstrably false upon review.\footnote{Id. at 575-76.} At the time, the Ohio Revised Code (“ORC”) stated that no person, during the conduct of a political campaign, using campaign material, shall “[p]ost, publish, circulate, distribute, or otherwise disseminate a false statement, either knowing the same is false or with reckless disregard of whether it was false or not, concerning a candidate that is designated to promote the election, nomination, or defeat of the candidate.”\footnote{Pestrak, 926 F.2d at 575 (quoting OHIO REV. CODE ANN. § 3599.091(B)(10) (West 1986) (repealed 1995)).} This largely tracked the language of the “actual malice” standard promulgated in \textit{New York Times v. Sullivan}.\footnote{See generally Sullivan, 376 U.S. at 279.}

The ORC then listed several subsections prescribing the means of enforcement of the statute. Among these was the authorization of the Ohio Election Commission to investigate, hold hearings, and make preliminary findings as to whether the substantive portion of the statute was violated.\footnote{Pestrak, 926 F.2d at 576.} Upon finding a violation, the Commission was then authorized to levy a fine of less than $1,000, present a county prosecutor with the Commission’s findings, and in select instances issue cease-and-desist orders against the violator.\footnote{Id.} In the present case, the Commission held a hearing, found probable cause that Pestrak had violated the statute, and turned its findings over to an appropriate prosecutor.\footnote{Pestrak, 926 F.2d at 576.} Pestrak subsequently lost the election before any formal state prosecution was initiated.\footnote{Id.}

The district court, via summary judgement, struck down all of the statute’s enforcement mechanisms as unconstitutional, specifically as “prior restraint on constitutionally protected speech” and liability on less than clear-and-convincing evidence.\footnote{Id.} At the Sixth Circuit, the court immediately refuted the main proposition of Pestrak and amicus ACLU’s brief; that the statute in its

\begin{thebibliography}{99}
\footnote{Id. at 575.}
\footnote{Id. at 575-76.}
\footnote{Pestrak, 926 F.2d at 575 (quoting OHIO REV. CODE ANN. § 3599.091(B)(10) (West 1986) (repealed 1995)).}
\footnote{See generally Sullivan, 376 U.S. at 279.}
\footnote{Pestrak, 926 F.2d at 576.}
\footnote{Id.}
\footnote{Pestrak, 926 F.2d at 576.}
\footnote{Id.}
\footnote{Id.}
\end{thebibliography}
entirety was unconstitutional as it involved content-based prohibitions on speech.\textsuperscript{128} Relying on \textit{New York Times v. Sullivan}, the court supported the substantive portion of the statute as passing constitutional muster due to its “knowing or reckless” mens rea requirements, which in the court’s view were exempt from constitutional protection as a category.\textsuperscript{129}

Ohio’s laws, however, did not emerge unscathed. Two of the enforcement mechanisms, the levying of fines and issuance of cease-and-desist orders, were found to be constitutionally deficient.\textsuperscript{130} First, no fines involving arguably First Amendment considerations may be levied, except upon presentation of clear-and-convincing evidence.\textsuperscript{131} Second, an alleged violator of the statute had no obvious recourse to the Commission’s cease-and-desist power; there was no opportunity for judicial review.\textsuperscript{132} With these two exceptions, the Sixth Circuit upheld the remaining portions of the ORC.\textsuperscript{133}

Four years later, the ORC was challenged again. This time, however, it was the Supreme Court of the United States who would evaluate the constitutional propriety of Ohio’s false political statement statutes.\textsuperscript{134} In \textit{McIntyre v. Ohio Elections Comm’n}, the core issue was an auxiliary aspect of Ohio’s law, which forbid the dissemination of anonymous leafletting involving “anonymous campaign literature.”\textsuperscript{135} After a winding trip through Ohio’s state courts, ultimately the Ohio Supreme Court upheld the conviction and fine of the petitioner for anonymous leafletting which opposed a school-levy.\textsuperscript{136} The Supreme Court of the United States disagreed, stating that the value of anonymous literature entering the “marketplace of ideas,” political in nature or otherwise, “unquestionably outweighs any public interest in requiring disclosure as condition of entry.”\textsuperscript{137} The Court further described the issue as one of “pure

\textsuperscript{128} Id. at 577.
\textsuperscript{129} Id.
\textsuperscript{130} Id. at 578.
\textsuperscript{131} \textit{Pestrak}, 926 F.2d at 578.
\textsuperscript{132} Id.
\textsuperscript{133} Id. at 580.
\textsuperscript{134} \textit{See generally} McIntyre, 514 U.S. at 334.
\textsuperscript{135} Id. at 336.
\textsuperscript{136} Id. at 339.
\textsuperscript{137} Id. at 342.
speech,” which required “exacting” scrutiny (essentially strict scrutiny) and held that it was not narrowly-tailored to serve an overriding state interest. 138

Somewhat curiously given later developments, the Court appeared to at least acknowledge the aggregate value of Ohio’s other false political statement laws, stating that these were alternative means of preserving the state’s interest in assuring fair elections. 139 After the ruling, the 1986 version of the ORC was amended to reflect the ruling without any other major substantive changes, and stood until being struck-down in its entirety by the Sixth Circuit in 2016. 140

B. Susan B. Anthony List and The Demise of Ohio’s False Political Statement Laws

A case, which no Ohio court or the Sixth Circuit was initially willing to hear on the merits, eventually proved to be the downfall of Ohio’s false political statement laws. In 2010, Steven Driehaus was a member of the United States’ House of Representatives for Ohio’s First District. Prior to the beginning of his re-election campaign, a pro-life political organization, Susan B. Anthony List (“SBA”), created and shopped an advertisement claiming Driehaus supported “tax-payer funded abortions” under the Affordable Care Act. 141 Driehaus’ counsel, after becoming aware of SBA’s intention to contract with a billboard company to publish the advertisement, approached the publisher who in-turn agreed not to display the advertisement. 142 Despite the incident, SBA subsequently ran the ad through other means. 143

Approximately one month before the election took place, Driehaus filed a formal complaint with the Ohio Election Commission (“OEC”) accusing SBA of violating Ohio’s false political statement laws under the ORC. 144 The penalty was a misdemeanor that included up to six-months imprisonment, a $5,000 fine, or

138. Id. at 345-46 (quoting Meyer v. Grant, 486 U.S. 414, 420 (1988)).

139. Id. at 348 (“Ohio does not, however, rely solely on § 3599.09(A) to protect that interest. Its Election Code includes detailed and specific prohibitions against making or disseminating false statements during political campaigns.”).

140. See generally OHIO REV. CODE ANN. § 3517.21 (West 2016); see also Susan B. Anthony List, 814 F.3d at 466 (striking down Ohio’s 1995 amended statue).


142. Id.

143. Id.

144. Id.
both.\footnote{145} At the probable-cause hearing, SBA claimed the statement was “true”, after which the OEC voted 2-1 finding probable cause that SBA had violated one of the statutes, and recommended a hearing before the full commission.\footnote{146} After a brief but impressive whirlwind of legal maneuvering in the district and appellate courts, Driehaus ultimately withdrew his complaint after losing his re-election bid.\footnote{147}

After withdrawal of the OEC proceedings, the Ohio Southern District Court lifted the stay, and SBA subsequently withdrew its complaint.\footnote{148} At this point, the Coalition Opposed to Additional Spending and Taxes (“COAST”), another political action committee critical of Driehaus, took up SBA’s mantle as plaintiff.\footnote{149} COAST asserted its desire to engage in speech similar to SBA, but was “fearful” of being subjected to SBA’s treatment and held-off on disseminating certain campaign materials.\footnote{150} The district court dismissed COAST’s now consolidated, amended complaint challenging the constitutionality of Ohio’s laws as failing on ripeness and standing grounds.\footnote{151} In the district court’s view, COAST’s “alleged subjective chill” was too conjectural to be adjudicated, and furthermore there was no “real and immediate threat of prosecution” as COAST maintained what it had intended to disseminate was true.\footnote{152} The district court concluded by offering up another significant hurdle COAST was to face; the speech it claimed was being “chilled” warranted no constitutional protection if it were, in fact, false speech.\footnote{153} On appeal, the Sixth Circuit affirmed the district court’s ruling in its entirety.\footnote{154}

\footnote{145} See Susan B. Anthony List, 134 S. Ct. at 2339.
\footnote{146} Susan B. Anthony List, 805 F. Supp. 2d at 414.
\footnote{147} Id. at 415 (quoting the Sixth Circuit denial of injunction) (“SBA List clearly has not been enjoined from any speech, and all indications are that its speech continues to be robust.”).
\footnote{148} Id.
\footnote{149} Id.
\footnote{150} See id. at 415-16.
\footnote{151} Id. at 420 (referencing test as laid out in Insomnia, Inc. v. City of Memphis, Tenn., 278 Fed. App’x 609, 612 (6th Cir. 2008)).
\footnote{152} Susan B. Anthony List, 805 F. Supp. 2d at 420.
\footnote{153} Id. at 422 (“Ohio’s false statement statute does not encroach upon any constitutionally protected speech.”).
COAST, undeterred by the trial and appellate court’s refusal to hear the case on the merits, applied for and was granted certiorari in 2014. Justice Thomas wrote the opinion of a unanimous court, stating that COAST’s claims had sufficient “ripeness” and Article III standing to proceed to adjudication. In particular, COAST’s intent to engage in its stated course of conduct rendered the threat of enforcement sufficiently imminent. The opinion, while not deciding the case on its merits, appeared to offer a great degree of skepticism regarding Ohio’s laws generally. Justice Thomas lamented that Ohio’s law “sweeps broadly,” and suggested that the “any person” language of the statute could be a tool of harassment wielded by political rivals. Furthermore, the statutes, by mere existence, forced individuals to choose between “refraining from core political speech” and being subjected to lengthy and expensive OEC administrative proceedings, regardless of whether the case is ever presented in a court of law.

Now squarely faced with the issue, the Southern District of Ohio ruled on the merits. Holding Ohio’s false political statement laws were content-based restrictions subject to strict scrutiny, the district court granted COAST summary judgment, rendering the laws unconstitutional and permanently enjoining the OEC from enforcement. On appeal before the Sixth Circuit for the second time, the appellate court held that its previous analytical framework under Pestrak was no longer valid due to intervening Supreme Court decisions. Furthermore, the Sixth Circuit held that the 1986 version of the statute evaluated in Pestrak was “alleviate[d]” to some degree by different enforcement mechanisms. Specifically, the 1986 version of the ORC did not provide the OEC with power to issue probable-cause findings. Instead, the

155. See Susan B. Anthony List, 134 S. Ct. at 2334, 2337, 2347.
156. Id. at 2343.
157. See id. at 2337, 2344.
158. Id. at 2347 (“[Ohio’s statute is] forcing them to choose between refraining from core political speech on the one hand, or engaging in that speech and risking costly Commission proceedings and criminal prosecution on the other.”).
160. Susan B. Anthony List, 814 F.3d at 471.
161. See id.
162. Id.
OEC had to wait until investigations were complete before it could offer a ruling.\textsuperscript{163}

The Sixth Circuit then turned to \textit{Alvarez} to reject the notion that false speech possessed no categorical First Amendment protection, despite other courts’ apprehensions as to the degree to which \textit{Alvarez} was applicable to false political statement jurisprudence.\textsuperscript{164} No longer able to shield Ohio’s false political statement laws with the actual malice standard, the court held that the laws regulated political speech, and therefore core-speech, which is evaluated under a strict scrutiny standard.\textsuperscript{165}

Under a strict scrutiny standard, as the Sixth Circuit noted, the laws at issue must: "(1) serve a compelling state interest and (2) [be] narrowly tailored to achieve that interest."\textsuperscript{166} While largely conceding that Ohio’s interest in protecting voters from the “confusion and undue influence” of false political advertising was compelling, the second prong of strict scrutiny analysis was unsatisfied.\textsuperscript{167} The Sixth Circuit found the laws were deficient due to lack of adequate screening processes to weed out frivolous complaints, applicability to non-material statements, liability of media and other intermediaries, and general over- and under-inclusiveness.\textsuperscript{168} Accordingly, the court held that the laws were unconstitutional and struck them down in their entirety.\textsuperscript{169}

\textbf{V. CONSISTENT STANDARDS, CONSISTENT CRITICISMS, AND IMPROVEMENT}

Given the veritable mountain of negative judicial opinion regarding false political statement laws over the last several years, one might reasonably question how these laws are salvageable—if even worthy of the effort. To this end, I propose a new formulation that preserves the valuable aspects of false

\textsuperscript{163} \textit{id.}

\textsuperscript{164} \textit{See id.} at 471-72 (referencing the Supreme Court’s rejection in \textit{Alvarez} of the “‘categorical rule . . . that false statements receive no First Amendment protection.’”). \textit{But see} 281 Care Comm., 766 F.3d at 779 (reasoning that the \textit{Marks} test regarding fragmentation would indicate that the concurring opinion of Justice Breyer is the appropriate standard if \textit{Alvarez} has any precedential value for false political statement cases).

\textsuperscript{165} \textit{See id.} at 473.

\textsuperscript{166} \textit{Susan B. Anthony List}, 814 F.3d at 473.

\textsuperscript{167} \textit{See id.}

\textsuperscript{168} \textit{See id.} at 474.

\textsuperscript{169} \textit{id.} at 476.
political statement laws, while mitigating or eliminating many of the negative qualities. Additionally, while it appears that strict scrutiny is the “go-to” for false political statement laws in the current judicial climate, this may not be the appropriate standard to apply. Until the Supreme Court weighs in definitively, the prospect of intermediate scrutiny must continue to be entertained as the possible standard for false political statement laws.

A. False Political Statement Laws Serve a Valuable Function

Outright falsehoods have little to no value from a utilitarian prospective. Until recently, it was a relatively common presumption that First Amendment safeguards did not extend to false statements made with either knowledge of untruthfulness or a reckless disregard as to whether the statement was true. A politically-motivated false message, done for the purpose of persuading a voter to cast a ballot in a particular way, works real and tangible harm to the democratic process. First and foremost, a voter who is moved by the false message is now operating with faulty knowledge of a candidate or issue, and in-turn is more likely to vote in a fashion that does not reflect the individual’s actual will or values. Moreover, the person who disseminates the false political statement can more easily exploit that vulnerability if there is no real threat of sanction. One can easily envision the exorbitant amounts of money to be spent on crafting advertisements that are patently false.

It is incumbent upon citizens to make informed democratic choices to ensure the government’s actions are consistent with their values. Even in a hypothetical climate where well-funded political organizations are largely given carte blanche to disseminate whatever information suitable to their particular ends, the public has a duty to inform itself of a political matter’s truth, irrespective of any difficulty. Nonetheless, it is fair to assume that a weary public who is already skeptical – if not outright cynical – of information proffered during election season would be even more alienated in a system that does not

170. See Garrison, 379 U.S. at 75; see also Alvarez, 132 S. Ct. at 2552 (Breyer, J., concurring) (explaining that false factual statements are less likely than are true factual statements to make a valuable contribution to the marketplace of ideas).

171. See Rickert, 168 P.3d at 833-34 (Madsen, J., dissenting); see also Alvarez, 132 S. Ct. at 2541.


173. See Rickert, 169 P.3d at 833-34 (Madsen, J., dissenting).
formally punish these sorts of falsehoods. The proposition that “more speech” could “cure” false speech in a climate where many voters are already tired, confused, and mistrustful of media fact-checking is not entirely tenable.

A major component of having false political statement laws is symbolic. Calculated falsehoods do not advance the democratic process, and laws usually serve as a formal expression of a society’s values and ideals. Though imperfect, false political statement laws deter some of the worst kinds of misinformation engineering—those that subvert an informed electorate. A well-crafted law would only punish the most egregious falsehoods and serve as a looming reminder to those who would otherwise be inclined to engage in behavior that substantially frustrates the purpose of informed elections.

B. A Proper Analytical Framework?

Alvarez is a less-than-perfect precedent to evaluate false political statement laws. The factual background in Alvarez dealt with false statements about military honors under federal law; it was not explicitly political and certainly not concerned with the electoral process. Moreover, the Marks standard, as observed by the Eighth Circuit, casts some doubt on whether the majority or concurring opinion is binding. Additionally, at least one circuit has openly stated Alvarez is not the framework to evaluate false political statement laws. Absent some future guidance from the Supreme Court, courts will likely continue to struggle and stretch Alvarez to interpret false political statement statutes.

174. Id. at 842.


176. See Rickert, 169 P.3d at 842 (Madsen J., dissenting).

177. See 281 Care Comm., 766 F.3d at 783 (8th Cir. 2014) (“[A]lthough Alvarez dealt with a regulation proscribing false speech, it did not deal with legislation regulating false political speech . . . [this is the reason why] Alvarez is not the ground upon which we tread.”).

178. See id. at 782-83.

179. See id. at 779.

180. See id. at 783 (“[A]lthough Alvarez dealt with a regulation proscribing false speech, it did not deal with legislation regulating false political speech . . . [this is the reason why] Alvarez is not the ground upon which we tread.”).
Despite questionable binding authority, *Alvarez* does indicate a number of reference points for interpreting aspects of false political statement laws. False statements are not, as a category, exempt from First Amendment protection.  

“Actual malice” has implicitly been relegated to a factor role. Given this, courts will continue to apply some scrutiny standard to false political statement laws because they implicate some constitutionally-protected content. If a court applies a strict scrutiny standard, the law must (1) serve a compelling governmental interest, and (2) be narrowly tailored to achieve that interest. It is highly doubtful that any current laws implicating speech—particularly those that deal with political speech—would survive that demanding standard. Alternatively, “intermediate” or “proportionality” scrutiny is a far more forgiving analytical framework. Under that framework, the law in question must have governmental utility that outweighs any perceived infringement on speech-related rights, essentially a cost-benefit analysis.

C. A Few Proposals

Even though Justice Breyer in his *Alvarez* concurrence expressed some apprehension as to whether political statements could survive even a more lenient standard, his opinion—and many other recent cases—indicate what aspects of false political statement laws are particularly objectionable. If any variation of these laws are to withstand judicial scrutiny, several common features of false political statement laws must be excised.

181. See *Alvarez*, 132 S. Ct. at 2545; see also *Susan B. Anthony List*, 814 F.3d at 471-72.
182. See *Alvarez*, 132 S. Ct at 2545 (referencing *Garrison*, 379 U.S. at 75 (1964)).
183. *Id.* at 2552 (Breyer, J., concurring).
185. See *Alvarez*, 132 S.Ct. at 2552 (Breyer, J., concurring).
186. See *id*.
187. *Id*.
188. See *Susan B. Anthony List*, 814 F.3d at 475 (“Ohio’s laws apply to all false statements, including non-material statements.”); see also *Lucas*, 34 N.E.3d at 1255 (“[the Massachusetts statute] reaches not only those statements that are widely disseminated through commercial advertisement, but also those exchanged between two friends engaged in a spirited political discussion in a local pub.”); see also *Rickert*, 168 P.3d at 830 (“there is no requirement that the statements subject to sanction under [the statute] be of the kind that tend to cause harm to an individual’s reputation.”).
Though actual malice is no longer the golden standard by which courts evaluate false political statement laws, it remains an indispensable requirement. By requiring that individuals be only punished for knowing or reckless falsehoods, actual malice heavily reduces the potential fear that individuals would refrain from expressing political opinions that are honestly held or even doubted to some extent. But this can be taken even further to reduce concerns about “chilling” speech. The statutes could require a specific intent for a violation. For example, an individual must make the false statement knowingly or recklessly with the purpose of misinforming the public regarding a ballot measure, voter eligibility, polling times or locations, or by defaming a candidate for public office. Some states use vaguer, open-ended language toward this end. It is not enough that the party intended to affect the outcome of the election because that element is presumed by the very act of widely disseminating political statements. This requirement would likely serve to punish only the most serious violations and more readily promote the purpose of the statutes—ensuring fair and informed elections. The statutes could further prescribe that the alleged violation be proven by clear-and-convincing evidence, which many but not all false political statement laws do explicitly.

But there is more that could be done. Some statutes do not add the qualifier that the statements are material in nature. With this omission, petty and insignificant false statements are theoretically drawn within the purview of statutes just the same as those that serve to significantly misinform the public and disrupt the election process. Of particular concern is that many statutes at least implicitly are applicable to non-public statements. Besides any

189. See Sullivan, 376 U.S. at 271-72 (referring to “breathing space”); see also Alvarez, 132 S. Ct. at 2553 (Breyer., J. concurring) (“Hence, the Court emphasizes mens rea requirements that provide ‘breathing room’”).

190. See Sullivan, 376 U.S. at 279-80.


192. See, e.g., Wisc. Stat. Ann. § 12.05 (West 2015) (punishing a false statement that “is intended or tends to affect voting of an election.”); see also Ohio Rev. Code § 2517.21(A) (West 2013) (requiring “knowingly and with the intent to affect the outcome of such campaign”).

193. See, e.g., Pestrak, 926 F.2d at 576.

194. See Susan B. Anthony List, 814 F.3d at 473

195. Id.

196. See, e.g., Lucas, 34 N.E.3d at 1255 (“[the Massachusetts statute] reaches not only those statements that are widely disseminated through commercial advertisement, but also those exchanged between two friends engaged in a spirited political discussion in a local pub.”).
imaginary justifications, this lends to the appearance of the government engaging in the paternalistic and “Orwellian” function of declaring what constitutes the truth, as noted by Justice Kennedy in *Alvarez*. While it is highly doubtful that few, if any, prosecutors would even entertain the idea of prosecuting a person who lied about a political candidate in their own home, the very notion that such prosecution is even possible is unacceptable.

Returning to *New York Times v. Sullivan*, Justice Black reasoned in his dissent that denial of recovery to the Alabama Commissioner was proper due to the “absolute, unqualified” immunity of The New York Times as a media outlet to criticize political candidates. This warrants revisiting. Many false political statement statutes insulate media and advertisers, so long as the media and advertisers are not themselves the ones engineering the false statements. Numerous courts have pointed directly to the inclusion or omission of these provisions. As such, a false political statement law should include provisions that are careful to avoid “sweep[ing] broadly” and targeting intermediaries. All of these factors and considerations needlessly raise the degree to which speech-related rights are adversely impacted and hampers the ability of the statutes as a whole to withstand any form of cost-benefit analysis.

Though peripheral to the ability of false political statement laws to survive judicial scrutiny, an exercise in direct democracy could serve to test whether the statutes truly reflect the will of the public. The Sixth Circuit’s decision in *Susan B. Anthony List* abrogated Ohio’s statute, and as the most recent state to lose its false political statement laws, it is a prime candidate for consideration. Ohio is one of twenty-four states that allows for some form of direct vote or ballot initiative to introduce new laws. As such, it is possible that a new false

197. See *Alvarez*, 132 S. Ct. at 2547 (referencing the book Nineteen Eighty-Four by George Orwell).

198. See *Sullivan*, 376 U.S. at 293 (Black, J., concurring).

199. See, e.g., *281 Care Comm.*, 766 F.3d at 778 (referencing Minnesota’s statute); see also *Susan B. Anthony List*, 814 F.3d at 476 (referencing Ohio’s statute); see also Samuel S. Sadeghi, *Election Speech and Collateral Censorship at the Slightest Whiff of Legal Trouble*, 63 UCLA L. REV. 1472, 1476 (2016).

200. *281 Care Comm.*, 766 F.3d at 778; *Susan B. Anthony List*, 814 F.3d at 476.

201. See, e.g., *Susan B. Anthony List*, 134 S. Ct. at 2344 (“The Ohio false statement law sweeps broadly”).

202. See *Susan B. Anthony List*, 814 F.3d at 466.

political statement law could be put to a vote after obtaining 1,000 signatures of registered state voters.\textsuperscript{204} After garnering the prerequisite signatures, the Ohio Attorney General must make a “fair and truthful” assessment and certification to Ohio’s Secretary of State.\textsuperscript{205}

This is only the initial step on a difficult path to a state-wide ballot, but nonetheless it could prove a valuable exercise in gauging public opinion. There is, however, an irony in the fact that if a false political statement law proposal were ever go to a vote in Ohio, it could be knowingly and recklessly lied about with virtual impunity.

VI. OUTLOOK & CONCLUSION

The next several years will be critical for the survival of false political statement laws. After several key circuit and state supreme court decisions, it appears judicial attitudes towards the statutes are growing increasingly unfavorable. It is likely that as more invalidations occur, the prospect of any court upholding the statutes will wane as the negative holdings reach a critical mass. However, it should be cautioned that the Supreme Court has yet to take a false political statement case on constitutional merits in a number of years, and the probability of doing so by its own volition or spurred by a circuit-split is certainly possible. The Court may also wish to correct the “fragmented” and unclear precedential quality of Alvarez.

Regardless of what comes next for the statutes currently on the books, this note has sought to explore the history and various criticisms of false political statement laws in their current iterations. A significant portion of current State false political statement laws do not precisely achieve the goal of protecting the fairness and integrity of the electoral process. Irrespective of the scrutiny standard, certain aspects of false political statement laws are indispensable. These include the requirements of clear-and-convincing evidence, reservation for material statements, and insulating media and advertisers. More auxiliary suggestions could further alleviate collateral harm and improve utility. Finally, if these laws are truly reflective of public will, a form of direct democracy could shed light on what direction, if any, false political statement laws should have going forward.


\textsuperscript{205} Id.
THE CONVICTED CHILD SEX OFFENDER NEARBY: DOES PRIVATE NUISANCE PROVIDE A REMEDY FOR NEIGHBORS?

Henry L. Stephens, Jr.*

I. INTRODUCTION

“Since English law began its development in a landed society, it was natural that its primary purpose was the protection of real property.”¹ The law of nuisance and the law of trespass were developed to complement each other; while trespass provided security against direct invasions of possession, nuisance provided protection against indirect injuries to land or its use and enjoyment.² In early cases, the formulation of the tort presupposed that the plaintiff was entitled to absolute protection from activities deemed to be nuisances, without regard to the social utility of the defendant’s conduct.³

However, by 1960, Kentucky courts recognized that the utility and reasonableness of the defendant’s conduct were vital considerations in determining whether a nuisance was deemed to exist. In Louisville Refining Company vs. Mudd, 339 S.W.2d 181 (Ky. 1960), Kentucky’s highest court ruled that:

[w]hat would be a substantial interference with the enjoyment of life in a residential area might very well be perfectly normal and inescapable in an industrial section. The problem becomes one of measuring what is normal and what is abnormal interference with life in an industrial area . . . Though negligence upon part of defendant need not be proved, whether defendant was doing as much as reasonably was possible in the way of careful operation becomes the measure of whether there has been substantial interference with plaintiff’s enjoyment of life.⁴

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2. Id. at 241.
3. Id. at 242 (“The presence or absence of a nuisance therefore is not measured by its cause, but by its effect. It is a condition and not a type of conduct. A nuisance is an interference with the use and enjoyment of another’s land; if there is substantial interference an actual nuisance results without regard to the type of conduct causing the annoyance.”).
Referencing the balancing test employed by the original Restatement of Torts, the *Mudd* holding explained as follows:

Without fully subscribing to the serpentine approach of the Restatement of the Law of Torts (Ch. 40, paragraphs 822–831), we accept the proposition that the existence of a nuisance must be ascertained on the basis of two broad factors, neither of which may in any case be the sole test to the exclusion of the other: (1) the reasonableness of the defendant’s use of his property, and (2) the gravity of harm to the complainant. Both are to be considered in the light of all the circumstances of the case, including the lawful nature and location of the defendant’s business, the manner of its operation, and such importance to the community as it may have; the kind, volume, time and duration of the particular annoyance; the respective situations of the parties; and the character (including applicable zoning) of the locality. The extreme limits are therefore, on the one hand, the reasonable use causing unreasonable damage and, on the other hand, the unreasonable (or negligent) use causing damage that is more unnecessary than severe.6

The Kentucky General Assembly codified Kentucky’s law of nuisance in 1991.7 Citing Kentucky statutory law,8 the United States District Court for the Eastern District of Kentucky stated in *Fletcher v. Tenneco, Inc.*9 that “Kentucky’s codification of the common law of nuisance frames the inquiry concerning the gravity of harm as a determination of whether a defendant’s use of its property

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5. *RESTATEMENT OF TORTS § 826 NUISANCE* (1934).

6. *Mudd*, 339 S.W.2d at 186-87. The Kentucky court accepted, without further analysis, the ALI’s determination that a nuisance exists *vel non*, only after balancing the offending conduct against its utility. See Jeff L. Lewin, *Compensated Injunctions and the Evolution of Nuisance Law*, 71 IOWA L. REV. 775,782 (1986) [hereinafter “Lewin”] (“The ALI, however, failed to explain why the initial question of whether a nuisance exists or not should depend upon the outcome of the balancing test with the problem of inappropriate injunctions had already been dealt with through the balancing test in the chapter on Injunctions. Nevertheless, Dean Prosser confirms that the existence of a nuisance depends upon balancing the relative positions of plaintiff and defendant.”).

7. *KY. REV. STAT. ANN.* § 411.500 (West 2016) (“It is the intent of the General Assembly to restate and codify in KRS 411.500 to 411.570 the common law of nuisance as existing in the Commonwealth on May 24, 1991.”).


would ‘substantially annoy or interfere with the use and enjoyment of property by a person of ordinary health and normal sensitivities.’”

While it is axiomatic that the tort of nuisance protects property and its use and enjoyment, the affected property owner may also have a claim for personal injuries, including claims for fear, distress, or even PTSD, causally related to the nuisance. Kentucky law makes clear that while such claims may be joined in a nuisance action, they must be pled and proved using traditional tort theories such as negligence or intentional tort.

This article explores whether the law of nuisance, as it has evolved over the centuries, is yet flexible enough to provide a remedy to homeowners who see their property use and property values diminished by neighboring activity that may have remained largely hidden until the 21st century: the neighbor nearby becomes a convicted sex offender, is put on the public sex offender registry, and everyone knows it, and is talking about it.

Not surprisingly, as of this writing, there are no reported cases analyzing the applicability of the law of private nuisance to remedy such harms. Accordingly, cases where the law of nuisance has been held applicable will be analyzed and applied by analogy to determine if this venerable tort provides a remedy for this increasingly prevalent problem. Cases from various jurisdictions will be analyzed to determine if the harms identified as nuisances in such cases would also be so categorized under Kentucky’s legislatively codified nuisance scheme. Throughout the article, such cases will be compared to the Restatement of Torts to determine whether jurisdictions that adhere to a strict Restatement formulation of the law of nuisance would reach a contrary result. Finally, in the event that the substantive law supports a justiciable case for private nuisance, the article explores the legal underpinning and practicality of the various remedies available. The article concludes by asserting that while the facts

12. See Palmore, supra note 4, at 5, stating:

   KRS 411.560 (3) specifically prohibits any reward “for annoyance, discomfort, sickness, emotional distress, or similar claims.” It further provides that if a claim for personal injury or damage is asserted in the same proceeding, it must be resolved on the basis of applicable principles independently of whether a nuisance is found to exist. (citations omitted). This is in keeping with the fundamental premise that the gravamen of a nuisance is damage to property rather than persons. Otherwise, the factors that are required for consideration in determining the existence of nuisance would be largely inappropriate.

13. See infra text accompanying notes 113-119.
asserted herein to allegedly justify recovery under the law of nuisance are novel, existing case law supports extending the law to protect property owners suffering diminution in value and loss of use of their property attributable to its proximity to a convicted sex offender.

II. HOW DO NEIGHBORS BECOME AWARE OF THE NEIGHBORING SEX OFFENDER?
COMMUNITY NOTIFICATION PROCEDURES FOR
CONVICTED SEX OFFENDERS – A BRIEF OVERVIEW

Congress passed the Jacob Wetterling Crimes Against Children and Sexually Violent Offender Registration Act in 1994. 14 The Act mandated that all states enact programs requiring those offenders convicted of a criminal offense against a minor or a sexually violent offense to register a current address with state or local authorities. 15 It also defined the length of required registration based upon previous number of convictions, the nature of the offense, and the characterization of the offender as a sexual predator. 16

“Community notification laws are relatively recent legislative enactments that followed state statutes requiring convicted sex offenders to register with the state upon release from incarceration.” 17 As many as 47 states now require sex offenders to register with local authorities. 18 As mandated by the federal statutes, Kentucky statutorily required certain sexual offenders to register with local law enforcement officers upon their release from imprisonment. 19 As with most other states, the Kentucky law required that offenders must include their name, local address, fingerprint, and photograph with the information to be updated at least every two years. 20 While Kentucky complied with the Wetterling Act’s minimum registration period of ten years, thereby meeting the minimum standards required by the federal Act, 21 Kentucky went further, as did

15. Id. § 14071(a)(1)(A).
18. Id.
a number of states,\textsuperscript{22} by increasing the registration period from 10 to 20 years, and by imposing residency restrictions that bar convicted sex offenders from living within 1,000 feet of a high school, middle school, elementary school, preschool, publicly owned playground, or licensed day care facility.\textsuperscript{23}

Accordingly, in this age of instant communication, it is no longer the case that notifications arrive surreptitiously in the mail or simply by word-of-mouth. What with Facebook, Instagram, Twitter, LinkedIn and whatever will come next, notification is instant, widely publicized, and will be the source of consternation and gossip in the neighborhood. To emphasize, everyone will know everyone.

III. THE PROBLEM FOR NEIGHBORS

Assume for the sake of discussion that you are a hard-working, college-educated professional who has scrimped and saved to purchase your “dream home” in a nice secure neighborhood in order to provide the best environment you can afford for your family. You find the ideal home in an upscale neighborhood and purchase it for $450,000. Several years after you move in, a couple moves into the neighborhood; they seem nice enough, keep their property well-manicured and generally mind their own business.

Coming home from work one evening, you see three police squad cars in their driveway. You are thinking perhaps a home invasion robbery, vandalism, or perhaps at worst, a charge of embezzlement from one of their employers. Needless to say, the neighborhood is abuzz. You are advised that he was immediately terminated from his employment. The next morning when you drop your child off at daycare, you are shocked to see photographs of this neighbor posted on their bulletin board, complete with name and address with the notation “charged as a sex offender – child pornography-under age 3.” The information is now in the community. Shortly thereafter, the neighbor pleads guilty, is given a fine, lengthy probation and registration on the Kentucky Sex Offender Registry for no less than 20 years.

Several weeks later, you decide to have a family cookout for friends with games for the children. Several of your invited friends call to regretfully express concern over their children playing outdoors close to a convicted sex offender. You have the same experience with friends several weeks later when their children are invited to your child’s birthday party. In fact, a number of your friends have said that they have concerns about their children being at your house under any circumstances. Your children have inquired why their friends

\textsuperscript{22} Sterrett, supra note 16, at 123.  
\textsuperscript{23} KY. REV. STAT. ANN. §17.545 (West 2016).
won’t come to their house. Distraught and anxious, your sleep is disturbed by the current situation and you begin to worry whether you will have difficulty selling your home given its proximity to the offender. The first thing you do is to “Google” the problem. You discover research studies that have shown that an affected property owner may suffer a diminution in value of anywhere between 9% and 20% when the property is ultimately sold. Panicking, you seek legal advice.

IV. THE LAWYER’S ANALYSIS

A. Is the Defendant’s Conduct Cognizable Under the Law of Private Nuisance in Kentucky?

After meeting with the client, and ascertaining that he appears deeply distressed, the lawyer prepares to analyze whether the law of private nuisance in Kentucky might afford a remedy. She focuses on Mudd’s requirement that the existence of a nuisance must be ascertained on the basis of two broad factors, neither of which may in any case be the sole test to the exclusion of the other: (1) the reasonableness of the defendant’s use of his property, and (2) the gravity of harm to the complainant.

Focusing on the first factor, the reasonableness of the defendant’s use of his property, she is immediately faced with an ambiguity. The only “use” defendant is making of his property is his living there. While the conduct that resulted in him being placed on the Sex Offender Registry may (or may not) have occurred at his residence, whether it did or not, your client was unaware of any offending activity until such time as public authorities notified the community as they are required to do. So, counsel questions whether the harm suffered by her client is the putative defendant’s child pornography activity itself, or is it rather the legalized societal stigma placed upon the defendant by the judicial system after the offending conduct has occurred and been adjudicated? Counsel’s research discloses that no reported cases have addressed the issue. Therefore, as a case of first impression, her presentation of the case must rest upon the hollow blocks of analogy, rather than the poured

24. See infra text accompanying notes 115-120.

25. Mudd, 339 S.W.2d at 186.

26. Is the offensive “act” of the defendant his child pornography viewing activities or, alternatively, his having been listed on the sex offender registry?

27. Nevertheless, it is his continued “use” of his property in this matter that arguably has caused plaintiff’s property to be diminished in value thereby.

28. See supra notes 17-23.
concrete of *stare decisis*. She starts her research broadly, hoping to find clues to narrow the scope of analysis.

According to the Restatement (Second) of Torts “the conduct necessary to make the actor liable for either a public or a private nuisance may consist of (a) an act; or (b) a failure to act under circumstances in which the actor is under a duty to take positive action to prevent or abate the interference with the public interest or the invasion of the private interest . . .”29 The Comments to the Restatement attempt to elucidate the type of “act” undertaken by the defendant that may give rise to liability in Nuisance:

In the ordinary case, [nuisance liability] arises because one person’s acts set in motion a force or chain of events resulting in the invasion. The acts may be a direct and immediate cause of the invasion, as in the case where the noise from the actor’s operation of a riveting machine is the thing complained of, or *they may be an indirect cause of the invasion*, as in the case where the offensive smells from a garbage pile or other physical condition created by the actor are the thing complained of. So far as the actor’s liability is concerned, it is immaterial whether he does the acts solely in the pursuit of his own interests or whether he is acting for another, gratuitously, under contract or as the other’s servant or agent. It is enough that his acts are a legal cause of the invasion.30

While the Restatement text and comments appear encouraging, as one commentator has opined, “[i]n general, merely living somewhere is not sufficient conduct to constitute a nuisance. Additionally, basing a nuisance claim on a person’s status (such as race or gender) would generally be unsuccessful.”31 Moreover, as Professor John Copeland Nagle explained in his well-reasoned article:

[v]irtually anything could constitute a nuisance because virtually anything could interfere with somebody’s use and enjoyment of her land. The reported cases alone contain claims that a church, a group home for those suffering from a contagious disease, and the mere presence of an unmarried couple or an African-American family are viewed as a nuisance through the eyes of some neighbors. It is also conceivable that someone would regard the proximity of Republicans

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30. *Id.* cmt. b (emphasis added).
or Democrats, gays or fundamentalists, or Mets fans or Yankees fans, as a nuisance. This is not what nuisance law is about.  

“However, due to the current stigma of dangerousness attached to nearby sex offenders, a court may distinguish the situation of a sex offender living in a residential neighborhood, particularly around young children, from most claims based on the mere presence of a person of a certain status in a neighborhood.”

Additionally, should it really matter if neighbors were unaware of the defendant’s illegal conduct until such time as authorities brought it to their attention? They are harmed at the point in time when they know of the defendant’s activity. By analogy to personal injury medical malpractice actions, most states provide a statute of repose for a plaintiff, requiring that the action be commenced within a specified period of time after the plaintiff knows, or has reason to know, that he has been injured at the hands of a medical professional. In addition, there is no question but what it is the defendant’s conduct that has created the harm, and that harm has occurred when plaintiff becomes aware of the danger associated with the neighbor’s status, which the law has conferred upon him because of his prior action. So counsel is unconcerned with the issue of whether the defendant’s conduct directly or


33. Hartzell-Baird, supra note 31, at 383-84 n. 155. On an unrelated, but often discussed issue, the author opines that:

[another issue that has not been addressed by the courts is whether homeowners could prevent sex offenders from moving into their neighborhood through the use of state nuisance laws (citations omitted). The argument has two components: (1) The nearby sex offender is a nuisance because he/she endangers the comfort, repose, health, or safety of others, and (2) The nearby sex offender is a nuisance due to the diminution in property values that results from his/her presence. If a sex offender does qualify as a nuisance, the homeowner would be able to either seek money damages... or enjoin the offender from moving into the neighborhood... .

Id. at 382.

One author has attempted to analogize restrictive covenants precluding sex offenders from purchasing homes in planned communities to Jim Crow laws and red line restrictions. This completely misses the point. Such antiquated, discriminatory provisions sought to exclude persons purely because of their status, rather than voluntary actions on their part that resulted in harm to others. Such laws, to use Professor Nagle’s examples, supra, are akin to seeking to exclude Republicans, Mets fans or supporters of Donald Trump. Residency restrictions seeking to preclude convicted sex offenders from moving into the neighborhood are not based upon one’s status as a person, but rather one’s status as a societal offender, having thus so been adjudicated. In short, Jim Crow laws and residency restrictions sought to exclude people because of who they are, not what they did. See generally Asmara M. Tekle, Safe: Restricted Covenants and the Mixed Wave of the Sex Offender Legislation, 62 SMU L. REV. 1817 (2009) [hereinafter “Tekle”].

34. See, e.g., KY. REV. STAT. ANN. §413.140(2) (West 2016).

35. See supra text accompanying note 33.
indirectly caused the harm to the plaintiff. But for the defendant’s conduct, no harm would’ve occurred. Thus, the defendant’s continued use of his property as a residence is the offending use, brought about solely by his own conduct.\footnote{See infra text accompanying note 195.}

Counsel feels confident concerning Mudd’s second requirement, the gravity of the harm to the plaintiff.\footnote{Mudd, 339 S.W.2d 181 at 185-86.} In twenty-first century society, convicted sex offenders are universally loathed and represent modern-day America’s least desirable neighbors all.\footnote{Lior Strahilevitz, Information Asymmetries and the Rights to Exclude, 104 Mich. L. Rev. 1835, 1887 (2006).} Moreover, while it can be argued that many persons listed on sex offender registries pose little or no risk to society and that the types of offenses justifying inclusion on sex offender registries are overly broad, even the sex offender apologist community has to admit the child sexual predators pose the greatest risk of recidivism, and therefore the greatest danger to society.\footnote{Robert F. Worth, Exiling Sex Offenders from Town: Questions about Legality and Effectiveness, N.Y. Times, Oct. 3, 2005, at B1, available at: http://query.nytimes.com/gst/fullpage.html?res=9C01E3D81030F930A35753C1A9639C8B63 &pagewanted=all (reporting that pedophiles “have recidivism rates of more than 50%”); see also Tekle, supra note 30 at 1825 (confirming “that sex offender covenants should be struck down under the common law unless they are narrowly tailored to focus on the most dangerous convicted sex offenders, a determination based on original offense or future risk of dangerousness.”) (emphasis added).}

But Mudd cautions that, consistent with the approach of the Restatement, both the gravity of the harm to the plaintiff and the reasonableness of the defendant’s use of his property must be analyzed in light of all the circumstances of the case, to determine whether a nuisance exists in law in the first place.\footnote{See supra text accompanying note 7.} Among the circumstances Mudd mandates for consideration by the court are whether the defendant’s use of his property is lawful, how long it has been ongoing, and its importance to the community.\footnote{See supra text accompanying note 7.}

Analysis of these factors virtually mirrors the analysis undertaken previously herein concerning the defendant’s “use of his property.”\footnote{See supra text accompanying note 33.} So, while the defendant’s “use of his property” is “lawful,” in the sense that there are no statutes or regulations prohibiting his living where he does, the “activity” which produces the nuisance claim in the instant case was clearly so unlawful and potentially dangerous as to cause Kentucky, and the vast majority of states, to
require that neighbors be warned of his presence\(^{43}\). If his residency and occupancy in the neighborhood pose no problem, why notify neighbors at all? Moreover, even the least restrictive states require that the offender remain on the sex offender registry for five years, and 13 states require that the offender stay on the registry for life.\(^{44}\) As such, because it was defendant’s perverted and unlawful acts which set in motion the chain of events giving rise to the instant action, it would be stunning for a court to rule that defendant’s continued use of his property for a residence does not give rise to a nuisance, notwithstanding the fact that it was his actions, and solely his actions, that at least “indirectly” caused the harms alleged by plaintiff.\(^{45}\) Accordingly, given that plaintiff’s nuisance claim must proceed under and be sustained by Kentucky’s nuisance statute,\(^{46}\) and given that the factors enumerated in KRS 411.550(1) virtually mirror Mudd’s factors for consideration,\(^{47}\) counsel is comfortable that any argument concerning the legitimacy of defendant’s use of his property can be overcome.\(^{48}\)

Further, an additional factor KRS 411.550 mandates for consideration in determining the reasonableness of defendant’s use of his property is “the kind, volume and duration of the annoyance or interference with the use and enjoyment of claimant’s property . . . .”\(^{49}\) In the context of the convicted sex offender living next door, this factor takes on enhanced importance. In the case of nuisances, the offending activity may either be permanent, in the sense that it is not capable of being eliminated or abated at a reasonable cost,\(^{50}\) or temporary (it is capable of being eliminated or abated at a reasonable cost).\(^{51}\) Whether it is classified as temporary or permanent, the nuisance-like “activity” associated with the sex offender next door creates harms that exist in the mind and therefore exist 24/7. Even in the case of a belching smoke stack or a hog

\(^{43}\) See supra note 16 and accompanying text.


\(^{45}\) See supra text accompanying note 25.

\(^{46}\) See Palmore, supra note 4, at 5.

\(^{47}\) See Palmore, supra note 4, at 3-4.

\(^{48}\) See supra text accompanying notes 26-33.


\(^{50}\) Ky. Rev. Stat. Ann. § 411.530(1)(b) (West 2016). An additional factor in determining the permanency of a nuisance is whether it is “relatively enduring and not likely to be abated voluntarily or by court order.” Id.

\(^{51}\) Ky. Rev. Stat. § 411.540(1) (West 2016) (“Any nuisance that is not permanent by this definition is a temporary nuisance.”).
farm, offended neighbors may enjoy periods of respite when, at least momentarily, they feel free of the offending activity. The same cannot be said for the convicted sex offender next door. The mind conceives that he is there, behind closed doors, lurking to reoffend at his whim.

Professor Nagel has explored what he categorizes as “fear” cases extensively and he references cases where the offending activity was the production of fear in several categories. The category that appears to most closely fit the facts of the instant case is the one he denominates “facilities for those perceived as dangerous.”52 As Professor Nagel explains:

Several cases decided in the late nineteenth and early twentieth centuries held that a facility for those who had a contagious disease constituted a nuisance when located in a residential neighborhood. A more recent Arkansas decision held that a halfway house for prisoners that was located in a residential neighborhood constituted a nuisance. And an Arizona case held that a church that served meals to indigent transients could be a nuisance. The harms in each instance resulted from the fears of those living nearby. These fears prompted concerns about residents’ physical health or safety. They led to worries about potential damage to property. They also reduced property values because others were less willing to locate in the neighborhood. The fact that scientists questioned the possibility of any of these harms actually occurring did not deter courts from accepting such fears as sufficient for purposes of nuisance law. As one court explained, “The question is, not whether the fear is founded in science, but whether it exists; not whether it is imaginary, but whether it is real . . . .”53

While it is certainly the case that society is more tolerant of the housing needs of the disabled and the physically ill in the present day,54 this fact serves to question the continuing vitality of “fear” cases concerning housing for the disabled or physically ill; nevertheless, real, substantiated fear may still give rise to a nuisance claim. The Restatement even uses such an example as an illustration of the principle that “fears and other mental reactions common to

52. See Nagle, supra note 32, at 291-93.
54. Id. Professor Nagle references City of Edmunds v. Oxford House, Inc., 514 U.S. 725 (1995), which held a city’s refusal to allow a group home for recovering alcoholics and drug addicts violated the Federal Fair Housing Act.
the community are to be taken into account, even though they may be without scientific foundation or other support in fact."55

However, in the case of the convicted child sex offender nearby, given the 50% rate of recidivism of such individuals, neighbors’ fears that the offender may reoffend are real and have support in the scientific community.56 Nevertheless, “[t]he mere awareness of the activity, any improper temptation produced by the activity, and reduced property values are not sufficient to establish a nuisance.”57 However, to the extent that the offending activity interferes with plaintiff’s use and enjoyment of his property, and also diminishes the value of his property, the nuisance claim may be justiciable.58

The final factor of KRS § 411.550 requires in consideration of whether the defendant’s use of this property constitutes a nuisance is “[t]he character of the area in which the defendant’s property is located, including, but not limited to, all applicable statutes, laws or regulations.”59 Without question, in the hypothetical herein presented, there are no “applicable statutes, laws or regulations” which serve to prevent the defendant from residing where he does. However, with respect to the “character of the area in which the defendant’s property is located” from the standpoint of the harms to be inflicted upon adjoining neighbors by his presence (fear of children being molested, fear of diminution of property values, etc.) it is hard to conceive that the “character of [any] area in which the defendant’s property is located” would be “appropriate” for the location of the convicted child sex offender. However, it must be remembered that the tort of nuisance, to be judicially sustained, must cause damage to property.60 It is conceivable that the character of some economically depressed neighborhoods may be such that the expert testimony needed to establish a diminution in value61 may not be obtainable.62 As discussed in more

55. Restatement (Second) Torts § 821(f) cmt. f (1979) (mentioning neighbors’ fear of a leprosy sanatorium and contagion spread thereby, may give rise to a nuisance claim, notwithstanding that the possibility of contagion is highly remote); see also Nagle, supra note 32, at n. 154.
56. Tekle, supra note 33, at 1823-1825.
57. Nagle, supra note 32, at 295.
59. Ky. Rev. Stat. § 411.550(1)(g) (West 2016); Ky. Rev. Stat. § 411.550(1)(f) (West 2016) also requires consideration of “the respective situations of the defendant and claimant[.]” However, this factor may have applicability in other circumstances, such as where the defendant is a business entity, but it is inapplicable under the facts of the hypothetical being discussed herein. The fact scenario assumes that the defendant and claimant are neighbors in a relatively “high-end” neighborhood and thus are on a relatively equal economic footing.
60. Makowski, supra note 1, at 242.
61. See Donaway v. Rohm and Haas Co., Louisville Plant, No. 3:06CV-575-H, 2013 WL 3872228 (W.D. Ky. July 24, 2013) (granting defendant’s motion for summary judgment because plaintiff failed to meet her evidentiary burden by failing to provide a competent expert opinion that the
detail herein, several studies have shown significant diminution in the value of neighboring homes, particularly in higher-priced neighborhoods.  

**B. Is the Defendant’s Conduct Cognizable Under the Restatement’s Formulation of The Law of Private Nuisance?**

In the course of analyzing the elements required to establish the tort of nuisance according to the approach of the Restatement, while counsel is comfortable that her Mudd analysis will be sufficient to establish that her clients are proper plaintiffs, in the sense that they are fee holding possessors of land, and that they have suffered significant harm, she is concerned whether her client’s claims would be justiciable under the Restatement’s formulation of the tort in light of its formulation of the elements for liability in Section 822.

The Restatement (Second) provides that “[o]ne is subject to liability for a private nuisance if, but only if, his conduct is a legal cause of an invasion of another’s interest in the private use and enjoyment of land, and the invasion is either (a), intentional and unreasonable, or (b), unintentional and otherwise actionable under the rules controlling liability for negligent or reckless conduct, or for abnormally dangerous conditions or activities.”

1. With Respect to the Restatement of Torts Section 822, are the Convicted Sex Offender’s Acts with Respect to Harms Inflicted Upon Adjoining Property “Intentional and Unreasonable”?

The Restatement (Second) of Torts states that in order for defendant’s conduct to be “intentional and unreasonable” the defendant actor must act for the purpose of causing it, or know that it is resulting or is substantially certain to result from his conduct. Applying this standard to the facts of the instant case purported nuisance diminished the market value of plaintiff’s property); see also Apple Hill Farms Development, LLP v. Price, 816 N.W.2d 914 (Wi. Ct. App. 2012) (holding that a real estate agent’s opinion regarding reduction in property value was sufficient evidence to establish the same).

62. For instance, in neighborhoods where homes range in value, say, between $40,000 and $50,000, a diminution in the value of the property attributable to the presence of a nearby sex offender may be so minuscule as to make the instigation of a nuisance suit economically impracticable, or, alternatively, the character of the neighborhood is such, and the intrinsic value of the properties therein is such, that it is difficult, if not impossible, for an expert appraiser to ascertain a defensible diminution in value.

63. See, e.g., supra text accompanying notes 28-33.

64. See Palmore, supra note 4, at 11.

65. See Restatement (Second) of Torts § 822 (1979).

66. Restatement (Second) of Torts § 822 (1979).

67. Restatement (Second) of Torts § 825 (1979).
presents a distinct challenge. First, as with any case where it is necessary to prove the subjective intent of an adverse party, adducing the necessary proof will be virtually impossible unless it comes from the mouth of the defendant himself, or witnesses which are hostile to him. In the present case, the likelihood that the defendant’s household residents would come forth to “rat him out” is slim to none. Second, the comments to section 825 confirm the difficulty of adducing proof of intention because:

[i]t is the knowledge that the actor has at the time he acts, or fails to act, that determines whether the invasion resulting from his conduct is intentional or unintentional. It is not enough to make an invasion intentional that the actor realizes or should realize that his conduct involves a serious risk or likelihood of causing the invasion. He must either act for the purpose of causing it or know that it is resulting or is substantially certain to result from his conduct. 68

Counsel thus concludes that while this putative defendant’s conduct is clearly “unreasonable,” she realizes that it can hardly be said that the defendant either procured, produced viewed or distributed child pornography “for the purpose of causing” damage to adjoining property and property owners. 69 The only thing this defendant clearly intended to do was to gratify himself with child pornography, however perverted and unreasonable. If deposed, he will certainly say that he intended no one to be harmed by his actions, and absent contrary proof from persons who either viewed his activity or whom he told about his activity, establishing by preponderance of the evidence that the defendant acted for the purpose of causing the harm to neighbors appears to be a practical impossibility. 70

Similarly, establishing that the defendant was “substantially certain” that harm to neighbors would result from his child pornography-related conduct is equally problematic. As previously discussed, 71 the harm to the neighbors occurs when they become aware of his illegal conduct through notifications mandated by the various community notification statutes applicable in all

68. Restatement (Second) of Torts § 825 cmt. c (1979) (emphasis added).
69. Faced with the possible dual motives of self-gratification on the one hand, versus causing damage to neighboring properties on the other, one has to assume that the motive of self-gratification preponderates as there are conceivably numerous methods to damage a neighbor’s property which would not involve the self-destructive aspects of child pornography viewing!
70. One can only imagine the hostility and unwillingness of such witnesses to come forward, knowing that the first question on cross-examination is likely to be as follows: “so, you knew about this illegal, perverted activity on the part of the defendant and told no one?”
71. See Nagle, supra note 32, at 291-95.
jurisdictions. Obviously, if the defendant thought his actions would ever become public, such possible public disclosure should have served to deter him in the first place. Thus, to establish the “substantial certainty” criterion, one would first have to establish that he was “substantially certain” that his actions would become public, and “substantially certain” that his actions, with their resultant publicity, would have deleterious effects upon neighboring properties. The defendant will, of course, testify that he never believed his child pornography activities would become public, and while proof to the contrary may exist, identifying and adducing such proof through normal civil discovery processes would appear difficult at best. Accordingly, counsel concludes that if her cause of action is to be judicially cognizable under the Restatement, she will have to categorize the defendant’s actions under Section 822 (b), i.e., unintentional and otherwise actionable under the rules controlling liability for negligent or reckless conduct, or for abnormally dangerous conditions or activities.

2. With Respect to the Restatement of Torts Section 822, are the Convicted Sex Offender’s Acts Unintentional, or May Such Acts Constitute Abnormally Dangerous Conditions or Activities?

At the outset, the Restatement cautions that:

[reckless misconduct differs from intentional wrongdoing in a very important particular. While an act to be reckless must be intended by the actor, the actor does not intend to cause the harm that results from it. It is enough that he realizes or, from facts which he knows, should realize that there is a strong probability that harm may result, even though he hopes or even expects that his conduct will prove harmless.]

In her analysis of this requirement, counsel concludes that from the provable facts, she can adduce evidence from which the fact-finder could find, by preponderance thereof, that the convicted sex offender acted recklessly. First,

72. See supra notes 17-20.
73. Assuming that the putative defendant is a rational person, one can assume that he desired to prevent public disclosure of his child pornography viewing activities because he conducted them in private in his own home.
74. See supra notes 69-74 and accompanying text.
75. See supra note 70 and accompanying text.
76. RESTATEMENT (SECOND) OF TORTS § 822(b) (1979).
77. RESTATEMENT (SECOND) OF TORTS § 500 cmt. f (1979).
78. RESTATEMENT (SECOND) OF TORTS § 500 cmt. f (1979) (To emphasize, “[i]t is enough that he realizes or, from facts which he knows, should realize that there is a strong probability that harm may result, even though he hopes or even expects that his conduct will prove harmless.”).
his child pornography activities were surreptitious. Consequently, it can be inferred that he knew they were wrong; as such, he desired to keep such activity secret. Charged with knowledge of the criminality of such actions, he is also thus charged with knowledge that the state viewed his actions as sufficiently harmful and deleterious as to impose its highest penalty, criminality, upon such actions. Because the defendant could proffer a virtual dearth of proof to show that he did not realize, nor should have been able to realize, that a strong probability of harm would result, counsel feels confident that any such proof would not preponderate over plaintiff’s proof of recklessness. Moreover, such proof may be so weak as to cause the court to conclude that reasonable minds could not differ as to the issue of recklessness and thus direct a verdict for plaintiff on this issue.

3. With Respect to Restatement of Torts Section 824, did the Defendant’s Child Pornography-Related Conduct Constitute an “Act” Which Would Support a Claim for Private Nuisance?

Continuing with her analysis of whether the defendant-child pornographer’s conduct would support a claim for private nuisance under the Restatement, counsel encounters Section 824, which provides:

> [t]he conduct necessary to make the actor liable for either a public or a private nuisance may consist of (a) an act; or (b) a failure to act under circumstances in which the actor is under a duty to take positive action to prevent or abate the interference with the public interest or the invasion of the private interest.

While, at first blush, it seems axiomatic that the defendant’s child pornography activities would constitute an “act,” counsel revisits the nagging question that

79. See supra notes 69-74 and accompanying text.
80. See supra notes 69-74 and accompanying text.
82. Presumably, the defendant knew his activities were illegal; otherwise why conduct them in secret? Moreover, one can only imagine the reaction of rational factfinders to the defendant’s argument that in viewing child pornography, he did not realize, nor from the facts should not have been able to realize, that “harm” would occur. But for “harm” occurring, why criminalize his conduct at all?
83. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250-51 (1986) (“[T]he standard for issuance of a directed verdict under Fed. R. Civ. P. 50(a) . . . [i]f the trial judge must direct a verdict if, under the governing law, there can be but one reasonable conclusion as to the verdict. If reasonable minds could differ as to the import of the evidence, however, a verdict should not be directed.”) (citations omitted).
84. RESTATEMENT (SECOND) OF TORTS § 824 (1979).
has troubled her from the beginning. Namely, she cannot establish that the defendant acted with the intention of harming neighbors.\(^{85}\) He acted for the purpose of self-gratification, pure and simple.

Nevertheless, revisiting her earlier analysis of Section 824 because it may inform a claim under Kentucky law, she is comforted by the comments to that Section, which confirm that whether the defendant is acting on his own for whatever purpose, it is enough that his actions are the legal cause of the invasion.\(^{86}\) Accordingly, she concludes that Section 824 will pose no impediment to her making the case for private nuisance in a jurisdiction that adheres to the Restatement’s formulation of the tort.\(^{87}\)

4. Counsel’s Conclusions Concerning the Viability of Her Claim Under the Restatement’s Formulation of Private Nuisance

Having concluded that she will not be able to sustain her client’s claims by establishing that the defendant’s conduct was “intentional,” as that term is defined in the Restatement,\(^{88}\) she analyzes the Restatement’s remaining requirements for a private nuisance claim under the Restatement’s “unintentional and unreasonable” standard.\(^{89}\) Noting that the remaining Restatement elements for liability deal only with intentional invasions, counsel concludes that she must start adducing proof showing that while the defendant’s conduct was unintentional, it was unreasonable. Liability should be imposed upon the defendant because his actions have caused significant harms to “normal” neighbors whose use and enjoyment of their property has been harmed and whose property values have been thereby diminished.\(^{90}\)

However, counsel is mindful that her establishing a substantial and unreasonable interference with the use and enjoyment of her client’s property is only half the battle. She also must prove a diminution in the value of such property.\(^{91}\) What proof must she adduce? Are expert witnesses required to proffer such proof? How is diminution in value to be established?

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85. See supra text accompanying notes 68–71.
86. Restatement (Second) of Torts § 824 cmt. b (1979).
87. See supra text accompanying notes 85–87.
88. See supra text accompanying notes 69–74.
89. Restatement (Second) of Torts §§ 825–831 (1979).
90. See id. §§ 821F, 822(b).
91. See supra text accompanying notes 1–12.
C. Are Plaintiff’s Fears of Diminished Property Values Attributable to the Proximity of a Convicted Child Sex Offender “Real”?

1. Perception or Statistically Provable Reality?

It is one thing to fear the actions of a convicted child predator nearby. It is quite another to then make the leap to claim, and be able to prove, that one’s property has been diminished in value thereby. Counsel seeks to determine whether there is any anecdotal evidence of diminution in property value, or better yet, statistical evidence thereof. Conducting some web-based research, she finds a blog-post by a homeowner who voices complaints virtually identical to her clients.

The homeowner, having actually experienced attempting to sell his own home, writes as follows:

As a homeowner trying to sell my home with a registered sex offender right next door, I can say this is financially devastating. I live in an area with excellent schools and my home is geared for beginning families, 3 bedrooms, expensive play system in yard, etc. Already, we have lost 3 sales in 3 months in an area where most homes sell within 2 weeks. Unfortunately, we purchased a new home and moved in anticipation of selling our old home quickly only to find that our neighbor’s son is a registered offender. He is 27 and has always lived at home and isn’t going anywhere. We even asked them to have him move temporarily and they refused. We are now faced with a 250,000 home that is essentially worthless which is financially devastating to us. I understand the idea behind the register for sex offenders but at what cost to innocent neighbors? We are honest, law abiding citizens who are being unfairly punished for another person’s crime.

Thus, “[a]necdotal evidence suggests that individuals are extremely averse to living in close proximity to convicted criminals and that they have put the information obtained from the offender registries to use.”

92. See supra text accompanying notes 23-24.
93. Jonathan J. Miller, Reader’s Angst About Sex Offenders, NAR Stats Delayed Closing Dates, MILLER SAMUEL, INC. (July 17, 2006), www.millersamuel.com/?s=sex& type%5B%=post.
94. Leigh L. Linden & Jonah Rockoff, There Goes the Neighborhood? Estimates of the Impact of Crime Risk on Property Value from Megan’s Law, NATIONAL BUREAU OF ECONOMIC RESEARCH, WORKING PAPER 12253, NBER WORKING PAPER SERIES 3 (May 2006), http://www.nber.org/papers/w12253.pdf [hereinafter, “Linden & Rockoff”]. (For instance, in 2002, Wisconsin required sellers to disclose whether a sex offender lived nearby, only if asked. New Jersey, however, allows lower-risk offenders to be disclosed only after the closing and conveyance of title of the subject property.); see also Susan Yeh, Revealing the Rapist Next Door: Property Impacts of a Sex Offender Registry,
Counsel’s search of the available literature discloses that in certain cases, neighbors have risen up and “encouraged” convicted sex offenders in their neighborhood to relocate. The notion that a convicted sex offender nearby may pose a cloud on a neighbor’s property is reflected in reports of sellers questioning whether they must disclose the convicted sex offender’s proximity to potential buyers. Additionally, “a small but growing number of state and local governments have passed laws that would prevent sex offenders from living almost anywhere within their borders.” Are these homeowners’ concerns, like those of counsel’s client, borne out by any statistical evidence?

2. The Statistics

In 2003, several professors at Wright State University in Dayton, Ohio published their findings concerning the effects of sex offender proximity to housing values. Following Congress’s passing of Megan’s Law in 1996, and states enacting its counterparts, the Wright State professors examined single-family house transactions that occurred during 2000 in Montgomery County, Ohio to determine the effect on the selling price of such properties, given their proximity to registered sex offenders’ residences. The authors, recognizing that presence of an offender may motivate owners to accept a low offer to consummate a speedy sale, adapted their model to capture that effect. The results of their findings are stunning: Houses located within 0.1 mile of an offender sold for 17.4% less, on average, than similar houses located farther.

44 Int’l Rev. L. & Econ. 42, 60 n. 9 (2015) [hereinafter, “Yeh”] (“For example, in 2002, Wisconsin required sellers to disclose whether a sex offender lives nearby if asked. Meanwhile, New Jersey allows disclosure of lower-risk offenders only after a deal has been closed.”).

95. Linden & Rockoff, supra note 94, at 3 (citing Randal Bell, The Impact of Megan’s Law on Real Estate Values, VALUATION INSIGHTS & PERSPECTIVE, 39-42 (1998)).


99. Id.

100. Id. The authors note, “[i]n order to estimate the actual selling price effect of proximity to an offender, both price and marketing time should be investigated because, from the seller’s perspective, extra time on the market lowers the present value of the selling price. Unfortunately, the transaction set used in this study does not include reliable ‘time on the market’ information. Because marketing time is not included in the model used in this study, the selling price effect discovered may understate the effective selling price effect.” (emphasis added).
away. For less dangerous offenders, the significant effect extends to 0.2 mile from the offender’s residence, and the effect is smaller.” 101 Their study reaches the sobering conclusion “that a monetary burden must be borne by house sellers in close proximity to a registered sex offender’s residence.” 102 Their findings have been cited without criticism, even among authors in the sex offender apologists’ community. 103

The 2003 findings of the Wright State professors were confirmed in 2006. 104 The authors of the 2006 study, Linden and Rockoff, combined data from the housing market in Mecklenburg County, North Carolina (Charlotte area), with data from the North Carolina Sex Offender Registry. They estimated how individuals value living in close proximity to a convicted sex offender. 105 The authors concluded that the value of houses within a one-tenth mile around a sex offender’s home fall by 4 percent on average (about $5,500) but that houses next to an offender sell for about 12 percent less. 106 However, when using the Wright State researchers’ methodology, Linden and Rockoff concluded that those living in closest proximity to a convicted sex offender could expect diminutions in value of up to 19%! 107 Buttressing the Wright State finding that the presence of sex offenders poses a monetary burden on nearby house sellers, 108 Linden and Rockoff aggregated those effects across all homes affected and all offenders, finding that the presence of sex offenders depresses property values throughout Mecklenburg County by about $60,000,000. 109

Most recently, one study sought to evaluate how prospective homebuyers are likely to respond to perceived crime risks about sex offenders in the neighborhood. 110 Unlike the prior studies, the author sought to evaluate the effect of the duration of the sex offender’s stay in his community after

101. Id.
102. Id. (To add insult to injury, the convicted sex offender’s property is likely the only property in the neighborhood to NOT suffer a diminution in value because his is the only property unburdened by the presence of a convicted sex offender!)
104. See generally Linden & Rockoff, supra note 94.
105. Id. Linden & Rockoff used the exact location of sex offenders to exploit variation in the threat of crime within small homogeneous groupings of homes, and used the timing of the sex offenders’ arrivals to control for baseline property values in the area.
106. Id. at 3-4.
107. Id. at 2.
108. See supra text accompanying notes 98-103.
110. See generally Yeh, supra note 94.
conviction, as it may relate to the perception of prospective buyers. The author, Professor Susan Yeh, concluded that:

the majority of registered offenders are relatively transient. The median duration of addresses listed in the registry was only 0.45 years. In general, sex offenders tend to live into worse neighborhoods with higher poverty levels and lower property values... I find that homebuyers do not respond to the majority of offender locations announced in the registry. Over the years in the data, transient addresses are more likely to be observed in richer neighborhoods, while more stable addresses are more likely in poorer neighborhoods.

Analyzing this finding, counsel for plaintiff has perhaps found the answer to the question, which has been nagging her from the beginning: why are there no reported cases raising a private nuisance claim against an adjacent sex offender? If most sex offenders are indeed transient and more likely to be found in poorer neighborhoods, it stands to reason that the diminution of property values in an economically depressed neighborhood may be so minuscule as to render incalculable the actual diminution in value caused by the presence of a sex offender.

In addition, even if a competent appraiser could establish a diminution in value, the litigation costs associated with obtaining a damage award for a small sum might well swamp the monetary value of any recovery obtained. It thus stands to reason that hers may be a case of first impression. However, in the case she is pursuing for her clients, assuming their home is worth approximately $450,000, the diminution in value could be anywhere between 4% and 20%, i.e., $18,000 to $90,000. The convicted sex offender against whom her clients are seeking recovery has means, is reasonably well-to-do, has a stable home life and has now resided in the neighborhood in his half-million-dollar home for six years—three years before his offense and subsequent listing on the sex offender registry, and three years thereafter. Thus, Professor Yeh’s conclusions demonstrate the validity of the concerns of counsel’s clients. Professor Yeh’s analysis, along with data from the 2003 and 2006 studies, is encouraging.

111. Id.
112. Yeh, supra note 94, at 43 (internal citations omitted) (emphasis added).
113. For example, if all homes in an economically depressed area sell between $15,000 — $25,000 of each other, the sales price differences might be ascribed to the condition of the properties themselves, the general vitality of the real estate market in the area, or a myriad of other factors unrelated to a convicted sex offender’s presence.
114. If, for instance, a plaintiff could establish that he suffered a 20% diminution in his property’s value, which was $50,000, litigation costs and attorney fees would likely consume the likely recovery of $10,000.
115. See supra text accompanying notes 98-103.
assuming that counsel can adduce the testimony necessary to support such conclusions.\textsuperscript{116}

However, as Linden and Rockoff point out, all of the studies fall short in one important facet: “like all such studies, we only can observe prices for houses that sell.”\textsuperscript{117} Nevertheless, a competent expert appraiser’s opinion on the \textit{likely} diminution in the value of homes adjacent to a convicted sex offender should be able to withstand a \textit{Daubert} challenge.\textsuperscript{118} But the appraiser must employ an accepted methodology, and his conclusions must be rationally based upon the information logically deduced from the application of that methodology.\textsuperscript{119} Thus, what is the appropriate methodology such appraiser needs to employ?

“It is intuitive that larger discounts would be associated with the proximity of a house to a more dangerous offender compared to [the] proximity to a less dangerous offender.”\textsuperscript{120} However, at least one study asserts that the type of community notification system employed in the locality where the offender resides influences this intuitive conclusion.\textsuperscript{121} The more passive the notification system, the lesser is the impact on adjoining properties.\textsuperscript{122} Conversely, the more active the notification system, the greater is the effect on adjoining properties.\textsuperscript{123}

Kentucky’s community notification system is “active” in the sense that public access to sex offender registries and community sex offender blogs makes notification of one’s sex offender status almost instantaneous.\textsuperscript{124} Therefore, it is imperative that a prospective appraiser take cognizance of

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\textsuperscript{116} See supra notes 98,103.
\textsuperscript{117} Linden & Rockoff, supra note 94, at 14.
\textsuperscript{118} See generally Daubert v. Merrell Dow Pharm., Inc., 509 U.S. 579 (1993) (establishing a four-part test to determine the reliability of expert testimony. Such factors include ascertaining whether the theory or technique in question (1) is scientifically valid and can properly be applied to the facts at issue; (2) can be (or has been) tested; (3) has been subjected to peer-review and publication; and (4) has attracted wide-spread acceptance within a relevant scientific community. In the case of a particular scientific technique, a court should also consider the theory or technique’s known or potential error rate. The Court emphasized that the inquiry is a flexible one, with the focus being upon principles and methodology, not conclusions generated.) Id. at 593-97.

\textsuperscript{119} See id. at 593-97.
\textsuperscript{120} Larsen et al., supra note 98
\textsuperscript{121} Id.

\textsuperscript{122} Id.
\textsuperscript{123} Id.

\textsuperscript{124} KY. REV. STAT. ANN. § 17.510 West 2016); see supra text accompanying notes 16-23.
Kentucky’s notification system when attempting to deduce an appraised value for a home adjacent to a convicted sex offender.125

So, how does a competent appraiser assess the “price effect” of a convicted sex offender’s presence in the neighborhood? In valuing a single-family house, many appraisers place heavy reliance on the sales comparison approach.126 Appraisal experts counsel that:

[t]his practice can be maintained if the price effect due to offender proximity is identical for the subject property and each comparable property. If this is not the case, appraisers must modify their methodology to accurately estimate value using the sales comparison approach. The potential effect of proximity to an offender must be calculated for the subject property, as well as the effect included in the transaction price for each comparable. Then, each comparable sale price should be adjusted to account for the difference in offender price effects between the subject and the comparable.127

D. Counsel’s Summary Conclusions with Respect to the Substantive Law of Nuisance

Thus, her client’s private nuisance claim attributable to a convicted child sex offender’s presence is a case of first impression in Kentucky, and perhaps nationally. But counsel is convinced that the venerable tort of nuisance is still viable and flexible enough to withstand a motion for summary judgment, or a motion for directed verdict, enabling counsel to have her case adjudicated by a finder of fact.128

First, using the relatively simplistic Mudd analysis, counsel is quite comfortable that she can establish the unreasonableness of the defendant’s use

125. See supra notes 121-125 and accompanying text.
126. See Larsen, supra note 98. As should be obvious to the reader now, lay opinion testimony concerning diminution in the value of the property at issue is meaningless. Plaintiff must provide a competent expert opinion that the purported nuisance reduces the market value of plaintiff’s property. See, e.g., Donaway v. Rohm and Haas Co., Louisville Plant, No. 3:06CV-575-H, 2013 WL 3872228, at *3 (W.D. Ky. July 24, 2013).
127. See Larsen, supra note 98.
128. See Steelvest v. Scansteel, 807 S.W.2d 476, 483 (Ky. 1991) (ruling that summary judgment is improper unless it would be “impossible for the respondent to produce evidence at trial warranting a judgment in his favor and against the movant.”); see also id. at 482-83 (“[T]rial judges are to refrain from weighing evidence at the summary judgment stage; that they are to review the record after discovery has been completed to determine whether the trier of fact could find a verdict for the non-moving party.”). As to the standard for the issuance of a directed verdict, see supra note 83.
of his property, as well as the gravity of the harm to her clients, by a preponderance of the evidence.\textsuperscript{129}

Second, using the Restatement’s formulation of the tort, counsel is satisfied that she can adduce proof sufficient to satisfy the “preponderance of the evidence” test.\textsuperscript{130} First, the defendant committed an act that, while unintentional with respect to harms to plaintiffs’ properties, was nevertheless one that he realized, or from the facts should have realized.\textsuperscript{131} Second, there was a strong probability that harm would result, even though he hoped his conduct would prove harmless.\textsuperscript{132} Finally, the act was clearly reckless and was the indirect cause of the invasion plaintiffs have suffered.\textsuperscript{133}

Counsel concludes that an expert appraiser, armed with the statistical support for a substantial diminution in the value of her client’s property,\textsuperscript{134} and using a methodology that is both logical and capable of being replicated, will be able to withstand a Daubert challenge.\textsuperscript{135} Accordingly, the fact-finder can use the appraiser’s testimony to determine a proper measure of damages.\textsuperscript{136}

As a consequence, counsel concludes that the facts of the instant case are sufficiently provable to establish the commission of the tort of nuisance under either Kentucky’s simplistic approach (\textit{Mudd}, as incorporated into Kentucky’s codification of the law of nuisance),\textsuperscript{137} or the Restatement’s more formulaic approach.\textsuperscript{138} Satisfied that the case can “make” under the substantive law, counsel moves on to her analysis of the remedy she should seek from the court.

\textsuperscript{129} See also, Donaway v. Rohm and Haas Co., Louisville Plant, No. 3:06CV-575-H, 2013 WL 3872228, at *1-2 (W.D. Ky. July 24, 2013) (confirming the analysis employed in \textit{Mudd}, 339 S.W.2d 181 (Ky. 1960)).
\textsuperscript{130} See id.
\textsuperscript{131} Restatement (Second) of Torts § 824(a) (1979).
\textsuperscript{132} Id. § 825.
\textsuperscript{133} Id. § 822 cmt. b.
\textsuperscript{134} See supra text accompanying notes 98-109.
\textsuperscript{135} See supra text accompanying notes 119-120 (discussing Daubert v. Merrell Dow Pharm., Inc., 509 U.S. 579 (1993) and the four-part test for valid expert testimony).
\textsuperscript{136} See supra text accompanying notes 119-120.
\textsuperscript{137} See supra text accompanying notes 4-7.
V. THE REMEDY

Mindful that the Kentucky courts have adopted the Restatement factors to determine the existence, *vel non,* of a nuisance tort, counsel notes that Kentucky’s codification of its common law of nuisance seems entirely devoted to establishing the remedy of damages, mentioning the remedy of injunctive relief but once. But counsel notes that the “savings clause” attendant to Kentucky’s codification of nuisance law, Ky. Rev. Stat. § 411.570, provides that the damage remedy detailed in the codification is not to be construed to repeal any statutes or common law relating to nuisance. Rather, it is to be construed as ancillary and supplementary to any other rights or remedies available for personal or property damage. Counsel is fully cognizant that the remedy her clients want is for the convicted sex offender to move out of the neighborhood. The only remedy that would *directly* force this outcome is an injunction. She explores the law of injunctions to determine whether this remedy is realistically attainable.

A. Is An Injunction Realistically Attainable?

Looking to the Restatement of Torts (Second) for guidance, counsel determines that:

> [t]he ALI’s approach to the law of nuisance as set forth in the *Restatement (Second) of Torts* may be summarized as follows: (1) a non-trespassory invasion that causes substantial damages will result in nuisance liability if it is ‘intentional and unreasonable’; (2) conduct is ‘unreasonable’ if ‘the gravity of the harm outweighs the utility of the actor’s conduct’; (3) conduct is also ‘unreasonable’ if ‘the harm resulting from the invasion is severe and greater than the other should be required to bear without compensation,’ but only if ‘the financial burden of compensating for this and similar harm to others would not make the continuation of the conduct not feasible.’

Using this approach,

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141. Id.
142. The defendant relocating would immediately solve all of the attorney’s client’s concerns.
143. Only after the issuance of an injunction would the Court issue an order directing the defendant to move.
144. Lewin, supra note 6, at 784 (citations omitted). The issue of whether the financial burden of compensating for the injuries the defendant has caused would make the continuation of his conduct “not feasible,” is inapplicable here, because the state has already determined conduct giving rise to his conviction and subsequent listing on the sex offender registry is illegal.
a court will issue an injunction if the harms imposed by the nuisance on the plaintiff and others in the community outweigh the costs an injunction would impose on the defendant and others in the community; if this balance weighs against the plaintiff, he will at least be entitled to damages in compensation for severe harms.145

As it relates to the appropriateness of the remedy, the issue of the defendant’s “conduct” again becomes problematic. The conduct that resulted in his conviction, which further resulted in his being listed on the sex offender registry, has presumably ended.146

Thus, the only “conduct” presently engaged in by the defendant is his occupancy of his residence. Would a court require one who, having been convicted and punished, and who presumably has paid, or is paying his debt to society, relocate? A court would likely view this remedy distastefully because the imposition of this remedy in a neighborhood with high property values will simply mean that persons of lesser means, and perhaps lesser access to the courts, will be afflicted by the same harm presently being remedied.147 It’s hard to conceive that any court would relish taking a rich person’s problem and making it a poor person’s burden.

Moreover, it is axiomatic that an injunction, an equitable—and thereby extraordinary—remedy, has traditionally been reserved for those cases requiring immediate judicial intervention to prevent harms that cannot be fully compensated by money damages.148 While counsel is comfortable that the Kentucky Rules of Civil Procedure permit the issuance of injunctions directing the defendant to undertake an act (such as moving),149 she is mindful that venerable Kentucky law holds that:

[i]njunctive relief, in common with most other equitable weapons, though perhaps to a greater degree, has great potency for harm when

145. Lewin, supra note 6, at 785.
146. Because the convicted sex offender’s child pornography viewing activities and his computer-use are electronically monitored, it is safe to assume that he has ceased such activity, lest his incarceration ensue.
147. Assuming that the value of the plaintiff’s property is relatively small, the “diminution in value” award is likely to be similarly paltry. As such, the plaintiff might have difficulty locating a lawyer who is willing to take such a case on a contingency basis, and that potential plaintiff might be without the means to pay the lawyer on an hourly basis.
148. Geveden v. Commonwealth ex rel. Fletcher, 142 S.W.3d 170, 171-72 (Ky. Ct. App. 2004) (citing Maupin v. Stansbury, 575 S.W.2d 695 (Ky. Ct. App. 1978)) (“an injunction is an extraordinary remedy not to be granted unless the movant establishes both that without it, he is likely to suffer the immediate and irreparable abrogation of a concrete personal right and that grant of the injunction will not unduly prejudice either the public or the non-movant.”).
149. Ky. R. Civ. Proc. 65.01 (“[a]n injunction may restrict or mandatorily direct the doing of an act.”).
misapplied, and for this reason courts consider every application for its employment in the light of its consequences to both parties, and, to that end, [courts] consider the “balance of inconvenience,” frequently withholding the granting of an injunction when the benefit to the plaintiff will be small in comparison to the injury to the defendant.\(^{150}\)

Additionally, counsel is mindful that for a court to adjudicate the defendant’s conduct as a nuisance, it must be adjudicated solely on the basis of whether his conduct has inflicted \textit{damage to property}. A court must adjudicate any claims for annoyance, inconvenience, mental distress, or other provable personal injuries as any other tort case resting upon theories of negligence, strict liability for ultra-hazardous activities, etc.\(^{151}\)

However, counsel is cognizant that the reason her clients desire for an injunction is not to prevent further damage to the value of their real estate caused by the sex offender’s duration of the residence in the neighborhood. Rather, clients seek injunctive relief to enjoy their property on a daily basis without the fear and angst attributable to the presence of a sex offender in the neighborhood.\(^{152}\) In order to establish her client’s entitlement to an injunction to prevent these harms, she is concerned that her client’s testimony alone may be insufficient to establish what are essentially personal injuries, personal

\footnotesize{\begin{itemize}
\item \textit{Bartman v. Shobe, 353 S.W. 2d 550, 554 (Ky. 1962)} (quoting \textit{2 Fred F. Lawrence, A Treatise on the Substantive Law of Equity Jurisprudence} § 1096 at 1179 (Albany: Matthew Bender & Co., 1929)).
\item \textit{See Palmore, supra note 4, at 6} (quoting S. Ry. Co. v. Routh, 170 S.W. 520 (Ky. 1914)). The \textit{Routh} court held:

\begin{quote}
[w]hen it comes to measuring damages, the diminution in the value of the use of the property necessarily includes annoyance and discomfort, which directly affect the value of the use. It is not, therefore, proper to permit a recovery both for the diminution in the value of the use and for annoyance and discomfort, which necessarily enter into and constitute a part of the diminution of such value.
\end{quote}

Consequently, \textit{Ky. Rev. Stat.} § 411.560(3) (2006), included within Kentucky’s statutory codification of the law of Nuisance, prohibits any award “for annoyance, discomfort, sickness, emotional distress or similar claims.”
\item \textit{See text accompanying note 105, supra}. While it is conceivable that a sex offender’s lengthy presence in a neighborhood may cause adjacent properties to decline in value simply because of the extended duration of his residence in the neighborhood, realistically, the “hit” property values may take is going to occur immediately upon the offender being listed on the sex offender registry. Moreover, trying to segregate the element of damages attributable to his initial listing on the registry from those elements of damages attributable to his extended stay in the neighborhood may be so problematic as to be speculative, and thus excluded from evidence pursuant to a timely \textit{Daubert} motion.
\end{itemize}
injuries that are serious, immediate, and sufficiently ongoing to warrant the extraordinary remedy of injunction.\textsuperscript{153}

Thus, counsel concludes that because the defendant’s acts for which he was convicted are likely not ongoing, she must look to remedies beyond an injunction.\textsuperscript{154} While the injunction would immediately remedy her client’s “fear and distress” issues, Kentucky law makes clear that any nuisance case seeking either injunction or damages to prevent a reoccurrence of such “fear and distress issues” must proceed independently of their nuisance claim.\textsuperscript{155} Thus, an injunction forcing the defendant to move, standing alone, will be insufficient to remedy any existing monetary damage her clients have suffered from the date of the offender’s listing on the sex offender registry to the time of trial.\textsuperscript{156} Therefore, at the very least, an injunctive remedy would need to be coupled with a damage remedy.\textsuperscript{157} Moreover, even if counsel miraculously clears all hurdles and at first blush appears entitled to an injunction, “[b]ecause the courts have never addressed this type of nuisance claim, it is unknown how they would rule. However, public policy considerations may also affect their decision.”\textsuperscript{158}

Enjoining sex offenders from residing in certain neighborhoods raises constitutional questions\textsuperscript{159} as well as policy issues concerning where to properly locate such displaced persons, including whether all sex offenders should be lumped together irrespective of the nature of their crimes.\textsuperscript{160} Counsel therefore reasons that her chances of convincing a court to enjoin the convicted sex offender from living in the neighborhood are at best questionable and even if granted, would provide an incomplete remedy for “loss of value of use” damage that has already occurred. Thus, if the case is to proceed with the desired

\textsuperscript{153} While not bursting with vitality, Kentucky law nevertheless holds “a discomfort which is purely mental, unaccompanied by anything else, may not be alleviated by injunctive relief.” Dulaney v. Fitzgerald, 13 S.W.2d 767 (Ky. 1929) (citing Pearson & Son v. Bonnie, 272 S.W.375 (Ky. 1925)).

\textsuperscript{154} See supra text accompanying note 143.

\textsuperscript{155} See, Palmore, supra note 4, at 5 (citing KY. REV. STAT. § 411.560 (3)).

\textsuperscript{156} See Palmore, supra note 4, at 4 (citing KY. REV. STAT. § 411.560(1)(a)). Clearly, plaintiffs have suffered diminution in the value of the use of their property during the period of time of the sex offender’s occupancy of his residence in the neighborhood since the date of his listing on the sex offender registry.

\textsuperscript{157} See Palmore, supra note 4, at 4 (citing KY. REV. STAT. § 411.560(1)(a)).

\textsuperscript{158} Hartzell-Baird, supra note 31, at 390.

\textsuperscript{159} Id. The author references Michael J. Duster, Out Of Sight, Out Of Mind: State Attempts to Banish Sex Offenders, 53 DRAKE L. REV. 71 (2005) (discussing current constitutional issues surrounding sex offender laws); see also Nagle, supra note 32 (noting that nuisance law may not prohibit that which the Constitution protects).

\textsuperscript{160} Hartzell-Baird, supra note 31, at 390.
remedy, at least in part, being damages, what is the proper measure of damages in such case?

B. To Determine the Proper Measure of Damages: Is the Nuisance From Which Plaintiffs Seek Relief Temporary or Permanent?

The resolution of this issue is critical to the determination of the proper measure of damages as Kentucky law mandates different measures dependent upon whether the classification of the alleged nuisance is temporary or permanent.\textsuperscript{161} In Kentucky, “[t]he allowable damages in a private nuisance suit are (1) for a permanent nuisance, the resulting loss in market value of the claimant’s property, and (2) for a temporary nuisance, the resulting diminution in the value of the use of the claimant’s property if it was occupied by the claimant or, if it was not so occupied, the resulting diminution in its fair rental value during the time the nuisance existed within the period of limitations.”\textsuperscript{162}

Kentucky Law’s distinction between temporary nuisances and permanent nuisances, while seemingly simple in definitional terms, poses a distinct challenge in the context of the present case. Kentucky’s nuisance codification statute defines as permanent “any private nuisance that: (a) [c]annot be corrected or abated at reasonable expense to the owner; and (b) [i]s relatively enduring and not likely to be abated voluntarily or by court order.”\textsuperscript{163} For definitional simplicity, “[a]ny private nuisance that is not a permanent nuisance shall be a temporary nuisance.”\textsuperscript{164} However, to aid in the interpretation of the temporary nuisance definition, Kentucky law goes on to provide that:

[a] temporary nuisance shall exist if and only if a defendant’s use of property causes unreasonable and substantial annoyance to the occupants of the claimant’s property or unreasonably interferes with the use and enjoyment of such property, and thereby causes the value of use or the rental value of the claimant’s property to be reduced.\textsuperscript{165}

\textsuperscript{161} KY. REV. STAT. ANN. § 411.560 (West 2016).

\textsuperscript{162} Palmore, supra note 4, at 4-5 (citing Ky. REV. STAT. § 411.560 (2006)) (“The measure of recoverable property damage thus set forth in KRS 411.560 accurately reflects long and well established case law as reflected by the opinions of Kentucky’s highest court.”).

\textsuperscript{163} KY. REV. STAT. ANN. § 411.530(1) (West 2016).

\textsuperscript{164} KY. REV. STAT. ANN. § 411.540(1) (West 2016).

\textsuperscript{165} KY. REV. STAT. ANN. § 411.540(2) (West 2016).
Thus, simply stated, Kentucky law provides for the remedy of money damages based upon diminution in market value for a permanent nuisance; and, diminution in the value of use or rental value (depending upon occupancy) for any nuisance that is not permanent. 166

1. Measuring and Proving Temporary Nuisance Damages

While counsel is comfortable that she can establish a diminution in the market value of clients’ properties, Kentucky law makes clear that this measure of damages is applicable if, and only if, the nuisance is determined to be “permanent.” 167 However, as this is a question of fact for the finder of fact, she realizes that she must adduce sufficient proof to justify award of damages measured by loss of value of use or rental value, in the event that the nuisance is determined to be “temporary.” 168

Analyzing her client’s claim under the “temporary nuisance” damages rubric, counsel is comfortable that she can establish that the defendant’s use of his property causes unreasonable and substantial annoyance to her clients as well as interfering with their use and enjoyment thereof. 169 Recognizing that “[t]emporary injury to real property may produce several different measures of damage,” counsel confronts this conundrum: is “loss of value of use” to be established by determining the rental value of the property lost during the continuation of the nuisance? 170 Or, is “loss of value of use” to be proven by resort to criteria less objective than rental value? 171

With respect to “loss of value of use,” Kentucky law makes it clear that any nuisance case seeking either injunction or damages to prevent a reoccurrence of such “fear and distress issues” must proceed independently of their nuisance claim. 172 Nevertheless, from her client’s standpoint, it is precisely the “fear and distress issues,” and their resultant effects upon the property owners, and their friends and families, that has caused the value of the use of their properties to

166. Id.
167. KY. REV. STAT. ANN. § 411.530(1) (West 2016).
169. Merrick, 5 F. Supp. 3d at 878.
170. RONALD W. EADES, KENTUCKY LAW OF DAMAGES § 33:3 REAL PROPERTY: USUAL MEASURE OF DAMAGES (Thomson-Reuters 2016).
171. Id.
172. See KY. REV. STAT. ANN. § 411.560(3) (West 2016).
be diminished.\textsuperscript{173} So, of what relevance, if any, is evidence of plaintiffs’ “fear and distress issues” to plaintiffs’ claim for damages for temporary nuisance?\textsuperscript{174}

In \textit{Kentland-Elkhorn Coal Co. v. Charles} the Kentucky court touched upon this subject, stating as follows:

\begin{quote}
The instructions should not authorize any recovery for personal annoyance, discomfort or sickness of the plaintiffs, because there was no claim of damages for personal injury. On a nuisance suit, such as this, \textit{while evidence of those elements is admissible as affecting the value of the use of the property, they are necessarily included in the damages for diminution in the value of the use and are not distinct elements of damage.}\textsuperscript{175}
\end{quote}

Counsel concludes that the net effect of this holding is that her clients may offer testimony about their “fear and distress issues,” but that the finder of fact is precluded from awarding damages therefore. As to the issue of valuing a loss of use of residential property, counsel notes that the U. S. District Court for the Western District of Kentucky, construing Kentucky law, formulated a logical and relatively simplistic method for valuing loss of use.\textsuperscript{176} In \textit{Brockman v. Barton Brands, Ltd.} the U.S. District Court for the Western District of Kentucky, construing Kentucky law, reasoned that:

\begin{quote}

Kentucky law requires that damages in a nuisance case be measured by a material reduction in fair market value or rental value. KRS § 411.560(1). Plaintiff must introduce a “tangible figure from which the value of the use can be deduced,” otherwise the valuation is pure speculation. (citation omitted). \textit{The likely purpose of this requirement is to impose an objective criteria upon an otherwise rather subjective tort.}\textsuperscript{177}
\end{quote}

\begin{footnotes}
\item[173] Id.
\item[174] To say that Kentucky law on this point is not a paragon of clarity is to wax with hyperbolic understatement!
\item[175] Kentland-Elkhorn Coal Co. v. Charles, 514 S.W.2d. 659, 664 (Ky. 1974) (emphasis added).
\item[176] For an example of a more convoluted mechanism for valuing “loss of use” damages, see note 179, infra.

\begin{quote}
Where the nuisance is temporary, damages to property affected by the nuisance are recurrent and may be recovered from time to time until the nuisance is abated. \textit{The measure of such damages [is] the injury to the value of the use and enjoyment of the property, which may be measured to a large extent by the rental value of the property, and extent that rental value is diminished.” This measure of damages is applicable during the time the nuisance exists.}
\end{quote}
\end{footnotes}
While loss of rental value can presumably be established by expert testimony, establishing loss of value of use by less objective criteria can be problematic.

Accordingly, counsel concludes that if the nuisance is to be categorized as temporary, she must persuade the Kentucky court to resort to the more objective and easily proved measure of damages for loss of use utilized by the U.S District Court in Brockman, namely, loss of rental value. Concluding that the damage calculation for loss of use/rental value would likely generate a smaller damage award than would a calculation based upon diminution in market value, counsel returns to the issue of whether the nuisance is temporary, or, alternatively, permanent?

2. Can a Nuisance Caused by a Convicted Sex Offender’s Continued


178. See supra text accompanying notes 100-111.

179. The problem of utilizing such less objective criteria is illustrated and explained by the Supreme Court of Connecticut in Johnson v. Flammia, 363 A.2d 1048 (Conn. 1975). In Johnson, the plaintiffs contracted with the defendant to install a swimming pool on their property. After the pool was installed, it buckled due to excessively wet and plaintiffs alleged that the defendant breached and negligently performed the contract. The jury’s award in the plaintiffs’ favor included damages for the plaintiffs’ loss of use and enjoyment of their swimming pool. Nevertheless, the reviewing court held that the plaintiffs failed to prove the nature and extent of their loss of use and enjoyment of the pool. In so holding, the Court stated as follows:

The defendants are liable for such damages as the plaintiffs sustained as a result of their loss of use of the pool and an essential element of the plaintiffs’ burden of proof is the value of the use of the pool . . . [t]he plaintiffs had the burden of proving the nature and extent of the loss of use.

Id. at 1054.

The Court went on to note that the plaintiffs did not present any evidence that would have allowed the jury: “(1) to approximate the number of days that the pool was unusable, (2) to approximate the extent of the actual or intended use made of the pool by the plaintiffs and their children when the pool was usable and (3) to establish a daily value use of the pool.” Id. For this reason, the court set aside the award of damages attributable to loss of use of the pool. Utilizing the Johnson formulation to analyze the type of proof her clients would need to adduce to establish their entitlement damages in the present case, how does one approximate the number of days the client’s property was “unusable” due to the presence of the convicted sex offender? Realistically, her clients have suffered harm every day since his presence in the neighborhood was discovered. Is it fair to limit plaintiffs’ damages to those days when family and friends were invited and declined to visit out of fear of the convicted sex offender? Clearly, the facts of the present case do not lend themselves to proving these seemingly abstract and ephemeral elements.


181. For example, counsel concludes that her client’s home, valued at $450,000, could easily be rented for $2000 a month. By the time of trial, the convicted sex offender will have been living in the neighborhood for 40 months, thus resulting in a diminution in rental value of $80,000. On the other hand, counsel believes that a competent real estate appraiser, utilizing the methodology described herein, would result in a diminution in sale market value of nearly 20%, i.e. $130,000 in damages. In addition, this is of paramount importance to counsel if she is to be compensated pursuant to a contingency fee contract!
Residence in the Neighborhood Ever Be Said to Be Temporary?

Recognizing that Kentucky nuisance law statutorily defines a “temporary nuisance” as any nuisance that is not a “permanent nuisance” she analyzes the facts and the law to determine whether she can make the case that the nuisance of which her clients complain is permanent.\textsuperscript{182} To do so, she must establish two elements: first, she must establish that the nuisance “cannot be corrected or abated at reasonable expense to the owner.”\textsuperscript{183} Second, she must establish that such nuisance is relatively enduring and not likely to be abated voluntarily or by court order.\textsuperscript{184}

Turning to the first element, while clearly this nuisance can be “corrected or abated” by the defendant moving out of the neighborhood, query whether such can be accomplished “at a reasonable expense to owner.”\textsuperscript{185} The defendant’s residence, like plaintiffs, is “high-end,” in good condition and is presumably marketable. In the event the defendant has sufficient equity in his residence to at least cover the down payment on a substitute residence, it can hardly be said that the cost of moving and procuring a substitute residence would be unreasonable. Under such circumstances, except for moving expense, it is entirely possible that the defendant could replicate his present circumstances at no additional cost.\textsuperscript{186}

On the other hand, the defendant is “underwater” with respect to his home loan, then the expense the defendant would incur in relocating could be deemed “unreasonable” because without sufficient funds to at least make a down payment on a new residence, the defendant is relegated to being a rental tenant.\textsuperscript{187} In either case, counsel is comfortable that she will not have to worry about this element since, in all likelihood, defendant will offer abundant proof that such costs are “unreasonable,” as proof of such element will be critical to the defendant’s case in chief.\textsuperscript{188}

\textsuperscript{182} See supra text accompanying notes 143-145.


\textsuperscript{186} If, for example, defendant is able to sell his residence for more than the mortgage balance on the subject property, the excess may be used for relocating expenses.

\textsuperscript{187} Say, for example, the defendant’s residence is currently worth $450,000, but the purchase price was $575,000, and the defendant’s loan balance indebtedness is in excess of $450,000.

\textsuperscript{188} See supra text accompanying notes 143-144.
Pivoting to the second element, establishing that such nuisance is “relatively enduring and not likely to be abated voluntarily or by court order,” counsel is immediately confronted with a catch-22. For purposes of damages, she wishes to have this nuisance categorized as “permanent,” but if the court enjoins the defendant from living in the neighborhood, the nuisance cannot be said to be permanent, since it will have been “abated . . . by court order.”

Thus, whether the court is likely to enjoin the defendant from residing in the neighborhood is a determination that must be resolved by the court before the question of whether the nuisance is “temporary” or “permanent” can be resolved by the finder of fact, either a jury, or the court, sitting without a jury. Counsel consequently conceives that her case must be postured and presented in such a way that the court will have to express itself on the likelihood of an injunction issuing, the resolution of which will resolve the permanent nuisance/temporary nuisance conundrum.

Counsel concludes that after the filing of the complaint, receipt of the defendant’s answer, and perhaps a bit of discovery, she must move the court for the issuance of a temporary injunction seeking the defendant’s removal from the neighborhood. If she is successful, her clients will be pleased and the case can proceed to trial to recover “temporary nuisance” damages for harms her plaintiffs have endured up to the time of trial. On the other hand, if the petition for a temporary injunction is denied, then the court will have established that the defendant’s nuisance-like activity by continuing to reside in the neighborhood is “relatively enduring and not likely to be abated voluntarily or by court order,” thereby establishing that the nuisance is permanent, for which damages measured by diminution in market value may be awarded.

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189. See KY. REV. STAT. ANN. § 411.530(1) (West 2016).


191. KY. REV. STAT. ANN. § 411.530(1)(b) (West 2016).

192. Id.

193. See generally Ky. R. Civ. Proc. 65.04(1); see also Lexington Loose Leaf Tobacco Warehouse v. Coleman, 158 S.W.2d. 633 (Ky. 1942). If, for instance, counsel moves the court, pretrial, for a temporary injunction pursuant to Ky. R. Civ. Proc. 65, the court will be forced to rule upon plaintiff’s entitlement to injunctive relief in granting or overruling this motion. If the court denies counsel’s petition for the issuance of a temporary injunction, it will be required to issue findings of fact and conclusions of law [see Ky. R. Civ. Proc. 65.04(5)], which will necessarily include a finding that plaintiff’s loss is not “irreparable,” since it may be compensated by money damages.

194. KY. REV. STAT. ANN. § 411.530(1)(b) (West 2016).
3. Might the Court Fashion a “Blended” Remedy, Such as “Private Condemnation” or “Compensated Nuisance”?

As Professor Lewin posits:

The past twenty-five years have witnessed an entirely new approach to nuisance law in which land use conflicts are analyzed in economic terms, with an emphasis on the goal of efficiency in resource allocation. The modern approach to nuisance law rejects the traditional emphasis on injunctive relief, asserting that this remedy often impedes the efficient resolution of land use conflicts. Monetary damage compensation, not injunctive relief, is the preferred remedy of most recent commentators. One unusual feature of the modern approach to nuisance law is a proposal that plaintiffs should be able to purchase injunctions through the judicial process in cases in which they would otherwise be denied injunctive relief.  

Professor Lewin cites Spur Industries, Inc. v. Del E. Webb Dev. Co. as an example of this modern approach. In Spur, the defendants were operating a concentrated animal feedlot operation for some years prior to Del Webb’s purchase and development of neighboring properties for sale to residential users. Because of odors and pestilence emanating from the feedlot operation, Del Webb sought to enjoin its operation through a nuisance suit, claiming that the operation was both a public and private nuisance.

While the Supreme Court of Arizona’s ruling in the case is complicated by some procedural anomalies, Spur’s uniquely constructed remedy sought to accommodate the legitimate interests of the parties before the court (and the surrounding public) by granting the injunction against the operation of the feedlot, conditioned upon Del Webb indemnifying the owners of the feedlot for the losses they incur in complying with the injunction. The Court reasoned:

[i]t does not equitable or legally follow, however, that Webb, being entitled to the injunction, is then free of any liability to Spur if Webb has in fact been the cause of the damage Spur has sustained. It does not seem harsh to require a developer, who has taken advantage of the lesser land values in a rural area as well as the availability of large tracts of land on which to build and develop a new town or city in the

195. See Lewin, supra note 6, at 775-76 (citations omitted) (emphasis added).
197. Spur, 494 P.2d, at 704.
198. Id. at 704-05.
199. Presumably because of the scope of Del Webb’s operations, the parties to the suit were barred from obtaining an injunction, but the court ruled, notwithstanding, that non-party residents of adjacent Del Webb properties would be entitled to injunctive relief in the interest of equity and public convenience; Spur, 494 P.2d at 706-08; see Lewin, supra note 6, at 791-92.
area, to indemnify those who are forced to leave as a result. Having brought people to the nuisance to the foreseeable detriment of Spur, Webb must indemnify Spur for a reasonable amount of the cost of moving or shutting down.\textsuperscript{200}

Accordingly, “the price to be paid by the plaintiff should equal the ‘damages’ caused to the defendant by the injunction.”\textsuperscript{201} Remembering, however, that an injunction will not serve to compensate plaintiffs for harms they will have incurred up to the time of trial, counsel believes the more appropriate measure of damages pursuant to this “compensated injunction” rubric would permit a prevailing plaintiff to receive a credit for any damages to which he would have been entitled.\textsuperscript{202} So the net price of the injunction would be the defendant’s abatement costs minus the amount of the defendant’s potential damage liability to the plaintiff.\textsuperscript{203}

\textit{Spur} is widely viewed as the only reported decision in which a court has compensated injunction to be the appropriate remedy in civil litigation.\textsuperscript{204} Nevertheless, as early as 1952, the highest court of Kentucky recognized the appropriateness of this remedy in the context of a boundary dispute.\textsuperscript{205} In \textit{Faulkner v. Lloyd}, plaintiff sought an injunction requiring the defendant to move a building constructed on plaintiff’s property.\textsuperscript{206} Defendant pled the equitable defense of estoppel, claiming that plaintiff knew, or should have known, of his claimed entitlement to the property as the building was being constructed.\textsuperscript{207} Although the defense of equitable estoppel might have been sufficient to deny plaintiff’s claimed entitlement to injunctive relief, the court noted that “[t]his action is pending in equity, and the court under its broad powers is not bound by inflexible rules in balancing the rights of the parties.”\textsuperscript{208} Accordingly, the Court of Appeals reversed and remanded the case to the lower court, stating:

\begin{quote}
we think under the circumstances the Court should have ascertained by proof the reasonable value of the strip of land taken and required its conveyance to appellees upon their payment of the sum fixed.
\end{quote}

\textsuperscript{200} \textit{Spur}, 494 P.2d at 708.
\textsuperscript{201} \textit{Lewin}, supra note 6, at 803 (citing Guido Calabresi & A. Douglas Melamed, \textit{Property Rules, Liability Rules, and Inalienability: One View of the Cathedral}, 85 \textit{Harv. L Rev.} 1089, 1092 (1972)).
\textsuperscript{202} See supra text accompanying note 153.
\textsuperscript{203} \textit{Lewin}, supra note 6, at 804-05. Professor Lewin finds support for this position in Robert C. Ellickson, \textit{Alternatives to Zoning: Covenants, Nuisance Rules and Fines as Land Use Controls}, 40 U. Chi. L. Rev. 681 (1973); see, e.g., \textit{Lewin}, supra note 6, at 741, n. 212.
\textsuperscript{204} \textit{Lewin}, supra note 6, at 793, n.74 (citing 53 A.L.R.3d 873-874 (1973)).
\textsuperscript{205} \textit{Faulkner v. Lloyd}, 253 S.W.2d 972, 974 (Ky. 1952).
\textsuperscript{206} Id.
\textsuperscript{207} Id. at 973.
\textsuperscript{208} \textit{Faulkner}, 253 S.W.2d at 974.
After the value is ascertained, the appellees should be given the choice of paying the reasonable value and requiring a conveyance or of removing the improvements.²⁰⁹

Faulkner thus legitimizes for the Kentucky court the broad and creative powers of the court in the context of a case seeking injunctive relief where the harshness of the injunctive remedy may be mitigated by the payment of money damages, but at the option of the defendant.²¹⁰

Moreover, 10 years later, in Bartman v. Shobe, the Kentucky Court of Appeals confirmed the propriety of the Faulkner approach, terming it a “private condemnation”:

In equity the rule of reason has always reigned supreme. In every case where injunctive relief is denied because the plaintiff has an adequate remedy at law there is, in practical effect, a ‘private condemnation’ in that the law refuses to stop one party from invading another’s property rights and paying later.²¹¹

While obviously not factually on point with the case at bar, counsel concludes that the broad language of Faulkner, buttressed by the nod of approval from the Court a decade later in Bartman, should provide comfort to the trial court when she urges it to fashion a “compensated nuisance” remedy.²¹²

4. Resolving the Temporary/Permanent Conundrum by Resorting to the Remedy Preferred by The Defendant – Defendant’s Choice!

At first blush, it might appear axiomatic that the defendant would choose to have his continued residence in the neighborhood denominated a “temporary” nuisance, since the defined remedy, loss of use or rental value, would likely result in a smaller damage award when compared with the award that could be levied by the court measured by diminution of market value, given the “high-end” nature of the property at issue.²¹³ On the other hand, the defendant must take cognizance of fact that without all potential plaintiffs joined in the lawsuit, he potentially faces a multiplicity of lawsuits claiming remedies for the “temporary nuisance,” given that “[a] temporary nuisance, on the other hand, is like a continuing trespass, for which recovery can be had for so much of the

²⁰⁹. Id.
²¹⁰. Faulkner, 253 S.W.2d at 974.
²¹². See supra text accompanying notes 197-205.
²¹³. Palmore, supra note 4, at 4-5.
damage as has accrued during the five-year period immediately preceding the filing of the action.\textsuperscript{214}

So, defendant must realize that in addition to the plaintiff seeking recovery in the within action, the simple filing of the Complaint may bring forth additional plaintiffs seeking to be joined in the action.\textsuperscript{215} And this is the case irrespective of whether the court awards temporary nuisance damages or permanent nuisance damages.\textsuperscript{216} Moreover, in the event the plaintiff in the instant action is successful, plaintiffs who are not parties to the instant action, and who seek recovery from a later initiated action, may be able to convince the court to rely upon the facts found in the previous action through the offensive use of collateral estoppel.\textsuperscript{217}

Thus, the defendant must realize that if plaintiff’s claim of nuisance is sustained by the court, irrespective of whether the court denominates the nuisance is temporary or permanent, defendant faces a potentially devastating award of damages in either case.\textsuperscript{218} So, at the margins, counsel for plaintiff arguably has no preference concerning how the court denominates the

\textsuperscript{214} Palmore, supra note 4, at 11 (citing KY. REV. STAT. § 413.120).

\textsuperscript{215} See CR 20.01 (West 2016). Alternatively, counsel for plaintiffs may seek to have all potential parties joined in a class action under CR 23.02 (West 2016). A class action may be the most practical solution to the problem of multiple plaintiffs, as the liability issues in the case would need to be tried but once.

\textsuperscript{216} Counsel for the defendant sex offender is thus placed in the unenviable position of being on the horns of a dilemma: he can defend the instant action and hope that unnamed, yet potential plaintiffs will "lie in the weeds"; or, he can seek the joinder of all potential plaintiffs. The first option may afford his client a smaller damage award, but the client may be faced with a multiplicity of lawsuits. If he chooses the second option, the award of damages, either temporary or permanent, may be so exorbitant as to force the defendant to relocate in order to avoid a devastating damages award. Recognizing that the second option is the remedy her clients would ultimately prefer, counsel for plaintiff would be well advised to secure service upon all potential plaintiffs in the instant action in order to force this outcome.


\begin{quote}
The requirements for the offensive use of Collateral Estoppel are: (1) a final decision on the merits; (2) identity of issues; (3) issues actually litigated and determined; (4) a necessary issue; (5) a prior losing litigant; and (6) a full and fair opportunity to litigate. (Citations omitted). The general rule is that a judgment in a former action operates as an estoppel only as to matters which were necessarily involved and a determined in the former action, and is not conclusive as to matters which were immaterial or unessential to the determination of the prior action or which were not necessary to uphold the judgment.
\end{quote}

\textit{Id.} at *2 (citing Sedley v. City of West Buechel, 461 S.W.2d 556, 556-58 (Ky. 1970)).

\textsuperscript{218} See supra text accompanying notes 215-220.
nuisance because the potential damage award for either permanent or temporary nuisance damages may be beyond the defendant’s ability to pay same, thus forcing his move from the neighborhood, the remedy counsel’s clients prefer.\textsuperscript{219} So, in summary, while the defendant may have a “choice” concerning whether he argues for temporary or permanent nuisance damages, he is in a “no-win” situation as his choice is truly a Hobson’s choice: unless the defendant is prepared to compensate plaintiffs with a damage award that could run into hundreds of thousands of dollars, he must relocate.\textsuperscript{220}

VI. CONCLUSION

Antiquated though it may be, the venerable tort of Nuisance remains viable in the 21\textsuperscript{st} century. Pursuant to Kentucky law, as well as the Restatement Second of Torts, it remains vital and flexible enough to remedy harms to property, the nature of which would have been inconceivable to courts merely a generation ago.\textsuperscript{221} True, the harms to neighboring properties discussed in this article in large measure occur only because of the widespread saturation of publicity the government has chosen to employ to notify the public of the potential dangers posed by convicted sex offenders.\textsuperscript{222} Thus, while competent counsel for the defendant sex offender will no doubt assert the defense of causation, the Kentucky courts have addressed this issue in a factually similar case.\textsuperscript{223}

In \textit{Allen v. Clemons}, a convicted sex offender brought suit against neighbors who erected a sign in his yard reading “Danger-Child Molester in the Community,” seeking damages for outrageous conduct.\textsuperscript{224} Confirming the propriety of the lower court’s dismissal of plaintiff’s cause of action, Chief Judge Lester, writing for the court, opined as follows:

The pain and suffering endured by the Plaintiff, William Allen, is directly attributable to his own wrongdoing. It was he who has been convicted by a jury of his peers of abusing a female child. The pain and suffering he has and is enduring is the direct and proximate result of

\textsuperscript{219} Id.
\textsuperscript{220} Merriam-Webster Online Dictionary defines a “Hobson’s Choice” as “a situation in which one is supposed to make a choice, but does not have a real choice because there is actually only one thing you can have or do.” Merriam-Webster Online Dictionary, http://www.merriam-webster.com/dictionary/Hobson’s%20choice (last visited Feb. 21, 2017).
\textsuperscript{222} Id.
\textsuperscript{223} \textit{Mudd}, 339 S.W. 2d at 186-87. Counsel for defendant will no doubt posit the notion that it is the government’s act of notification, rather than the defendant’s offending activity, which has caused the alleged damage to plaintiffs’ properties.
\textsuperscript{224} \textit{Allen v. Clemons}, 920 S.W.2d 884, 885 (Ky. Ct. App. 1996).
his sexual perversions becoming public knowledge. Throughout the history of civilized man we have operated on the premise that you don’t kill the messenger boy, which is what the Plaintiff herein wants to do. Accordingly, this Court finds that the damages sustained by William Allen, if any, are a direct and proximate result of his criminal conduct and not a result of the Defendant’s actions.\footnote{225} In \textit{Allen}, the conduct engaged in by the defendant/neighbor, erecting a sign in the sex offender’s yard, occurred in 1993, predating Kentucky’s adoption of its community notification legislation.\footnote{226} The General Assembly’s subsequent adoption of Ky. Rev. Stat. §17.580 now criminalizes such conduct, and, consequently, the outcome in \textit{Allen} would no doubt be different were the case to be brought in the present day.\footnote{227} Nevertheless, Judge Lester’s reasoning portends well of the predictive value concerning how the Kentucky courts may view a putative defendant’s claim that it is community notification, rather than his initial actions, which give rise to plaintiff’s claims of nuisance.\footnote{228}

Community notification is a direct and proximate result of the nuisance defendant’s conduct, but for which, no nuisance claim would have arisen.\footnote{229} In short, if you don’t “shoot the messenger boy” when he is a private individual, \textit{a fortiori}, one shouldn’t “shoot the messenger boy” when he is the government. Only time will tell whether the courts are willing to give this new application of the law of nuisance the attention and remedy it deserves.

\footnote{225}{\textit{Id.} at 887; see Chrisandrea L. Turner, Note, \textit{Convicted Sex Offenders v. Our Children: Whose Interests Deserve the Greater Protection?}, 86 Ky. L.J. 477, 503 (1997-1998)) (citing \textit{Allen}, 920 S.W.2d at 887).}
\footnote{226}{\textit{Allen}, 920 S.W.2d at 885.}
\footnote{227}{\textit{Ky. Rev. Stat. Ann.} § 17.580(4) (West 2009) provides: The following language shall be displayed on the Website: “UNDER KRS 525.070 AND 525.080, USE OF INFORMATION OBTAINED FROM THIS WEBSITE TO HARASS A PERSON IDENTIFIED ON THIS WEBSITE IS A CRIMINAL OFFENSE PUNISHABLE BY UP TO NINETY (90) DAYS IN THE COUNTY JAIL. MORE SEVERE CRIMINAL PENALTIES APPLY FOR MORE SEVERE CRIMES COMMITTED AGAINST A PERSON IDENTIFIED ON THIS WEBSITE.”}
\footnote{228}{\textit{Allen}, 920 S.W.2d at 886.}
\footnote{229}{But for community notification, the defendant’s activities may have remained secret, and thereby incapable of deleteriously affecting the value of surrounding properties. Similarly, what is the motivation of anyone to bring a nuisance action unless and until one is aware of the offending activity? Like the adage concerning “the tree falling in the forest,” who is harmed if no one has heard it?}
HOW TATTOOS FIT WITHIN THE REALM OF COPYRIGHT LAW: DO WE FINALLY HAVE A LAWSUIT THAT WILL PROVIDE SOME CLARITY?

Tyler Noonan

I. INTRODUCTION

The NBA 2K video game series is reaching unprecedented levels of success thanks to its latest version, NBA 2K16. In an effort to make the game more realistic, developers reproduced real-life tattoos on the virtual personas of National Basketball Association (NBA) players. These players include some of the best in the league – LeBron James, Kobe Bryant, DeAndre Jordan, Kenyon Martin, and Eric Bledsoe. Whether this “realistic” strategy is what caused the great success may be up for some debate, but there is no debating the sales-success the video game has had since its release.

The game was released on September 25, 2015 and within its first week on the market it sold over four million copies. By the next month, the game more than doubled the previous year’s sales for digital copies, while nearly tripling the amount of online games played. Jason Argent, who is a Senior Vice President of Operations for 2K, described the success, stating, “NBA 2K fans around the world are buying this title faster and in greater numbers than ever before.” NBA 2K16 was the best-selling video game in the United States, topping other

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3. Id.


5. Id.

6. Id.

7. Id.
well-known video game franchises such as *Madden NFL 16*, *Metal Gear Solid*, and *FIFA 16*. In fact, *NBA 2K16* wasn’t just the best selling video game at that time – it was the best ever. The video game had the best launch month ever for a sports game on the 8th generation of video game consoles. The game was so successful that 2K’s video-game rival, Electronic Arts’ *NBA Live 16*, couldn’t even crack the top ten on the list of best-selling video games.

The financial rewards for Take-Two, 2K’s parent company, are astounding. For the second quarter of 2015, the quarter in which *NBA 2K16* was released, Take-Two saw tremendous increases in revenue and net income. When compared to the same quarter of the year before, revenue jumped 169 percent to $364.9 million. The company produced a net income of $32.7 million. All told, that’s a remarkable difference of $68.1 million. While the company also released two other major video games, *Grand Theft Auto V* and *WWE 2K16*, the majority of this revenue undoubtedly came from the chart-topping NBA series. This financial success passed on to Take-Two’s shareholders, with their predicted earnings of 15 cents per share doubling to 30 cents per share.

So what makes this version of the virtual basketball game so much better than the rest? Sports media empire Bleacher Report gives three reasons why


9. See id.

10. Id. (A “generation” of a video game console is an era in which the video game was produced. So, here, this game sold on the 8th version of the video game console, which is the most recent generation.)

11. Id.


13. See id.

14. Id.

15. Id.

16. Id.

17. See id.

18. Id.
this version is better than the rest: (1) team customization and 2K Pro-am; (2) colleges in MyCareer; and (3) the aforementioned tattoos. The new team customization and 2K Pro-am tour allows players to customize their own team – with everything from branding the team with a new logo, to building a new arena, to designing a new uniform, or relocating the team entirely. This customized team can then be used for the 2K Pro-am setting, which allows for players to team up with up to five friends to play a game together. The addition of colleges in the game’s MyCareer feature allows players to choose which college they want to attend before controlling the player throughout a simulated NBA career. Third, critics love the improvement of player tattoos, which have appeared in the game since at least the 2K14 version. NBA 2K16 contains updated, accurate player tattoos, as well as a feature that allows gamers to build their own player and deck them out in personalized tattoos. The tattoo feature plays a large role in the video game’s great success, as it is “leagues ahead of what has been offered in the past.” With record-breaking sales, exponentially increased income, and beloved new features, all was well with NBA 2K16.

However, in February of 2016, 2K Sports, Take-Two, and Visual Concepts (a subsidiary of 2K that is in charge of the marketing and development of 2K’s products) (collectively “Defendants”) were hit with a lawsuit. Solid Oak Sketches (“Plaintiff”) filed a copyright infringement lawsuit against the makers of NBA 2K16 in the United States District Court for the Southern District of New York. The complaint alleges that six tattoos on the five players previously


20. Id.

21. See id.

22. Id.

23. See id.

24. Id.

25. Id.


mentioned – LeBron James, Kobe Bryant, DeAndre Jordan, Kenyon Martin, and Eric Bledsoe – were unlawfully reproduced in the game, with some even being featured in advertisements and cover art. Solid Oak Sketches, who is represented by Heitner Legal, owns the copyright to these tattoo designs and seeks compensation for their use. This note attempts to predict what the outcome of this case will be if it continues on to trial.

II. BACKGROUND

The issue of copyright and tattoos is not an issue of first impression. As TheWhiteBronco.com puts it, “[t]his is not the first litigation volley in the tattoo copyright wars.” However, no court has ever confirmed whether tattoos are copyrightable. There have been several cases concerning the issue, but they have all settled out of court and without a ruling. This section will take an in-depth look at these previous instances, highlighting the facts of each case to show similarities to the complaint filed by Solid Oak Sketches.

A. Escobedo v. THQ, Inc.

Chris Escobedo is a tattoo artist based in Phoenix, Arizona. In 2009, he applied a large lion tattoo on the right ribcage of the Ultimate Fighting Championship’s (“UFC”) Carlos Condit, who went on to become the interim UFC Welterweight Champion. Prior to applying the tattoo to Condit’s skin, Escobedo drew the design out on paper. In 2012, the United States Copyright Office recognized Escobedo as the copyright owner of the work. The work was

31. Id.
32. Id.
33. Id.
35. Id.
36. Id.
37. Id.
given the title “Lion Tattoo.”\textsuperscript{38} THQ is a company that develops and publishes video games – most relevant here is the game UFC Undisputed 2010, which was released around May of 2010.\textsuperscript{39} Two years later, THQ released another game – \textit{UFC Undisputed 3} – as a follow-up feature.\textsuperscript{40} In both games, the “Lion Tattoo” was featured on Condit’s character.\textsuperscript{41}

As a result, Escobedo brought suit for copyright infringement, claiming the tattoo was prominently shown in several of the game’s features – particularly during highlight reels, replays, between each fight’s rounds, and during the rounds.\textsuperscript{42} While Escobedo admitted that he had impliedly licensed Condit to publicly display the tattoo on his body, he gave no such license to the makers of the video game.\textsuperscript{43} Therefore, Escobedo claimed that THQ had violated his rights by reproducing, copying, creating a derivative work, distributing, and displaying his work.\textsuperscript{44} Escobedo cited the game’s retail price ($59.99) and sales data (it had sold approximately 660,00 copies at the time the complaint was filed) to claim a right to receive actual damages.\textsuperscript{45} Escobedo was seeking $4 million in compensation.\textsuperscript{46}

A bankruptcy court eventually awarded Escobedo $22,500 for the tattoo.\textsuperscript{47} Escobedo appealed this judgment, challenging the award as inadequate.\textsuperscript{48} The matter was settled out of court shortly thereafter for an undisclosed amount.\textsuperscript{49}

\par\textsuperscript{38} Id.
\par\textsuperscript{39} Complaint, Escobedo v. THQ, No. 2:12CV02470 (D.Ariz. 2012), 2012 WL 5815742.
\par\textsuperscript{40} Id.
\par\textsuperscript{41} Id.
\par\textsuperscript{42} See id.
\par\textsuperscript{43} Id.
\par\textsuperscript{44} Complaint, Escobedo v. THQ, No. 2:12CV02470 (D.Ariz. 2012), 2012 WL 5815742.
\par\textsuperscript{45} Id.
\par\textsuperscript{46} Bryan Wiedey, \textit{Lawsuit Filed Over Copyrighted Tattoos on Players in NBA 2K16}, \textsc{SportingNews} (Feb. 2, 2016), http://www.sportingnews.com/other-sports/news/lawsuit-filed-over-copyrighted-tattoos-on-players-in-nba-2k16-lebron-james-kobe-bryant/15pm9g4a2xfdr1sx26hnfjry3h.
\par\textsuperscript{48} Wiedey, \textit{supra} note 46.
\par\textsuperscript{49} Id.
EA Sports eventually gained the rights to the UFC virtual series, and prior to releasing their first version of the game, they removed the tattoo from Condit’s body. While it appears (though we don’t know for sure since no opinion was issued) the bankruptcy court acknowledged the infringement of Escobedo’s work, the public is left with little information about the details of infringement on tattoos or, thanks to the confidentiality agreement in the settlement, the value of such infringement.

B. Allen v. Electronic Arts, Inc.

Allen v. Electronic Arts, Inc. is another case that bears a striking resemblance to the one involving Solid Oak Sketches and Take-Two. Stephen Allen is a tattoo artist for Crybabies Tattoo and works out of Shreveport, Louisiana. In 2003, Ricky Williams, a player in the National Football League (NFL), sought out Allen for a tattoo. Allen applied the tattoo to Williams’ arm, charged Williams $200 for the work, and had Williams sign a document entitled “Consent to Tattoo or Piercing Procedure Release of Claims.” Allen knew Williams was a professional football player and expected to see the tattoo on television.

However, several years later Allen filed suit against Williams and Electronic Arts (EA) when he saw the tattoo appearing on the cover of EA’s video games NFL Street, Madden NFL 10, and Madden NFL 11. The complaint alleged that Allen was never contacted in regards to permission to use the tattoo, but nevertheless EA “copied, reproduced, distributed, adapted and/or publicly displayed” the copyrighted work. The complaint named Williams as a defendant due to his alleged “contributory infringement of Plaintiff’s copyright and exclusive rights.” Allen asked the court to force Williams to produce

50. Id.

51. See generally Complaint for Copyright Infringement and Accounting and Other Relief, Allen v. Electronic Arts, No. 5:12-V-3172 (W.D.La. 2012), 2012 WL 6852208.

52. See id.

53. See id.

54. Id.

55. Id.

56. See id.


58. Id.
documents showing how much money he made from the use of the tattoo and, based off those numbers, compensate Allen his fair share. Just three and a half months after the complaint was filed, and before a court could give a ruling on the issue, the case was settled out of court for an undisclosed amount.

C. Reed v. Nike, Inc.

A similar conflict comes out of the United States District Court for the District of Oregon. Matthew Reed filed a lawsuit against Nike, Rasheed Wallace, and Weiden+Kennedy for the alleged infringement of his work. According to Reed’s complaint, Wallace, who was an NBA player, sought him out for a tattoo involving an Egyptian theme. The two met on multiple occasions, with Wallace offering up the general idea, Reed drafting up an image, Wallace requesting changes, and finally a reduction of the final tattoo to a stencil. The tattoo was then applied to Wallace’s arm for a fee of $450 (which was actually below value, but Reed was willing to sacrifice some money in exchange for the exposure it would bring for his business). Reed obtained a copyright for the work, titled “Egyptian Family Pencil Drawing.”

In 2004, Reed learned that Nike, whom Wallace had an endorsement deal with, was featuring the tattoo in a new advertising campaign. Weiden+Kennedy, the third defendant in the complaint, was hired by Nike to create, manage, and coordinate the advertising campaign. The commercial involves an image of the tattoo being recreated over Wallace’s skin, with

59. Id.


61. See generally Complaint Copyright Infringement Accounting, Reed v. Nike, No. CV 05 198 (D.Or. 2005), 2005 WL 1182840.

62. See id.

63. Id.

64. See id.

65. Id.


67. Reed, supra note 61.

68. Id.
Wallace doing a voice-over explaining the tattoo’s meaning. 69 After learning of this, Reed filed suit, alleging that Nike and Weiden+Kennedy copied, reproduced, distributed, adapted, and/or publicly displayed his copyrighted work. 70 Much like in Allen above, this lawsuit alleged Wallace advised his co-defendants that he had exclusive ownership of the tattoo and, at a minimum, his conduct “caused or materially contributed to the unauthorized” infringement. 71 Additionally, Reed claimed that if it were found he and Wallace were co-owners of the tattoo, he was entitled to a portion of Wallace’s profit from the endorsement. 72 Unfortunately, like the other cases, the issue settled out of court and the terms of the settlement are still private. 73

D. Whitmill v. Warner Bros.

This case is perhaps the most well-known and insightful case we have on this issue. 74 It is “the most (in)famous of the tattoo and copyright cases.” 75 Victor Whitmill applied a tattoo to professional boxer and former world heavyweight champion Mike Tyson’s face, which, as Whitmill describes it, has since become “one of the most distinctive tattoos in the nation.” 76 Eight years later, Warner Bros. began advertising for their new movie, The Hangover Part II. 77 Warner Bros. admits to copying the tattoo to the face of a character in the movie, Stu Price. 78 In addition to being featured for over half the film, the tattoo is the “prominent focus” of an advertising campaign, a promotional event in which fans can get a collectible cup with an image of Stu’s face (with the tattoo), and an iPhone app that allows users to download a badge that consists of the tattoo on a blank background, presumably so users can take a picture of a

69. See id.
70. Id.
71. Id.
72. Id.
74. See id.
75. Id.
77. Commander, supra note 73 at 1960.
face so it will appear with the tattoo on it.\textsuperscript{79} After learning of this, Whitmill sued Warner Bros. for infringing on his exclusive rights to the tattoo.\textsuperscript{80}

The complaint alleged that on the day that tattoo was completed, Tyson signed a release form stating “that all artwork, sketches and drawings related to [his] tattoo and any photographs of [his] tattoo are property of Paradox-Studio of Dermagraphics.”\textsuperscript{81} Whitmill claimed to have a copyright to the tattoo and stated he had never applied the tattoo onto anyone else or authorized anyone “to copy, distribute, or publicly disseminate” the tattoo.\textsuperscript{82} The complaint stated Warner Bros. infringed on the copyright by copying, distributing, and publicly displaying the tattoo, as well as through the making of an unauthorized derivative work based off the original.\textsuperscript{83} Whitmill sought damages and, more importantly, a preliminary injunction throughout the pendency of the action to stop the movie from being released.\textsuperscript{84}

Not surprisingly, Warner Bros. objected to the preliminary injunction and asked the court to deny the motion.\textsuperscript{85} First, Warner Bros. asserted that when a work of art is transformed into a tattoo, it becomes a part of the public domain and is no longer a protectable art.\textsuperscript{86} This is because the tattoo cannot be separated from Tyson’s face, which is a “useful article.”\textsuperscript{87} Second, Warner Bros. used the “Fair Use” defense.\textsuperscript{88} This weighs four factors to determine if one party’s use of the other party’s work should not be punished: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the portion of the work used in relation to the entire work; and (4) the effect of the accused use on the market or value of the copyrighted work.\textsuperscript{89} Third, Warner Bros. claimed to have an implied license to use the tattoo.\textsuperscript{90} Fourth, Warner Bros.
presented an estoppel argument, arguing that since Whitmill did not object to Tyson’s appearance (as well as, obviously, the tattoo’s appearance) in the first Hangover movie, they could not object now.\textsuperscript{91}

Whitmill responded with counter-arguments, explaining why each of the claims set forth by Warner Bros. was invalid.\textsuperscript{92} Whitmill claimed that all of Warner Bros. assertions were affirmative defenses for which they cannot meet their burden of proof.\textsuperscript{93} First, Whitmill claimed that tattoos are copyrightable because “[t]hey are ‘pictorial works’ ‘fixed in any tangible medium of expression . . . from which they can be perceived . . . directly.”\textsuperscript{94} Then, Whitmill rebutted Warner Bros. by showing that a “useful article” is defined as “an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey the information.”\textsuperscript{95} Whitmill compared tattoos to a pattern on an umbrella; the umbrella is not copyrightable, but the design on the umbrella is.\textsuperscript{96} Then, Whitmill asked Warner Bros. to think of how their own argument would negatively effect them – if tattoos were not copyrightable, Warner Bros. “risks losing a significant portion of its own copyright portfolio anytime someone gets a tattoo of Bugs Bunny.”\textsuperscript{97}

Second, Whitmill claimed the infringement is not a “fair use.”\textsuperscript{98} Whitmill argued the purpose of Warner Bros.’ use of the tattoo is purely for commercial reasons – it is used as part of a marketing campaign that will remind viewers of the first Hangover movie and entice them to watch The Hangover Part II as well.\textsuperscript{99} The four factors for determining “fair use” – (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the portion of the work used in relation to the entire work; and (4) the effect of the accused use on the market or value of the copyrighted work – all favor Whitmill as well,

\textsuperscript{90} Whitmill, 2011 WL 11569200.
\textsuperscript{91} See id.
\textsuperscript{92} See generally id.
\textsuperscript{93} Id.
\textsuperscript{94} Id. (citing 17 U.S.C. § 102(a)).
\textsuperscript{95} Id. (citing 17 U.S.C. § 101).
\textsuperscript{96} Whitmill, 2011 WL 11569200.
\textsuperscript{97} Id.
\textsuperscript{98} See id.
\textsuperscript{99} Id.
according to his memorandum.\textsuperscript{100} Third, Whitmill argued that the implied license is limited to Tyson and Tyson only, arguing that since he was never in contact with Warner Bros. they must have gotten the “implied license” as a sub-licensee, which is a legal position for which there is no support.\textsuperscript{101} Fourth, Whitmill objected to the estoppel argument due to Tyson’s implied license.\textsuperscript{102} Because Tyson had an implied license for the tattoo, Whitmill argued, there was nothing to object to in the first \textit{Hangover} movie (in which Tyson appears, playing himself).\textsuperscript{103} Whitmill also explained that the first element to an estoppel claim is the plaintiff’s knowledge of defendant’s conduct.\textsuperscript{104} There was nothing in the first movie that would have indicated or put Whitmill on notice that the tattoo would be reproduced in the second movie.\textsuperscript{105} Therefore, Warner Bros. does not meet the elements required for an estoppel claim.\textsuperscript{106}

Judge Perry heard the arguments on Whitmill’s Motion for a Preliminary Injunction, which would have stopped the film from releasing unless the tattoo was removed from Stu’s face.\textsuperscript{107} Although she denied the motion, Judge Perry did not seem entirely unconvinced by Whitmill’s arguments, stating that the “[p]laintiff has a strong likelihood of prevailing on the merits for copyright infringement.”\textsuperscript{108} She went on to criticize Warner Bros. defenses and proclaimed, “Most of the defendant’s arguments against [copyright infringement] are silly. Of course tattoos can be copyrighted. I don’t think there is any reasonable dispute about that.”\textsuperscript{109} Later that same day, the parties settled for an undisclosed amount and the issue was resolved with no court ruling.\textsuperscript{110}

\begin{itemize}
\item \textsuperscript{100} See id.
\item \textsuperscript{101} Whitmill, 2011 WL 11569200.
\item \textsuperscript{102} See id.
\item \textsuperscript{103} Id.
\item \textsuperscript{104} Id.
\item \textsuperscript{105} Id.
\item \textsuperscript{106} See generally id.
\item \textsuperscript{108} See generally id.
\item \textsuperscript{109} Id at 1963.
\item \textsuperscript{110} Id.
\end{itemize}
E. *Madden NFL and the approach of the NFLPA*

While this section does not discuss a lawsuit, it shows how professional football and the *Madden NFL* video game series are “practicing avoidance” of the issue.111 *Madden NFL* no longer depicts players with tattoos, with very few exceptions.112 In *Madden NFL ’15*, Colin Kaepernick, quarterback for the San Francisco 49ers, was the only player with tattoos.113 Kaepernick’s tattoos were allowed because they secured the licenses from the quarterback’s tattoo artists, a process which took “a fair amount of work.”114 In the newest release of *Madden*, Odell Beckham Jr. and Martavis Bryant joined Kaepernick.115 These two players also obtained the necessary permission from their artists.116 *Madden NFL* has perhaps been the most cautious on the issue, realizing the potential legal ramifications that could follow putting tattoos on all players.117 Even with the sacrifice of a small piece of authenticity, the game has enjoyed immense success, selling over 100 million copies.118

The NFLPA (National Football League Player’s Association) has taken note of these copyright issues as well, urging players to get waivers, licenses, or assignments from their tattoo artists for all public appearances.119 According to SportingNews, the NFLPA’s caution could also be a contributing factor to


112. *Id.*


116. *Id.*


118. *Id.*

Madden NFL’s lack of tattoo-covered players. In 2014, the NFLPA notified players that, absent express written permission, their tattoos “would not appear in products such as video games, on merchandise or in advertising where the art has to be reproduced.” This puts the burden on the players – if they want their tattoos to be shown off, then they need to be the ones to put forth the effort to obtain the proper licensing. So far, only Kaepernick, Beckham Jr., and Bryant have received the “green light.”

III. DISCUSSION OF SOLID OAK SKETCHES V. 2K SPORTS

The eight tattoos in question in Solid Oak Sketches v. 2K Sports were created by five different tattoo artists, all of which agreed to a deal giving up their rights, in exchange for royalties, to Solid Oak Sketches. Shawn Rome created the works “330 and Flames Tattoo Artwork,” “Lion’s Head Tattoo Artwork,” and “Script with a scroll, clouds, and doves.” All three of these tattoos were given to LeBron James. Justin Wright created the work titled “Child Portrait tattoo Artwork.” LeBron James was also the recipient of this tattoo. Tommy Ray Cornett created “Basketball with Stars and Script” and “Wizard.” “Basketball with Stars and Script” was given to Eric Bledsoe, while “Wizard” was inked onto Kenyon Martin. Kobe Bryant received the tattoo “Crown with Butterflies,” which was created by Robert Benedetti. Lastly, DeAndre Jordan was the
recipient of a tattoo created by Leslie Hennelly entitled “Script with a Scroll.”132 Solid Oak Sketches claims, and offers copies of agreements to prove, that they are the owner of the rights of each of these tattoo designs.133 Though the negotiation letters list all eight of these tattoos, the actual complaint does not list Bryant’s or Jordan’s tattoos.134 This means that the lawsuit only involves six tattoos on three players.135

Prior to the filing of the lawsuit, Solid Oak Sketches reached out to the creators of NBA 2K16 in an attempt to reach an agreement out of court.136 In the initial demand letter, Solid Oak Sketches did not specify what compensation they were seeking, instead pushing the issue off on the video game makers and ensuring the agreement would be confidential:

“I can assure you that my clients would prefer to resolve this matter quietly and amicable [sic]. Assuming the parties can reach an agreement as to fair compensation for the prior unlicensed uses of the tattoos and, if your company so desires, a license for future uses, my clients would be willing to include in the settlement documents an appropriate nondisclosure provision designed to maintain the confidentiality of the settlement, including its very existence.”137

In Exhibit B of the complaint, Plaintiff, seemingly in response to a request for an exact dollar figure from Defendants, demanded a total of $819,500 in damages.138 Alternatively, Plaintiff offered a perpetual license for a one-time fee of $1,144,000.139

Plaintiff was very generous to defendants in calculating these damages, basing the numbers off the court’s award to Christopher Escobedo in his previously mentioned suit against THQ.140 Plaintiff’s demand letter

132. Id.
133. See id. at Exhibit D-K.
134. See id.
136. See id. at Exhibit A.
137. See id.
138. See id. at Exhibit B.
139. Id.
acknowledges that Escobedo’s actual compensation was settled for an amount undoubtedly greater than the $22,500 the court awarded, but stated they were using that number solely as a baseline for the “initial discussion[s].” Using Escobedo’s award and applying it to the sales data for the NBA 2K14 and 2K15 games, Solid Oak Sketches claimed to be owed $572,000 in compensation for the in-game infringement. Since two of LeBron James’ tattoos were “featured prominently” on the cover of NBA 2K14, plaintiffs “conservatively” estimated their value to be at least four times the rest of the tattoos. The value of these tattoos was then multiplied by the total sales for the NBA 2K14 game, accumulating to a total of $819,500 in damages. To determine the one-time licensing fee, Solid Oak Sketches used the in-game infringement numbers and calculated what it would cost to license the tattoos for four additional years, equaling an amount of $1,144,000. Again, Plaintiff was generous in this calculation, noting that most of the athletes with the tattoos in question will have careers that last much longer than four years. This detailed demand letter was unsuccessful, causing Plaintiff to file an official complaint in New York District Court. Ultimately, Plaintiff requested the court award “appropriate statutory and/or monetary damages” and “reasonable attorneys’ fees.”

A. Take-Two’s Motion to Dismiss Statutory Damages and Attorneys’ Fees

While refusing to admit they had done anything wrong, Defendants responded to the filed complaint by filing a motion to dismiss. The motion to dismiss was “narrow,” as it only sought to dismiss Solid Oak Sketches’ claim for the statutory damages and attorneys’ fees. According to Defendants, 17

141. *Id.*
142. *Id.*
143. *Id.*
144. *Id.*
146. *Id.*
147. See generally *Id.*
148. See *Id.*
150. *Id.*
U.S.C. § 412 (which plaintiff filed the claim under) does not allow for statutory damages and attorneys fees when the work is registered after the infringement has occurred. The alleged infringement began, as plaintiff admits, as early as the 2K14 version of the video game. The copyright registrations did not take place until two years after this initial infringement took place, in June and July of 2015. § 412 states that there will be no “award of statutory damage or of attorney's fees” for “any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.” Therefore, Defendant asks the court to grant its motion to dismiss the statutory damages and attorneys’ fees claims.

Plaintiff, of course, would not go down without a fight. Plaintiff gave four main reasons why they should be entitled to the statutory damages and attorneys’ fees: (1) because the NBA 2K16 infringement was “overtly willful,” it is separate from the prior infringements; (2) an “appreciable period of time” had passed between the 2K16 infringements and the past infringements, thus making it a new infringement; (3) since the infringement only occurred in, at most, two prior instances (NBA 2K14 and NBA 2K15), the § 412 bar to damages does not apply; and (4) the NBA 2K16 game is sufficiently different from the previous versions of the game and should therefore be treated as its own infringement.

Defendants responded to this by attacking the reasoning as

151.  Id. (citing Knitwaves, Inc. v. Lollytogs Ltd. 71 F.3d 996, 1012 (2d Cir. 1995)).
153.  Solid Oak Sketches, supra note 148.
155.  See Solid Oak Sketches, supra note 148.
157.  See id.
158.  Id.
159.  Id.
160.  Id.
weak and without precedent or support. In fact, Defendants argued that Second Circuit precedent actually bounded the court to do exactly the opposite of what Plaintiff was asking. Defendants again asked the court to grant the motion to dismiss and strike down the opportunity for statutory damages and attorneys’ fees.

On August 2, 2016, the court offered a ruling on the issue. In granting the motion to dismiss, the court sided with nearly every one of Defendants’ arguments. The court noted the initial infringement occurred with the release of NBA 2K14 in 2013, yet Plaintiff did not register the tattoo designs with the U.S. Copyright Office until 2015. For each of the four points Plaintiff raised in response to the Motion to Dismiss (listed above), the court explained why Plaintiff’s arguments were “unavailing.” First, the court pointed out that whether or not Defendants acts were “overtly willful” is irrelevant, as willfulness has nothing to do with § 412. Second, the court showed that the one year gap between each infringement does not constitute “an appreciable period of time” as to render it a new infringement. Third, the court ruled it does not matter that the infringement occurred on only two previous occasions, as § 412 precludes statutory damages and attorney fees where any infringement occurred before the copyright was registered. Fourth, the court dismissed the idea that since the newest version of NBA 2K is different than the past versions, the infringements are new. The court reasoned that the game is


162. Id.

163. Id.


165. Id. at *4.

166. Id. at *2 (citing Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124.).

167. Id. at *3-4.

168. Id. at 3.


170. Id.

171. Id.
substantially the same, with only slight changes being the title and visual and graphic improvements, and that the same defendants were allegedly infringing on the same tattoos.172

B. Take-Two’s Answer and Counterclaims

With this ruling behind them, Defendants filed their Answer to the complaint just two weeks later.173 In the Answer, Take-Two denied any wrongdoing.174 Defendants went on to list, but did not elaborate on, seven defenses they believed favored them: (1) failure to state a claim; (2) de minimis use; (3) fair use; (4) license; (5) consent, waiver, estoppel; (6) non-infringement; and (7) fraud on the Copyright Office.175 The Answer also discussed, in further detail than at any point prior, the tattoos and their history.176 The Answer even included pictures of the tattoos at the heart of the controversy, and for each one, explained the length of time between the actual inking and its copyright filing and Defendants belief that the players had more influence over what the tattoo would look like than the artist did.177 The Answer also alleged that the tattooists knew the tattoos would become a part of the athletes’ image.178 Take-Two also stated that the tattoos appear only “fleeting” in the game, and they never appear in any other form than as part of the players’ likeness.179 In discussing these aspects of the tattoos, Take-Two was laying the groundwork to argue their defenses.180

Take-Two’s Answer also included three counterclaims.181 First, Take-Two sought a declaratory judgment that use of the tattoos in NBA 2K16 constitutes a

172. Id.
174. See id.
175. Id. at 9-10.
176. See id. at 17-26.
177. Id.
178. Id. at 27-29.
180. See generally id.
181. See id. at 36-39.
De minimis use. De minimis use means “the law does not concern itself with trifles” – or, as applied here, the use of the tattoos is so small and unimportant that the law should not concern itself with the use. Take-Two sought this declaratory judgment because the tattoos appear only “fleeting” and briefly and they are just a small part of the graphic display and virtual world created in NBA 2K16. Furthermore, the game features tattoos beyond just the ones at issue in this litigation, and the tattoos are just one of many components that make up NBA 2K16. Second, Take-Two sought a declaratory judgment of fair use. As Take-Two said, they “are not creating, distributing, or marketing tattoos; they are creating, distributing, and marketing video games.” Because Take-Two is not impeding on Solid Oak’s ability to market tattoos, and because the tattoos serve a minor purpose as a feature of the players’ likenesses, Take-Two said this was a fair use of the tattoos. Third, Take-Two sought a declaratory judgment of fraud on the Copyright Office, in addition to an order from the court invalidating and cancelling the copyright registration for the tattoo “Lion’s Head Tattoo Artwork.” The tattoo, originally created by and inked onto Lebron James by Shawn Rome in 2000, has since undergone significant changes. These changes were not made by Rome. However, when the tattoo was filed with the Copyright Office in 2015, the application listed Rome as the only artist. The application should have listed Rome and at

182. Id. at 36.
185. Id.
186. Id. at 37.
187. Id.
188. Id. at 38.
189. Id. at 38-39.
190. Defendants’ Answer and Counterclaims at 36, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016), at 21-22 (The original tattoo was a lion’s head with a crown on it, but it was later changed such that, among other things, the crown is no longer visible.).
191. Id. at 22.
192. See id.
least one other artist as the creators of the work, but it did not, and as a result, Take-Two sought a declaratory judgment of fraud on the Copyright Office.\textsuperscript{193}

Solid Oak responded with a Motion to Dismiss the counterclaims made by Take-Two.\textsuperscript{194} Solid Oak argued that the counterclaims are redundant and duplicative of Take-Two’s affirmative defenses.\textsuperscript{195} After all, the three counterclaims are the same as three of the affirmative defenses listed in Take-Two’s Answer.\textsuperscript{196} Solid Oak cited to Federal Rule of Civil Procedure 12(f), which states that “the court may strike from a pleading ... any redundant ... matter.”\textsuperscript{197} Solid Oak alleged that Take-Two’s counterclaims are duplicative of their defenses and “add nothing new from a legal or factual standpoint.”\textsuperscript{198} Additionally, Solid Oak argued that there is no need to be concerned about putting Defendants at the mercy of Plaintiffs, referring to the possibility that Plaintiffs could drop suit and then re-sue Defendants at any time in the future since the controversy has not been resolved.\textsuperscript{199} If the case were to be dismissed, Solid Oak argued that the court has the discretion to determine the proper terms of the dismissal and whether it is with prejudice or not.\textsuperscript{200} This, Solid Oak claimed, would prevent Defendants from constantly having to worry about another suit being brought against them by Plaintiffs or another owner of tattoo copyrights.\textsuperscript{201}

Two weeks later, Take-Two filed a memorandum in opposition of Solid Oak’s motion to dismiss the counterclaims.\textsuperscript{202} First, Take-Two argued that the counterclaims are not redundant as they serve a separate purpose than the affirmative defenses – the declaratory judgment counterclaims serve the

\insertFootnotes
\begin{itemize}
  \item[193.] Id.
  \item[194.] Memorandum of Law in Support of Plaintiff’s Motion to Dismiss, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).
  \item[195.] Id. at 1.
  \item[196.] Id.
  \item[197.] Id.
  \item[198.] Id. at 3.
  \item[199.] Id. at 4.
  \item[200.] Memorandum of Law in Support of Plaintiff’s Motion to Dismiss, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).
  \item[201.] Id.
  \item[202.] Defendants’ Memorandum of Law in Opposition to Plaintiff’s Motion to Strike, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).  
\end{itemize}
purpose of providing Take-Two with legal certainty and ensuring that the full case and controversy between the parties is resolved by the court.\textsuperscript{203} If the counterclaims are dismissed, Solid Oak could drop the lawsuit and, due to the uncertainty still remaining, Take-Two could face future lawsuits on the issue.\textsuperscript{204} Allowing the counterclaims would ensure the issue is decided and would provide legal certainty for Take-Two and other similar organizations going forward.\textsuperscript{205} Second, Take-Two argues the counterclaims are not mirror images of the affirmative defenses because the counterclaim includes 235 paragraphs of factual allegations accompanying the counterclaims.\textsuperscript{206} Third, Take-Two claims that the counterclaims are not redundant because they are seeking an order cancelling the copyright registration of the “Lion’s Head Tattoo Artwork,” which is something that cannot be achieved by an affirmative defense.\textsuperscript{207} Take-Two offers case law to show that “when a counterclaimant challenges the validity of the plaintiff’s intellectual property rights, related counterclaims for non-infringement should not be dismissed as redundant either.”\textsuperscript{208}

Seemingly in response to Defendant’s arguments, Solid Oak filed an amended complaint, removing the “Lion’s Head Tattoo Artwork” tattoo from the lawsuit and adding infringement claims for the NBA 2K14 and NBA 2K15 versions of the game, in addition to NBA 2K16.\textsuperscript{209} Again, Take-Two was quick to offer a response, this time by submitting a letter to the Honorable Judge Laura Taylor Swain.\textsuperscript{210} This amended complaint, Take-Two argued, was further evidence as to why their counterclaims should not be dismissed.\textsuperscript{211} Take-Two argued that the since the “Lion’s Head Tattoo Artwork” was dropped from the newest complaint, the only way to resolve the issues of \textit{de minimis} use, fair use,

\textsuperscript{203} Id. at 1.
\textsuperscript{204} Id. at 8-9.
\textsuperscript{205} Id. at 9.
\textsuperscript{206} Id. at 2.
\textsuperscript{207} Id. at 11.
\textsuperscript{208} Defendants’ Memorandum of Law In Opposition to Plaintiff’s Motion to Strike, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724[LTS](RLE) (S.D.N.Y. 2016), at 3 (citing Leach v. Ross Heater & Mfg. Co., 104 F.2d 88 (2d Cir. 1939)).
\textsuperscript{211} Id.
and fraudulent registration for that particular tattoo is through the counterclaims.212 Also, Take-Two argued that by adding the two prior versions of the game to the complaint, they are doing exactly what Take-Two referenced in their opposition brief – bringing suit from the “cloud” of mystery over the lawsuit.213 By allowing the counterclaims in this case, Take-Two argued they would be able to “clear the cloud” of uncertainty and feel confident they would not be sued for any tattoo infringement for prior or future versions of NBA 2K.214

C. Last Update on the Proceedings

On March 9, 2017, the Honorable Judge Laura Taylor Swain advised the parties that the motion to dismiss the counterclaims was still under advisement and the parties would be notified when a decision was made.215 That was the last update on the case at the time of this note.216

IV. ANALYSIS

Before diving into this issue specifically, the basics of copyright law must first be analyzed. Copyright protection exists in “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”217 There are several categories of “works of authorship,” the most relevant of which is § 102(a)(5).218 § 102(a)(5) identifies “works of authorship” as, among other things, “pictorial, graphic, and sculptural work.”219

Ultimately, this section will prove that if this case goes to trial, Solid Oak Sketches will come out victorious. The following three subsections address the

212. Id.
213. Id.
214. Id.
216. Id.
218. Id. at § 102(a)(5).
219. Id.
three major issues of the case: the ability of tattoos to be copyrighted, possible defenses for Take-Two, and the issue of damages.

A. Are Tattoos Copyrightable?

There are two parts of the tattooing process that must be looked at when determining if they are copyrightable – the flash design, which is the drawn out design of the tattoos (which is often displayed in tattoo shops), and the final inked on-skin product. The flash design is certainly copyrightable, much like any other painting or drawing. The actual tattooed, finished product is less certain. However, most scholars agree that it also meets the requirements for being a copyrightable work. The issue with tattoos is whether they are “fixed” in a “tangible medium of expression.” A work is “fixed” when “its embodiment . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” As Jennifer Commander states, “[a]s skin ages, stretches, shrinks, burns, and varies pigments, a tattoo on that changing skin morphs as well, calling into question whether a tattoo can ever be fixed.” However, in defeating this argument immediately after raising it, Commander discusses the “rather permanent quality” of tattoos. This permanent quality suggests tattoos are “fixed,” while the belief that human skin is “a tangible medium of expression” is the “consensus.”

Therefore, since tattoos are copyrightable, the owners of those copyrights are “entitled . . . to institute an action for any infringement of that particular right committed while he or she is the owner of it.” Infringement occurs

220. Id.
221. Id.
222. Id.
223. Id. at 1953.
224. Id. at 1954.
227. Id.
228. Perkowsky, supra note 177.
when anyone “violates any of the exclusive rights of the copyright owner.”\textsuperscript{230} The exclusive rights of the copyright owner include the right “to do or authorize any of the following”:

“(1) to reproduce the copyrighted work in copies or phonorecords;
(2) to prepare derivative works based upon the copyrighted work;
(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.”\textsuperscript{231}

Defendants publicly displayed the tattoos in a video game that they sold millions of copies of all over the world, without Plaintiff’s authorization, and in direct violation of § 106(5) above.\textsuperscript{232} Therefore, Solid Oak Sketches is entitled to file the complaint and sue their infringers (Defendants).\textsuperscript{233}

\textbf{B. What About Take-Two’s Defenses?}

Defendants, in their Answer to the Complaint, listed seven affirmative defenses to Solid Oak’s claims. These defenses include: (1) failure to state a claim; (2) \textit{de minimis} use; (3) fair use; (4) license; (5) consent, waiver, estoppel; (6) non-infringement; and (7) fraud on the Copyright Office.\textsuperscript{234} Although Defendant did not elaborate on these defenses, the viability of each defense can still be analyzed. Each potential defense is discussed in detail below.

\begin{itemize}
\item \textsuperscript{230} \textit{Id.} at § 501(a).
\item \textsuperscript{231} 17 U.S.C. § 106 (2002).
\item \textsuperscript{233} \textit{Supra} note 181.
\item \textsuperscript{234} Defendants’ Answer and Counterclaims, Solid Oak Sketches v. 2K Games, Inc., No. 1:16-cv-724(LTS)(RLE) (S.D.N.Y. 2016).
\end{itemize}
1. Failure to State a Claim

Failure to state a claim is not a valid affirmative defense because it is not a defense at all – it is a basis as to file a motion to dismiss. Under the Federal Rules of Civil Procedure, failure to state a claim is not an available affirmative defense under rule 12(c). Pursuant to rule 12(f), the court can strike this defense from the pleadings as insufficient.

2. De Minimis Use

Previously in this note, the definition of de minimis use was given. De minimis use means “the law does not concern itself with trifles.” As one case from the Southern District of New York put it, “if the copying is de minimis and so “trivial” as to fall below the quantitative threshold of substantial similarity, the copying is not actionable.” When determining whether the quantitative threshold of substantial similarity has been met, “courts consider the extent to which the copyrighted work is copied in the allegedly infringing work.” Here, the tattoos in question were completely copied into the video game – it wasn’t just a part of the tattoos, it was the entire tattoos. The aforementioned case also said “[t]he observability of the copyrighted work is critical, and courts will consider the length of time the copyrighted work is observable as well as factors such as focus, lighting, camera angles, and prominence.” Though it is tough to see the tattoos from the normal gameplay view, the tattoos can be seen every time the camera zooms in on the players and every time an instant replay is shown from a closer view. When these instant replays are shown, the copyrighted work can be observed for long periods of time, and this observation can have the right focus, lighting, and camera angles to make the observation of the tattoos prominent. Admittedly, this may be Take-Two’s strongest defense, but it is still not enough to defeat Solid Oak’s claim.

236. Id. (citing Fed. R. Civ. P. 12(c)).
237. Id. (citing Fed. R. Civ. P. 12(f)).
238. Inesi, supra note 184.
240. Id.
241. Id.
3. Fair Use

“[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”242 There are several factors used to determine whether a use of work is “fair” or not.243 These factors are:

“(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.”244

Congress and the courts interpret this defense through two different lenses: the private benefit approach and the public benefit approach.245 This distinction depends on the first factor above – whether the use is commercial or for nonprofit purposes.246 The private benefit approach is when the use is for purely commercial purposes; the public benefit approach is when the use is for nonprofit educational purposes.247 When the use of the copyrighted work is for purely commercial reasons (private benefit approach), courts are less likely to give deference to the defense.248 Here, since the use of the tattoos is solely to make the game more realistic, in an attempt to sell more games, the use is purely commercial.249 Next, the nature of the infringement is, as Plaintiff’s earlier described, “overtly willful.”250 Third, all of the tattoos are being copied in

243. Id.
244. Id.
245. Commander, supra note 186 at 1967.
246. Id.
247. Id.
248. See id. at 1967-68.
their entirety, not just partially. Fourth, since the game reproduced the tattoos and sold their copies all over, there is a great effect on the market of the copyrighted work. Since Solid Oak’s work has been widespread, without Solid Oak receiving credit, the value of the copyrights has been effectively nullified. This defense is not very persuasive.

4. License

A recipient of a tattoo is allowed to go out in public and display his/her tattoo due to the implied nonexclusive license granted to them by the artist. This license does not transfer any interest in the copyrighted work, but it allows the client to use the copyrighted tattoo in ways specified by the artist. This license is what saves tattoo recipients from a “parade of horribles” that would include being prohibited from appearing in photographs, removing the tattoo, getting tattoos surrounding the original work, or appearing on television. But, does this implied nonexclusive license extend to third parties such as Defendants?

Whitmill debunked this third-party-implied-nonexclusive-license theory after Warner Bros. raised it as a defense. Whitmill argues that since he never had any discussions with Warner Bros., the implied license must’ve somehow come in the form of a sublicense from the original licensee (in their case, this was Mike Tyson). This thought is quickly dismissed as having no legal support. The only issue then becomes whether the scope of an implied license involves allowing third parties to create derivative works.

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254. Id. at 1975.


257. Id.

258. Id.

259. See id.
of an implied license is determined by the conduct of the parties involved, and since Solid Oak Sketches has filed this lawsuit, their conduct clearly does not allow for third parties to use this implied license. While Defendants may try to argue that since Solid Oak did not object to the use of the tattoos in previous versions of the game, they were given an implied license to use the tattoos. However, this argument would be weak, since the reason Solid Oak did not object is because they did not yet have the copyrights for the tattoos, as those were received in 2015. Furthermore, courts tend to limit their recognition of this defense to noncommercial displays of copyrighted works. As discussed earlier, the use of Solid Oak Sketches’ tattoos by Defendants is for purely commercial purposes. Like the fair use argument, this defense is not very persuasive.

5. Consent, Waiver, Estoppel

In order to claim this defense, a defendant in a copyright suit must prove four elements: (1) the copyright owner knew of the defendant’s infringing conduct; (2) the plaintiff either expressly or impliedly consented to the defendant’s infringing act through inaction or acquiescence; (3) the defendant must be ignorant of the true facts; and (4) the defendant must rely on the plaintiff’s conduct to its injury. In this case, the first point can be proven. Obviously, Solid Oak knew of Take-Two’s infringing conduct. However, Take-Two cannot prove the second prong—Solid Oak did the exact opposite of consenting to Take-Two’s infringing acts by sending the demand letter before filing suit. Take-Two also cannot prove the third element, as they knew of their infringement due to Solid Oak’s negotiation letters and continued with the production of NBA 2K16 anyway. As for the fourth prong, Take-Two did not act on Solid Oak’s conduct—they effectively ignored Solid Oak by continuing with the production of NBA 2K16 with the tattoos still a part of the game. Since


261. Id.


Take-Two can only prove one of the four required elements for this defense, it should be quickly dismissed as having no credibility.

6. Non-infringement

The owners of a copyright have six exclusive rights: (1) the right to reproduce; (2) the right to prepare derivative works; (3) the right to distribute; (4) the right to publicly perform; (5) the right to publicly display; and (6) in the case of sound recordings, the right to perform by means of digital transmission. When one of these exclusive rights is violated, an infringement of the copyright occurs. In this case, Solid Oak’s exclusive rights in regards to 1, 2, 3, and 5 have been violated. By putting the tattoos on the virtual characters in the video game, the copyright was reproduced and a derivative work was prepared. Then, when 2K sold the game containing the recreated copyrights, they violated Solid Oak’s exclusive right to distribute the works. Finally, Take-Two violated Solid Oak’s exclusive right to publicly display by selling and advertising the game to the general public. Therefore, since four of the six exclusive rights of copyright owners are infringed upon, Take-Two cannot escape liability on this defense.

7. Fraud on the Copyright Office

While this may have been an originally valid and credible defense, it is not anymore. Since Solid Oak submitted their Second Amended Complaint (which no longer listed the tattoo that was allegedly fraudulently filed), this defense no longer matters. Take-Two does not allege fraud on the copyright office on any of the tattoos listed in this new complaint, therefore the defense is irrelevant.

C. What are proper damages?

Previously in this note, the financial demands of Solid Oak Sketches were discussed in detail. These demands took place prior to the filing of the lawsuit, with the lawsuit asking for “appropriate statutory and/or monetary damages, together with interest, reasonable attorneys’ fees, and costs incurred in [the]
action.\footnote{269} This note also previously discussed the arguments for and eventual granting of the motion to dismiss the statutory damages and attorneys’ fees.\footnote{270} So, with those remedies out of the picture, Solid Oak Sketches is now simply looking at monetary damages.\footnote{271} How much money should Solid Oak Sketches receive?

The demand letter used Escobedo’s $22,500 award that was appealed as insufficient and undoubtedly lower than the actual compensation he ultimately received in the settlement.\footnote{272} The letter also used the same amount to compute a one-time license fee.\footnote{273} As the demand letter states, these numbers are too low.\footnote{274} The “ultimate payment [to Escobedo] no doubt exceeded $22,500,” so there is also no doubt the number is too low of an indicator.\footnote{275} Even if we ignore the fact that Escobedo’s award settled for a higher amount, comparing the two is like comparing apples and oranges. Escobedo’s award came from a UFC video game, which is focused around the sport of Mixed-Martial Arts – the 10th most popular sport in the United States.\footnote{276} The NBA 2K series is focused around the third most popular American sport.\footnote{277} Furthermore, LeBron James was identified as the most popular athlete in the United States, according to a 2014 study.\footnote{278} In 2012, the year of Escobedo’s suit, Carlos Condit (the fighter who received the tattoo) was not even ranked among the top 15 most popular fighters.\footnote{279} The infringement against Solid Oak Sketches is clearly more high-profile, so consequently the damages should be higher.

\footnote{269} Id.
\footnote{271} Id.
\footnote{272} Solid Oak Sketches, supra note 210 at Exhibit B.
\footnote{273} Id.
\footnote{274} See id.
\footnote{275} Id.
\footnote{277} Id.
Furthermore, when calculating the one-time licensing fee, Solid Oak Sketches based the fee off of the players playing just four more seasons.\textsuperscript{280} Kobe Bryant (who is mentioned in the demand letter, but not in the actual suit) retired from basketball following the 2015-16 season.\textsuperscript{281} He is 37 years old.\textsuperscript{282} Using Bryant as an example, the potential remaining playing years for each of the other players named in the lawsuit can be determined (while noting it is entirely possible for players to play beyond, or retire before, they turn 37) by seeing how many years the players have until they are age 37. LeBron James is 31, so he could hypothetically have six more years of playing left.\textsuperscript{283} Eric Bledsoe is 26, leaving him with 11 years still to go in the NBA.\textsuperscript{284} Kenyon Martin has not played since the 2014-15 season, so his tattoo will not be infringed upon anymore.\textsuperscript{285} Although Martin is no longer an active player, Bledsoe and James’ potential time remaining in the NBA is far beyond the conservative four year estimate. Ultimately, the calculated damages in the demand letter are too low, and it is entirely possible the District Court for the Southern District of New York could award damages greater than those listed in the complaint.\textsuperscript{286}

V. CONCLUSION

Copyright law and its relationship to tattoos is an issue that has been brought up many times before, yet never been conclusively and definitively solved by an American court. This issue has led to the lawsuit filed by Solid Oak Sketches. The NBA 2K16 video game experienced immense success for myriad

\begin{itemize}
\item \textsuperscript{280} Solid Oak Sketches, \textit{supra} note 210 at Exhibit B. (While some may think an obvious and easy way to calculate damages would be to use the average career length of an NBA player, this number is skewed and not an accurate representation of the players infringed upon. Many players never see substantial playing time and spend a very short career on the bench, thus causing the average NBA career length to be lower than that of higher-caliber players such as the ones named in the lawsuit.)
\item \textsuperscript{281} \textit{Kobe Bryant}, ESPN, http://www.espn.com/nba/player/_/id/110/kobe-bryant (Last visited Aug. 21, 2016).
\item \textsuperscript{282} \textit{Id.}
\item \textsuperscript{284} \textit{Eric Bledsoe}, ESPN, http://www.espn.com/nba/player/_/id/4238 (Last visited Aug. 21, 2016).
\item \textsuperscript{286} \textit{See generally} Complaint for Copyright Infringement, Solid Oak Sketches v. Visual Concepts, LLC, No: 1:16-cv-00724 (S.D.N.Y. 2016) 2016 WL 445124 at Exhibit B.
\end{itemize}
reasons, though at least a portion of the success can be appropriated to the game’s featuring of realistic tattoos. The issues resulting from these tattoos provide the foundation for Solid Oak’s lawsuit. There are many other situations that have involved the tattoo/copyright issue. These situations include Chris Escobedo’s claim against video game maker THQ, Stephen Allen’s claim against a different video game maker in Electronic Arts, Matthew Reed’s claim against Nike, Victor Whitmill’s claim against Warner Bros., and finally, how Madden NFL and the NFLPA have avoided the issue altogether. Solid Oak Sketches’ claim already has an interesting history, from when they attempted to negotiate a settlement to when they ultimately lost out on statutory damages and attorneys’ fees to when they were hit with counterclaims.

Solid Oak Sketches is likely to win their lawsuit against Take Two and 2K. This conclusion was reached by looking at the overwhelming consensus that tattoos are in fact copyrightable. Additionally, Defendants are offered no adequate or credible defenses. After the case is argued, it will be shown that their claim for damages is actually low, and it would not be surprising if more damages are awarded. Video game makers, professional athletes, tattoo artists, and scholars of copyright law are, without a doubt, interested to see how this case plays out. Hopefully, this will finally be a case that goes to trial – and with the pending counterclaims, it seems that trial is a real possibility – and provides some clarity on how tattoos fit within the realm of copyright law. If the case is litigated, it is likely Solid Oak Sketches will come out victorious.
Civil procedure teachers have always faced dilemmas on classroom coverage. In the past, the chief dilemma, prompted by limited credit hour allocations, involved choices about the content and extent of coverage of written and unwritten federal civil procedure laws. Traditionally and currently, first year civil procedure courses focus on the federal constitutional Article III courts, especially district courts, and their procedures. These procedures chiefly originate in written U.S. Supreme Court rules and Congressional enactments, as well as in related and unrelated U.S. Supreme Court precedents, though there are some important local court rules and traditions. This focus has introduced students to civil procedure laws relevant nationwide; facilitated relative uniformity across state borders on how law students are trained, perhaps much prompted by bar examiners and textbook publishers; and, allowed important training on case analysis and synthesis, on statutory and rule interpretation, on inherent judicial authority, and on the fundamental role(s) of trial courts.1

Since the inclusion of federal civil procedure on the multistate bar exam (MBE) in February 2015, there are significant new pressures on civil procedure teachers to continue, if not do more, instruction on the Federal Rules of Civil Procedure, federal statutory procedural laws, and related and unrelated U.S. Supreme Court precedents. The initial set of sample test questions for the MBE exam confirm the importance to the bar examiners of such topics as federal

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1 Of course there are some variations in the materials and teaching methods generally employed in required federal civil procedure and other first-year courses. See, e.g., Jens David Ohlin, The Changing Market for Criminal Law Casebooks, 114 Mich. L. Rev. 1155 (2016) (perhaps less uniformity in classroom practice than in the past due to “changing profile of law students” and “the great diversity of intellectual perspectives that law teachers bring to the lectern”); A quite revolutionary approach to teaching civil procedure was presented by Professors Cover, Fiss, and Resnik in their course book simply titled Procedure (The Foundation Press 1988), labeled as a book on “metaprocedure” due to its inclusion of materials on civil, criminal, and agency adjudicatory procedures; See also William Eskridge, Metaprocedure, 98 Yale L. J. 945 (1989) (book review) and Mark V. Tushnet, Metaprocedure? Procedure, 63 S. Cal. L. Rev. 161 (1989) (book review) (not generally employed in law schools).
district court subject matter and personal jurisdiction, venue, pleading, choice of law, and trial (especially jury trial) processes.2

Yet there are significant new counter pressures arising from the ascending goal of graduating law students who can hit the ground running, that is, who are practice ready.3 Most recent law school graduates undertaking civil litigation will not soon-or perhaps ever-practice in the Article III federal courts, or do many trials (whether jury or bench) when there. A continuing emphasis on federal district court practices, and on trials therein, will detract from this ascending goal. Understanding of federal civil procedure laws does not make a law school graduate very practice ready for the dispute resolution work they will do in state civil litigation and in facilitating civil claim settlements.

In fact, whether yesterday, today, or tomorrow, civil litigation has been practiced primarily in state courts and other state tribunals, and, more recently, increasingly in private dispute resolution bodies rather than in Article III federal courts. There, the challenges involving subject matter and personal jurisdiction arise infrequently. In state and private adjudicatory bodies, there are also major differences between written state and federal civil procedure laws, as well between the civil litigation guidelines falling outside of any written laws. Practice ready lawyers will need some feel for these differences.

Amongst the key differences between the written civil procedure laws governing federal and nonfederal courts are the sources of subject matter jurisdiction, which are typically constitutional for the states courts;4 the requirements on the compulsory joinder of parties, far more extensive outside

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3. Compare Report and Recommendations of the Special Committee on the Impact of Law School Curriculum on the Future of the Practice of Law in Illinois, ILLINOIS STATE BAR ASSOC. 2015, at 7-8 (“Law school graduates must be equipped with practice-ready skills to succeed” and proposing “a new perspective on law school curriculum,” which would yield “a better investment on the cost of legal education” and provide more and better practice skills for new graduates”) with Daniel B. Rodriguez, Assumptions of Risk, 2014-3 AALS NEWSLETTER 1, November 2014 (flaws in push for law schools to focus on preparing practice ready students).

4. Compare, Ill. Const. art. VI, 9 (circuit courts have original jurisdiction over “all justiciable matters,” though they may only “review administration action as provided by law”) with U.S. Constitution Art. III, I (Congress ordains and establishes federal trial courts, though only federal question or diversity cases may be vested in these courts). See also Jeffrey A. Parness, “Failed or Uneven Discourse of State Constitutionalism?: Governmental Structure and State Constitutions,” 5 St. Thomas L. Rev. 155, 158-159 (1992).
federal district courts;\textsuperscript{5} the existence of differentiated procedures in states for so-called common law claims, like personal injury claims arising from accidents, and statutory causes of action, as with probate, adoption, juvenile delinquency and marriage dissolution;\textsuperscript{6} the work product and attorney-client communication privileges, often far more limited outside federal courts;\textsuperscript{7} and, the more extensive nonfederal norms on standardized interrogatories,\textsuperscript{8} mandated jury instructions,\textsuperscript{9} and form pleadings.\textsuperscript{10}

Amongst the important differing civil litigation guidelines for state courts outside written civil procedure rules and codes are the processes for handling nonparty claims, including lienholder\textsuperscript{11} and other subrogation interests;\textsuperscript{12} the

\begin{itemize}
\item \textsuperscript{5} See Penn. S. Ct. Rule 2228 (husband and wife to enforce related non-death, personal injury claims “in one action,” as should minor and parent(s)) and Wis. Stat. Ann. § 803.03(2)(a) (compelled joinder of all persons who have related claims involving subrogation, derivative rights, or assignments).
\item \textsuperscript{6} See, e.g., Strukoff v. Strukoff, 389 N.E.2d 1170, 1172-3 (Ill. 1979)[where statutes address civil case procedures not subject to the general common law or equity powers of constitutionally-created courts, courts have less or no “inherent power” and General Assembly authority is greater]; In re Adoption of Baby Boy Martindale, 940 S.W.2d 491, 493 (Ark. 1997)[adoption proceedings are “special” and not wholly governed by general civil procedure laws]; and Rule 1-001 of N.M. Rules Civ. Pro. for District Courts (committee comment describes special cases, including probate, adoption, condemnation, election contests, and zoning).
\item \textsuperscript{7} See, e.g., III. Sup. Ct. Rule 201(b)[unlike FRCP 26(b), this rule only protects opinion work product from compelled disclosure, meaning no access to materials if they “contain or disclose the theories, mental impressions or litigation plans of the party’s attorney”) and Consolidation Coal Co. v. Bucyrus-Erie Co., 432 N.E. 2d 250 (Ill. 1982)[adopting “control group” test for assessing who are clients where corporation retains an attorney, thus rejecting the federal approach in Upjohn v. U.S., 449 U.S. 383 (1981), utilized in The Manitowoc Co., Inc. v. Kachmer, 2015 WL 1746552 (N.D. Ill. 2016)[audio recordings of company employees by company attorney are discoverable by employees over company’s objections].
\item \textsuperscript{8} See, e.g., III. Sup. Ct. Rule 213(c) (recognizing Supreme Court power to adopt “standard forms of interrogatories “which have their own special numerical limits; today, there are standard interrogatories for motor vehicle, matrimonial and medical malpractice cases).
\item \textsuperscript{9} See, e.g., III. Sup. Ct. Rule 239(a) (an Illinois Pattern Jury Instruction “shall be used, unless the court determines that it does not accurately state the law”).
\item \textsuperscript{10} See, e.g., Rule 7.2(a) of Rules of Solano County, California Courts (“Printed forms of petitions, orders and other documents which have been approved or adopted by the Judicial Council shall be used in all cases where applicable”) and “Circuit court forms,” on Wisconsin Supreme Court website at www.wi.courts.gov/forms1/circuit/index.htm (declaring: “standard, statewide forms are required by all Wisconsin circuit courts for civil, criminal, family, guardianship, juvenile, mental commitment, probate and small claims cases”).
\item \textsuperscript{11} See, e.g., 770 ILCS 5/0.01 (Attorneys Lien Act).
\item \textsuperscript{12} See, e.g., 770 Ill. Comp. Stat. Ann. 23/5 and 10 (subrogation interests pursued through Health Care Services Lien Act). Written state civil procedure laws are not themselves uniform on
limits on informal fact investigation, both before and after civil litigation has commenced;\textsuperscript{13} and, claim and issue preclusion standards.\textsuperscript{14}

Furthermore, increasingly civil litigation occurs in state agencies and specialized state tribunals with no significant counterparts within the federal civil litigation fora, as with worker’s compensation.\textsuperscript{15} And increasingly, much civil litigation occurs in private dispute resolution bodies where again the procedures are significantly different than those operating in Article III federal courts. Consider compulsory and binding arbitrations,\textsuperscript{16} which are sometimes even mandated by state laws regardless of party consent, as with certain insurance claims.\textsuperscript{17} Practice ready lawyers need some familiarity with these civil litigation bodies, even though their practices will not be tested on the MBE.

As well, whether yesterday, today, or tomorrow, civil claim dispute resolution is primarily driven by civil claim settlement norms. Here, as with trial preparation and trial practice, there are significant differences between the general norms in Article III federal courts, American state tribunals, and private adjudicatory bodies. Further, there are often special settlement norms operative in state tribunals as well as in private civil dispute resolution bodies. Practice ready students need some familiarity with these settlement norms addressing such matters as the roles played by insurers; lawyer civil claim joinder of subrogation interest. \textit{Compare, e.g.}, Mississippi Civil Procedure Rule 17(b)(where “subrogor still has a preliminary interest in the claim the action shall be brought in the names of the subrogor and the subrogee”) to 735 Ill. Comp. Stat. Ann. 5/2-403(c)(any subrogation action “shall be brought either in the name or for the use of the subrogee”).

13. See, \textit{e.g.}, Illinois Rule of Professional Conduct 4.2 (lawyer generally shall “not communicate.. . with a person the lawyer knows to be represented by another lawyer”).

14. See, \textit{e.g.}, Hudson v. City of Chicago, 889 N.E. 2d 210 (Ill. 2009)(notwithstanding voluntary dismissal statute, res judicata bars refiled claim presented within the time limits of the voluntary dismissal statute).

15. There is a worker’s compensation scheme applicable to certain federal employees, but it is far less expansive than state worker’s compensation schemes. \textit{Compare, e.g.}, 33 U.S.C. 901 et. seq. (“Longshore and Harbor Workers’ Compensation Act”) with Iowa Code 85.1 et. seq. (limited exceptions of employees from workers’ compensation scheme).

16. 9 U.S.C. § 2 (a written contract to settle by arbitration a controversy is “valid, irrevocable and enforceable, save upon such grounds as exist at law or in equity for the revocation of any contract); Allied-Bruce Terminex Cos. v. Dobson, 513 U.S. 265, 281 (1995) (“states may regulate contracts, including arbitration contract clauses, under general contract law principles,” but may not have, per federal preemption anti-arbitration policies).

17. See, \textit{e.g.}, Reed v. Farmers Ins. Group, 720 N.E.2d 1052 (Ill. 1999) (upon challenge on state jury trial right grounds, upholding statute, 215 ILCS 5/143a, requiring binding arbitration for certain uninsured motorist coverage claims).
settlement authority; the requirements for valid civil claim settlement contracts; the effects of partial settlements on later civil litigation, including the impact of collateral sources and empty chairs; and, the means for addressing civil claim settlement breaches.

Federal civil litigation practices, future bar exams, and the realities of nonfederal civil litigation may not all be able to be simultaneously pursued vigorously in required law school civil procedure courses. There are often insufficient credit allocations and a wide breadth of expected coverage. How can basic civil procedure teachers better prepare students for the challenges posed by contemporary nonfederal civil dispute resolution while also insuring familiarity with Article III federal court practices?

Civil procedure teachers can utilize problems in the first year courses based on procedural laws that are markedly different in Article III federal courts and state tribunals, as well as in the many different state tribunals; exercises on practical issues arising during civil claim settlements; materials on the roles of insurers, noninsurance lienholders, and other interested nonparties (like expert witnesses) in civil cases; and, exercises on the roles of alternative governmental adjudicatory bodies and private civil claim decisionmakers.

Significant alterations in coverage and approach in the basic civil procedure courses in the foreseeable future may be unrealistic, however. Changes may be difficult to implement since many law students do not care as they will not become civil litigators. National bar examiners will remain likely unconcerned with non Article III dispute resolution practices and with civil claim settlement norms. Most future law students will take bar exams which even more narrowly approach civil dispute resolution issues than in the past, given the ascent of the Uniform Bar Exam and the 2015 change in the MBE. So how might upperclass students interested in civil litigation become more practice ready through elective courses, even if those courses do little for bar exam preparation purposes?

Local and regional law schools can offer civil procedure electives which focus on in-state, and perhaps neighboring state, civil dispute practices, with emphases on the major differences with Article III federal district court


litigation. Similar electives at national law schools can focus on major differences between these same federal courts and the general practices of the varying state tribunals across the nation, if not the world. These suggestions offer little that is new. Such elective courses are prevalent, particularly in local and regional schools, though often offered by adjuncts whose choices on course contents and teaching techniques are not always subject to significant institutional oversight or direction, and thus to coordination with the basic civil procedure course(s). So what else might be done to better prepare practice ready law school graduates who are more able to undertake civil claim resolutions guided chiefly by state laws, both in and outside of litigation?

An intradisciplinary, elective course on civil claims settlements could be offered where the focus would be on the major legal guidelines for amicable civil claim resolution. Such guidelines, of course, encompass issues arising in and outside of litigation. They include norms on partial preclaim settlements, which can be procedural (like those addressing compulsory and binding arbitration and choice of forum) or substantive (like those addressing liquidated damages and waivers of negligence claims).

Such an elective course on civil claim settlements should, at the least, be intradisciplinary in that it addresses guiding U.S. and state legal norms from varying lawmakers, including those who formulate general civil procedure, professional responsibility, tort, contract, privacy, and tax laws, as well as those who formulate special laws applicable to civil claim settlements in discrete arenas like civil rights, professional malpractice, product liability, employment, pollution, auto accidents, defamation, probate, and real estate. More ambitious would be an interdisciplinary and international course that includes materials on psychology, economics, and the like that are important to amicable civil dispute resolution, as well as comparative U.S. and foreign legal procedures guiding civil claim settlements.

A course on civil claim settlements could also include teaching materials that reverse traditional course texts in that they invite initial student discussion on major issues through problems that do not identify the types of relevant guiding laws. Later class materials could then provide some of the black letter laws.

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20. A brief chapter outline for these follow up materials, which are based on a chapter outline of a book the author has under contract with Lexis Nexis, appears in Appendix One. A more complete outline is available from the author at jparness@niu.edu
For example, in the very first class there could be a general discussion of how contract law principles might differ for civil claim settlements, criminal case plea bargains, and widget purchases. A follow up class could include a review of comparative laws. This follow up class could, as well, focus more particularly on the roles of lawyers as agents representing clients who settle civil claims (both before and after litigation); who plead guilty or nolo contendere in criminal cases; and who buy widgets.

In a later class, there could be a more nuanced discussion of how basic contract law principles might themselves differ for varying types of civil claim settlements, which themselves may vary between in-court and out-of-court pacts, or between presuit and postsuit pacts. The later class could, for example, examine the differences in contracts resolving civil rights, marriage dissolution, and auto accident claims or cases. The contract laws for settling these types of civil claims and cases vary significantly. One type often has issues of governmental misconduct; another type frequently has issues of child welfare; and the third type often contains issues involving contingency fee agreements.

In another later class, there could also be a general discussion of a problem involving confidentiality pacts on settlements of sexual abuse or pollution claims, with the next class focusing on the guiding laws. In these classes there could be an initial review of how churches might structure settlements with the alleged child abuse victims and their families, or how oil companies might approach the consequences of oil spills. In a follow up class, comparative laws demonstrating the differences in public access to civil, criminal, and regulatory adjudicatory proceedings could be examined, including any differences in access to prelawsuit and lawsuit settlements.

And in another later class, there could also be an initial discussion of a problem focusing on the roles of presiding adjudicators, be they judges or alternative dispute resolution officials, in facilitating settlement pacts. In a follow up class there could be explored the differences in the laws guiding civil, criminal, and private case adjudicators, including variations in their settlement enforcement, including sanctioning, authority.

Of course, an interdisciplinary civil claim settlement course could be narrowly tailored, as with a course addressing the roles of insurers and other indemnitors in civil dispute resolution. Here auto insurers and property insurers might be compared, as might private insurance companies, private employers with vicarious liability for at least some of their employees’ acts, and governmental bodies with statutory, ordinance, and/or contractual indemnification responsibilities germane to at least some of their officers’ acts. A somewhat broader, though not comprehensive civil claim settlement course could encompass the roles of nonparties in civil dispute resolution, so as to include not only indemnitors tied to defending parties, but also those with
subrogation, reimbursement, lien and similar interests tied to the recoveries by claimants.

Comparable intradisciplinary domestic, if not interdisciplinary and international, elective law school courses can also be devised. For example, consider a course on the varying legal consequences, both substantive and procedural, flowing from negligent conduct, intentionally bad acts, or both. Here, there could be review of criminal, regulatory, tort, contract, and professional licensing laws, as well as of the variations in the applicable dispute resolution processes and in the procedural due process demands. A more narrow course could address negligence, as with negligent driving; negligence by those acting in a professional capacity; negligence in product design, manufacture and sale; or negligence in parental childcare. Alternatively, there could be an even narrower course, focusing on entity responsibility (i.e., to prevent) and liability (i.e., to compensate) for the negligent actions of its agents/employees in varying settings, including contracts, business licensing, crimes, civil rights and litigation sanctions.

In other intradisciplinary law school elective courses, as with a civil claim settlement course, issues could first be generally introduced and then followed by a review of the relevant laws, even if the laws are of diverse types and pigeonholed elsewhere in the curriculum.

Particularly with more narrowly focuses courses, like a course on the roles of insurers in civil litigation or, more narrowly, the roles of insurers in defending insureds before and during civil litigation, even a two credit hour allocation may be unwarranted. Shorter courses could be offered during only a portion of an academic semester or quarter, with other shorter courses possibly piggybacked into the law school schedule. There are benefits in more focused and shorter courses, including accommodations within a particular law school community of long-established law review, moot court, and clinical course schedules demanding intense, albeit brief, student time commitments. Shorter courses could also meet regularly early in a term and then reconvene later, with later classes focused on student projects completed in the interim. Here, in-depth student research projects would allow each student to help other students think outside the boxes of pigeonholed courses.

Whether intradisciplinary and domestic, or interdisciplinary and international, new elective law school courses on civil claim settlement are well-suited to provide more advanced skills training. Exercises involving interviewing, negotiating, drafting, and/or advocating can be easily incorporated. Here, unlike at least some other skills training courses, like pretrial civil practice or trial advocacy, many diverse laws could also be introduced in ways that break the molds operating in other (and particularly in first year) law school classes. Clients do not neatly present just contract law issues, or just property law issues,
or just tort or criminal law issues, or just procedural rather than substantive law issues. Lawyers must listen and determine which lawmakers and which laws are most relevant in helping to resolve their clients’ problems. To become more practice ready, law students should have more experiences in which they are challenged to sort and assess varying lawmakers and legal doctrines applicable to varying client needs.

APPENDIX ONE

PRINCIPLES GUIDING CIVIL CLAIM SETTLEMENTS

Table of Contents
I: Introduction to Civil Claim Settlement Laws
II: Settling Procedural Law Issues Before Civil Claims Arise
III: Settling Substantive Law Issues Before Civil Claims Arise
IV: Civil Claim Settlement Talks Before and During Litigation
V: Authority to Settle Existing Civil Claims Held By or Pursued Against Individuals
VI: Authority to Settle Existing Civil Claims Held By or Pursued Against Entities
VII: Contractual Requirements for Civil Claim Settlements
VIII: Nonparty Interests in Civil Claim Settlements
IX: Effects of Partial Settlements on the Viability of Remaining Claims
X: Effects of Partial Settlements on Later Trials and Other Adjudicatory Hearings
XI: Secrecy of Civil Claim Settlements
XII: Enforcing Civil Claim Settlements
XIII: The Later Effects of Civil Claim Settlements