Supreme Court Strikes Down Prohibition of Registration of Immoral or Scandalous Trademarks on First Amendment Grounds

BY DAVID E. FINK AND SARAH E. DIAMOND

On June 24, 2019, the US Supreme Court issued its highly anticipated opinion in Iancu v. Brunetti, holding that the Lanham Act’s prohibition on the registration of “immoral” or “scandalous” trademarks violates the First Amendment.¹

In 1990, Erik Brunetti, an artist and entrepreneur, founded the streetwear clothing line FUCT (pronounced as four letters, one after the other: F-U-C-T).² Brunetti attempted to register the FUCT trademark in order to protect its value. The US Patent and Trademark Office (PTO), denied his application for registration, concluding that because it was phonetically equivalent to the “past participle” of “a well-known” vulgarity, registering the FUCT trademark would violate Section 1052(a) of the Lanham Act, which prohibits trademark protection for immoral, shocking, offensive, and scandalous marks. After exhausting his remedies in the PTO, Brunetti brought a First Amendment challenge to Section 1052(a) in the Court of Appeals for the Federal Circuit. That court invalidated the “immoral or scandalous” clause. In a 6-3 opinion, the Supreme Court affirmed the Federal Circuit’s decision, holding that the prohibition of immoral or scandalous trademarks infringes the First Amendment because it disfavors certain ideas. The Court’s majority opinion, joined by both liberal and conservative justices, made clear that the government cannot discriminate against “ideas that offend.”³

The Brunetti opinion comes on the heels of the Court’s 2017 decision in Matal v. Tam, in which the Court invalidated neighboring language in Section 1052(a) that bars the registration of marks that “disparage any person, living or dead.”⁴ In both Tam and Brunetti, the Court determined that Section 1052(a) of the Lanham Act permits the PTO to discriminate on the basis of viewpoint in violation of the First Amendment. Together, the Court’s rulings in Tam and Brunetti mean that, absent the passage of new legislation, the PTO will no longer have a statutory basis to refuse federal registration of any trademark for being potentially vulgar, profane, offensive, disparaging, or obscene.

Continued on page 16
Defending the Traditional Media in the Fake News Era

BY DAVE GILES

It seems as though every time a news-cast rolls around today, the onslaught against the media grows. Cries of “fake news” appear to intensify with each new politically fueled controversy, often including threats of litigation against the Fourth Estate.

Rants of fake news against the mainstream media have certainly been hard to ignore since the 2016 presidential campaign. An unscientific Google search of the term turned up more than one billion hits. Though this term has been around longer than many of us would suspect, few talked about it before the 2016 presidential election. Since then, use of the term has exploded to the top of our national debate—or perhaps “shouting contest” would be more accurate.

Still, some optimistic signs are emerging that the judiciary is holding steady in support of a free press. Earlier this year, Judge Matthew Leitman in the Eastern District of Michigan granted summary judgment to WXYZ-TV, our Scripps station in Detroit, in a hotly contested public official libel case. The win was important. Judge Leitman took the opportunity to reinforce the key role the press plays in our democracy. He opened his opinion by stating: “Now more than ever we depend upon the ‘free press’ to ‘awaken public interest in government affairs’ and to ‘expose corruption among public officers and employees.’ Indeed ‘[t]he press plays a unique role as a check on government abuse’ and serves ‘as a watch dog of government activity.’” This reaffirmation of core First Amendment values is a breath of fresh air amid the persistent threats to an independent media. It’s refreshing to see that not all public officials—and especially gatekeepers of the First Amendment—see our clients as “enemies of the people.”

It is clear from the Covington Catholic free-for-all that cries of fake news won’t subside any time soon. It’s also clear from Judge Leitman’s opinion that not everyone who matters will be swayed by the fake news claims. These two very disparate developments prompted me to consider whether the fake news juggernaut has or should affect how we defend libel suits against our media clients. While I’m not intending to definitively answer that question—or to wade too far into the fake news jungle—the idea of how the rise of the term affects our work is worth more discussion among our members.

As is often the case, history provides some perspective. If you were to ask your average Twitter addict when claims of “fake news” began, many would point to two parallel recent phenomena, both coming into sharp focus during the 2016 presidential election: criticism of legitimate mainstream media as “fake news” and the propaganda-filled postings of blatantly false news on Facebook and other social media sites by bogus websites in an attempt to influence public opinion. (Remember, according to one post during the campaign, the Pope was set to announce that he was endorsing Donald Trump.)

But claims of false news reporting did not start with President Number 45. Rather, they date all the way back to Numbers 2 and 3—John Adams and Thomas Jefferson. “Nothing can now be believed which is seen in a newspaper,” Jefferson once wrote. “Truth itself becomes suspicious by being put into that polluted vehicle.” While it sounds like a presidential tweet, the quote comes from an 1807 letter from Jefferson, an avowed advocate for a free press. But we also might point the finger at President Trump if we were to read that a sitting president had observed: “There has been more new error propagated by the press in the last ten years than in an hundred years before.” Trumpian in its exaggeration, that, however, was John Adams in 1798. And during the Civil War, Union General William Tecumseh Sherman famously said, “If I had my choice I would kill every reporter in the world, but I am sure we would be getting reports from Hell before
breakfast.”

Any curious historian can find examples of false news stories infiltrating the public consciousness and conning many news consumers. Notable examples include the New York Sun’s Great Moon Hoax of 1835 when the newspaper reported an astronomer had discovered life on the Moon; the New York World’s 1898 reporting that the Spanish blew up the US battleship Maine in Havana Harbor; and Orson Welles’s infamous War of the Worlds broadcast. Of course, the media of those times bore scant resemblance to the modern professional organizations we all know. Ironically, the modern generations of reporters whom General Sherman wanted to kill are now embedded with the military.

But actual fake news does occasionally rear its ugly head. In 1982, Janet Cooke of The Washington Post returned a Pulitzer Prize and resigned after her feature about the life of an eight-year-old heroin addict living in Washington, D.C., was revealed to be false. And The New York Times fired Jayson Blair for plagiarizing and fabricating details in dozens of stories. And then there are the supermarket tabloids—talk about fake news, with headlines including “Man Gives Birth to Healthy Baby Boy,” “Satan Captured by G.I.s in Iraq,” and “Severed Leg Hops to Hospital.”

While fake news was neither invented during the 2016 election nor coined by Trump, its use has intensified since the 2016 election. According to The Columbia Journalism Review, the Collins Dictionary named “fake news” the word of the year in 2017, and CJR reported that use of the term had increased some 365 percent since the 2016 election. But what exactly does the term mean? The devil here is in the definition. In an interview, 60 Minutes producer Guy Campanile defined the term as follows: “‘S’stories that are fabricated out of thin air. By most measures, deliberately and by any definition that’s a lie.” The Cambridge English Dictionary defines it as “false stories that appear to be news, spread on the internet or using other media, usually created to influence political views or as a joke.”

That’s all fine, and if the use of the term ended there, we’d likely not need to pursue this discussion. But the term has been, according to some, “weaponized.” As we hear these repeated broadsides, we are reminded of Humpty Dumpty telling Alice in Through the Looking Glass: “When I use a word it means just what I choose it to mean—neither more nor less.” In just his first year in office, Trump used the term “fake” over 400 times, frequently in the context of attacks on the mainstream media—and often accompanied by the phrase “enemy of the people.” In a recent interview with the New Yorker about his excellent new book Truth in Our Times, David McCraw, Deputy General Counsel of The New York Times, criticized the “dark genius” of the term as inducing people to disregard facts or critical thinking in favor of labels. The president’s main targets seem to be the tent poles of the mainstream media: CNN, The New York Times, The Washington Post, ABC, MSNBC, NBC, and CBS. Recently, New York Times publisher Arthur Sulzberger met with President Trump to attempt to explain the harm such nihilistic rhetoric does to the nation. The relief was fleeting: Shortly after the meeting, the president labeled the Times “a true enemy of the people.”

There have been polls, focus groups, academic articles, and debate about the effect on the public of this and other blasts from the Tweeter in Chief. There also have been efforts to help readers and users wade through the morass to parse fact from fiction. The Knight Foundation recently donated $5 million to the nonprofit News Literacy Project (www.news-lit.org), which endeavors to educate students about how to separate objective news from disinformation.

Trying to interpret these results is more work for a social scientist than a lawyer, but a news outlet and its counsel can find both comfort and concern in the data. On the positive side are suggestions that the fake news accusations resonate only with those already inclined to distrust the media and that some participants labeled the president himself as a source of fake news. On the worrisome side are the results of a 2016 Gallup poll that found trust in journalists had reached an all-time low: Only 32 percent of Americans indicated they trusted mass media. But there is hope even there: A Gallup poll in 2018 showed the number had grown to 45 percent. And this data must be considered historically: Trust in the media peaked in the late 1970s (with 72 percent of Americans indicating they trusted the media) before declining quickly and has in fact not exceeded 55 percent since the late 1990s. In other words, distrust of the media is nothing new.

So, we know President Trump has cheered on Covington Catholic student Nicholas Sandmann in his lawsuits against The Washington Post and his arch nemesis, CNN, and continues his fake news and enemy of the people broadsides against the mainstream media. And we can surmise that while he is doing this, he may be contributing to the erosion of trust in the media.

With that as a backdrop, how do we defend libel claims? Some of my overall thoughts follow:

• The more things change, the more they stay the same. There is probably no plaintiff’s lawyer who could resist the opportunity to plug in to the “fake news/enemy of the people” amplifier. Plaintiff’s lawyers have for decades been describing the defendant(s) as shoddy journalists, yellow journalists, liars, incompetents, biased, unethical, driven by an agenda, and on and on. If the judge hearing the case has some anti-media bias, but not enough for a recusal motion, adding “fake news” to the litany is not likely to make a material difference. Or if the judge is completely neutral or has a pro–First Amendment leaning, all the shouting in the world about fake news is going to fall on deaf ears.

• When the case proceeds to jury, there are, of course, further considerations but also startlingly new. Motions in limine and voir dire should address many problems. If you make the motion and lose, it may well incentivize plaintiff’s
Communications Lawyer

Summer 2019

Counsel to double down on any fake news theme. Also, judges may well be hesitant to order that a term (fake news) cannot be used in arguments. Is it any different for a lawyer to argue that the publication is irresponsible, despicable, one-sided, unethical, malicious, or any other adjective in the plaintiff lawyer’s thesaurus than to say it is fake news? That is a tough argument for a defendant. But if the lawyer thinks plaintiff’s counsel will argue that your client has been identified by the president of the United States as an enemy of the people that publishes fake news (especially if the defendant is one of his regular targets), then the lawyer may want to get some ground rules set before trial through a motion in limine.

- Voir dire remains the mechanism to delve into potential prejudices or suggest material for possible peremptory challenges, including the fake news issue. Many media defense lawyers have routinely sought voir dire as to what newspapers, magazines, and radio or television programs the prospective jurors read, listen to, or view. In today’s terms, that would, of course, include websites, blogs, Twitter feeds, Facebook pages, news sites, podcasts, and other forms of new media. Given the explosion of focused—often partisan—sites, this inquiry should be even more informative. What this inquiry has always sought to ascertain is how the prospective juror consumes news. The answer to those inquiries along with demographic and background information on the jurors can likely give the defense attorneys enough information on the juror to make a guess as to that juror’s potential leanings. And today it could give the defense some pretty good insight into the juror’s receptiveness to shouts of “fake news.”

- Finally, defense lawyers will do what they have always done: focus the jurors on the case before them. A jury trial is not the time for First Amendment lectures or worrying about what is happening in Washington, DC. Good lawyers have always personalized their clients to tell their story. If done well (and supported by the hand the lawyer’s been dealt), claims of fake news should not affect the outcome.

In other words, the fundamentals still apply even as technology and partisan discourse created a new world for us.

Much gratitude to Jim Stewart, Len Niehoff, and Andy Pauwels of Honigman Miller for their zealous defense of WXZY-TV in the decision cited, as well as their significant contributions to this column.
Special Analysis of the May 2019 Superseding Indictment of Julian Assange

BY GABE ROTTMAN

On May 23, 2019, a federal grand jury in the Eastern District of Virginia returned a superseding indictment against Wikileaks founder Julian Assange. The indictment adds 17 counts under the Espionage Act, a 1917 anti-spying law, to the one count of conspiring to violate the Computer Fraud and Abuse Act (CFAA) that the government unsealed on April 11, 2019.

In the Reporters Committee for Freedom of the Press’s initial analysis of the CFAA case, we observed that the government’s theory would be difficult to apply to trained investigative reporters operating in a newsroom environment with access to experienced legal counsel because it’s hard to see such reporters would agree to hack a password for another user’s account on a government network. We did, however, caution that investigative reporters could try to hack passwords with respect to data that they own, possess, or control, and that should never be the basis of a CFAA charge.

The superseding indictment adds an unprecedented level of complexity to the First Amendment issues in the case. The analysis below answers eight of the frequently asked questions this development raises. It then offers commentary on specific elements of the superseding indictment.

Frequently Asked Questions

Is There Any Precedent for This?
The government has only twice brought Espionage Act charges against nongovernment third parties, most notably in the 2005 prosecution of two employees with the American Israel Public Affairs Committee (AIPAC) for allegedly conspiring with Pentagon analyst Larry Franklin to receive and disseminate classified information about Iran. One of those AIPAC employees, Steven Rosen, was charged with both conspiracy and aiding and abetting the crime by helping Franklin fax a document to Rosen’s home. The charges against Rosen and the other employee, Keith Weissman, were ultimately dropped after U.S. District Judge T.S. Ellis, who sits in the Eastern District of Virginia, interpreted the Espionage Act to require an evidentiary threshold for the government’s case that would have been difficult to prove. The other case was the 1971 Espionage Act prosecution of Daniel Ellsberg’s friend Anthony Russo for helping Ellsberg copy the Pentagon Papers, but that case fell apart because of prosecutorial misconduct.

Counts 2 through 14 in the Assange indictment, all of which are predicated on Assange coordinating with Manning on the receipt and publication of classified documents, are similar to the aiding and abetting charges against Rosen. They allege direct violations of several parts of §793 of the Espionage Act along with a violation of 18 U.S.C. §2, which permits someone who aids, abets, counsels, commands, induces, or procures, or “willfully causes,” an offense to be committed to be punished as the principal offender.

But counts 15 through 17 are different. This is the first time the Justice Department has ever successfully obtained an indictment from a grand jury with Espionage Act charges based exclusively on the act of publication (what we’re calling “pure publication” as it is distinct from either conspiring with a source or aiding and abetting the illegal acquisition of classified information). The Reporters Committee addressed these “pure publication” charges in a detailed analysis on Lawfare.

As a point of reference for those who might want to situate the Assange case historically, the Reporters Committee maintains an ongoing survey of federal media leak cases, which it updates regularly.

Based on our investigation, there have been four cases where charges against members of the news media for “pure publication” were contemplated but never brought. These four matters—Stanley Johnson, Amerasia, Operation Holystone, and Operation Ivy Bells—are discussed in our survey.

Also worth emphasizing is that the Pentagon Papers case was an attempt to block, not punish, publication, though the Justice Department investigated reporters for possible Espionage Act violations and, as noted, unsuccessfully prosecuted the leaker, Daniel Ellsberg, and his friend, Anthony Russo. Ellsberg was an employee with government contractor RAND Corporation, while Russo, a private citizen, helped him copy the papers.

Ellsberg and Russo were tried together, and charges were dropped after revelations that the “Plumbers,” the Nixon administration’s ad hoc leak-hunting unit, had burglarized Ellsberg’s psychiatrist’s office. It also came out during the trial that the judge overseeing the case had met with senior Nixon officials and had discussed his possible nomination to head the FBI.

Does It Matter If Julian Assange Is a Journalist?

No. The First Amendment covers everyone. If, for instance, a private citizen had received the Pentagon Papers, recognized their newsworthiness, and published them in a small-town newsletter, the epic 1971 Supreme Court ruling rejecting the government’s injunction should not have turned out differently. The First
Amendment also covers noncitizens such as Assange.

Furthermore, there is no journalist carve-out in the Espionage Act. It applies to anyone who obtains or discloses national defense information. So, answering the question of whether Assange is a journalist is immaterial in this regard. Indeed, given the risk in permitting the government to determine who is or is not a journalist, advocates of Espionage Act reform often argue for a new protection that would not turn on that question but would create a “public interest defense” that would protect those who disclose information about, among other things, government misconduct.

That said, there are important practical and ethical differences between Assange and national security reporters, and they should not be minimized. For instance, The New York Times, which received and reported on the same material exfiltrated by Chelsea Manning, omitted the names of informants and, at the request of the government, asked Assange to do the same. But nothing in the text of the Espionage Act turns on those practical or ethical distinctions, and they would be impossible to articulate in law without opening the door to inconsistent and possibly selective application, including against news entities.

**Do Justice Department’s Claims that Assange Put Informants at Risk Change Things?**

Endangering informants isn’t a specially protected subset of national security harm. Rather the government can make broad claims of national security harm going beyond just the naming of informants. In the Wikileaks case, for instance, the Defense Department’s response to the publication of reports from the Iraq War focused first on how the release could encourage additional disclosures, in addition to endangering coalition forces and Iraqis and Afghans working with them. The official statement from the Pentagon on October 22, 2010, began, “We deplore Wikileaks for inducing individuals to break the law, leak classified documents and then cavalierly share that secret information with the world, including our enemies.”

Under the plain terms of the Espionage Act, the government always could have prosecuted Assange, or The New York Times, or Der Spiegel, or The Guardian, irrespective of whether they redacted the names of informants. Rather, the government, until now and as a matter of prosecutorial discretion, has largely refrained from using the Espionage Act against a nongovernment third party (with the only exceptions being AIPAC’s Rosen and Weissman, and Russo in the Pentagon Papers case).

Again, however, none of this is to minimize the potential for harm caused by the publication of informants’ names. But the decision not to redact those names is an ethical distinction, not a legal one.

**Will This Go To Trial, And, If So, When?**

It is unclear, but it could take several years, if it happens at all. On May 1, 2019, a British court sentenced Assange to 50 weeks in prison in the United Kingdom for failing to appear in court seven years ago when he took refuge in the Ecuadorian embassy. Additionally, the Swedish government has reopened its investigation into alleged sexual assaults by Assange and mentioned that it could bring a new extradition request. If so, the British home secretary would have to decide which request takes precedence and would base his decision primarily on which is the more serious crime.

Additionally, the US-UK extradition treaty does not permit extradition for “political offenses.” The treaty specifies that a series of violent crimes, like kidnapping, will not constitute “political offenses,” but none of those are charged in the Assange superseding indictment. And, notwithstanding these carved-out offenses, even they will be non-extraditable if the relevant authority determines the prosecution was politically motivated. Spying and treason are widely understood to constitute “political offenses.”

**What’s the Possible Penalty?**

Assange is facing 17 charges under the Espionage Act, each punishable by up to ten years in prison. It is true that another provision in the Espionage Act, 18 U.S.C. § 794(b), permits the death penalty based solely on the “elicitation” and “publication” of “any—information relating to the national defense, which might be useful to the enemy” in a time of war. That is not part of this case.

*Why is Assange Being Charged Under the Espionage Act Now?*

As part of the countries’ extradition agreement, the US was under an obligation to present all of the charges that could form the basis for extradition within sixty days of the request. On May 24, 2019, The Washington Post reported that the case against Assange had been explored and dropped by the Obama administration, in large part because of concerns for how it could impact press freedom.

The Washington Post story noted that Attorney General Jeff Sessions, who announced a crackdown on leakers in August 2017, asked the U.S. Attorney’s Office for the Eastern District of Virginia to take another look at the case.

The Washington Post also reported that two prosecutors disagreed with bringing charges because of the difficulty of distinguishing between the receipt and publication of the Manning material by Wikileaks and the receipt and publication of that material by news outlets. According to the Post: “Part of the concern among Justice Department veterans was that prosecutors had looked at the same evidence for years during the Obama administration and determined such charges were a bad idea, in large part because Assange’s conduct was too similar to that of reporters at established news organizations.”

The statute of limitations on the Espionage Act charges is 10 years.

*Does the First Amendment Apply to the Publication of Government Secrets?*

In 2001, the U.S. Supreme Court decided Bartnicki v. Vopper, which held that federal and state wiretapping laws could not constitutionally
be applied against a radio host for broadcasting illegally intercepted conversations, so long as the host was not involved in the illegal interception.

Subsequent cases have affirmed First Amendment protections for journalists who publish lawfully acquired material, even if that material was illegally acquired by a source. Although these cases do not involve the Espionage Act—because the government has never tried to prosecute someone for the pure publication of classified information—we would argue that the government must allege that Assange did something in coordination with Manning that takes him out of these long-standing protections for the publication of truthful information. The indictment’s general allegations begin with three primary claims against Assange: that he “encouraged sources to (i) circumvent legal safeguards on information; (ii) provide that protected information to Wikileaks for public dissemination; and (iii) continue the pattern of illegally procuring and providing protected information to WikiLeaks for distribution to the public.”

It is true that trained investigative reporters will be more circumspect in how they seek the disclosure of government secrets, but it’s difficult to see how one could legally distinguish less sophisticated journalists from this alleged conduct. National security reporting, in particular, relies on the disclosure and occasional publication of government secrets, as well as developing relationships with sources who have access to classified information and are willing to provide it to journalists.

If those three allegations are enough to bring Assange out of the scope of Bartnicki protections, it would be a challenge, as a legal matter, to draw principled distinctions that could be consistently applied between Assange’s conduct and that of an investigative reporter, sufficient to protect that reporter from a similar Espionage Act claim.

**Does It Matter Whether Assange Sought to Harm the United States?**

If it ever goes to trial, the Assange prosecution will be heard in the same court as the AIPAC case. Part of the reason prosecutors dropped the charges against the AIPAC employees was because of rulings from Judge Ellis on what the government had to prove with respect to their mindset (legally known as the “mens rea,” scientist, or intent requirement).

The intent requirement is arguably the most complicated legal question in the Espionage Act. With respect to Assange, there are two key preliminary points:

1. What would be relevant is Assange’s mindset when he was pursuing and publishing the Manning leaks, not any of his more recent activity; and

2. Assange is charged not just with violations of 18 U.S.C. § 793(d)–(e), which were the provisions at issue in AIPAC, but also with a violation of § 793(b)–(c), which have a heightened intent requirement in the statute.

Also, there is a distinction in the law between tangible documents or other material and intangible classified information. Assange is charged with the solicitation, receipt, and publication of tangible material. Both tangible and intangible information are referred to as “national defense information,” or “NDI.” With respect to tangible NDI, § 793(b) and (c) require a showing that the defendant acted with “intent or reason to believe that the [national defense information] is to be used to the injury of the United States, or to the advantage of any foreign nation.” That will be the intent requirement for counts 2 through 8.

Counts 9 through 17 all involve the same provisions in § 793 that were at issue in AIPAC, namely subsections (d) and (e). The intent requirement there, at least as formulated in the AIPAC rulings, turns on whether the information is tangible or intangible. Assange is charged with the receipt and publication of tangible material.

With respect to the communication, delivery, or transmission of tangible national defense information, § 793(d) and (e) only require that those offenses be done “willfully.” The AIPAC court found the intent requirement to be met if the government can prove that the act was done “with a bad purpose either to disobey or to disregard the law.”

But that just means that the defendant must know that the act is illegal and that the information qualifies as national defense information (in that it is closely held and that its disclosure could harm national security).

Despite *Rosen*, it is still an open question with respect to § 793(d) and (e) as to whether the government has to prove some subjective desire to harm US national security or to help a foreign power (and there’s an additional question of whether that foreign power has to be hostile). As Judge Ellis found, it’s likely that, with respect to intangible information, such a showing is required because the text of the statute qualifies the phrase in § 793(d) and (e) “information relating to the national defense,” with the modifier “which information the possessor has reason to believe could be used to the injury of the United States or to the advantage of any foreign nation,” similar to § 793(b) and (c).

But with tangible material like the reports and cables at issue here, that subjective desire to harm the United States or help a foreign power may not apply, and Judge Ellis’s position in *Rosen* was that all that is required is a showing that (1) the information qualifies as national defense information (it was closely held and disclosure could harm national security) and (2) the leaker knew he or she was breaking the law.

Long story short, the intent questions here are going to be intensely complicated.

***

**THE CHARGES**

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA

Alexandria Division

UNITED STATES OF AMERICA v. JULIAN PAUL ASSANGE, Defendant

Criminal No. 1:18-cr-111 (CMH)
Count 1: 18 U.S.C. § 793(g)
Conspiracy To Receive National
Defense Information
Counts 2–4: 18 U.S.C. § 793(b) and 2 Obtaining National Defense Information
Counts 5–8: 18 U.S.C. § 793(c) and 2 Obtaining National Defense Information
Counts 9–11: 18 U.S.C. § 793(d) and 2 Disclosure of National Defense Information
Counts 12–14: 18 U.S.C. § 793(e) and 2 Disclosure of National Defense Information
Counts 15–17: 18 U.S.C. § 793(e)
Disclosure of National Defense Information
Count 18: 18 U.S.C. §§ 371 and 1030 Conspiracy To Commit Computer Intrusion

The initial indictment in April included only count 18, the conspiracy to violate the CFAA. The “overt act” in furtherance of the alleged conspiracy was that Assange himself agreed to try to crack a password that would have given Assange and Manning access to someone else’s account on SIPRNet, the secure military network handling “secret”-level classified information. That comparatively narrow theory of CFAA liability would have made this a difficult precedent to apply to news outlets, who do not actively participate in hacks to access remote networks.

None of the other charges rely on that password-cracking allegation, and only count 1 is a conspiracy charge (namely, conspiracy to violate § 793(b) through (e) of the Espionage Act). Everything else is an alleged direct violation of the Espionage Act based on different aspects of Assange encouraging the disclosure of, receiving, or publishing military logs known as significant activity, or SIGACT, reports; Guantanamo Bay detainee assessment briefs; and State Department cables. Please see below for a breakdown of the individual counts.

With the exception of counts 15 through 17, counts 2 through 14 most resemble the AIPAC case, one of only two other cases involving Espionage Act charges against nongovernment third parties (the Russo prosecution in the Pentagon Papers case being the other). That is, the Justice Department alleges here joint violations of various provisions of the Espionage Act and 18 U.S.C. § 2, which grafts on principal liability to anyone who “aided, abetted, counseled, induced, procured," § 2(a), or “willfully caused," § 2(b), another to violate the law.

In the context of this superseding indictment, the charging language looks like this (from count 2 on page 19):

B. Between in or about November 2009 and in or about May 2010, in an offense begun and committed outside of the jurisdiction of any particular state or district of the United States, the defendant, JULIAN PAUL ASSANGE, who will be first brought to the Eastern District of Virginia, and others unknown to the Grand Jury, knowingly and unlawfully obtained and aided, abetted, counseled, induced, procured and willfully caused Manning to obtain documents, writings, and notes connected with the national defense, for the purpose of obtaining information respecting the national defense—namely, detainee assessment briefs classified up to the SECRET level related to detainees who were held at Guantanamo Bay—and with reason to believe that the information was to be used to the injury of the United States or the advantage of any foreign nation.

It may be noteworthy, however, that the § 2 “principal liability” language here goes further than in the AIPAC case. In the superseding indictment charging the analyst and the two AIPAC employees, the § 2 claims were just “aiding and abetting.” For instance, the charging language from count 3 on page 19 of the superseding indictment from the AIPAC case looks like this:

On or about March 17, 2003, in Arlington, Virginia, within the Eastern District of Virginia and elsewhere, defendant LAWRENCE ANTHONY FRANKLIN, lawfully having possession of, access to, control over, and being entrusted with a document, writing and note relating to the national defense, did unlawfully, knowingly and willfully communicate, deliver and transmit said document, writing and note to a person or persons not entitled to receive it, namely defendant STEVEN J. ROSEN, who did unlawfully, knowingly and willfully aid and abet FRANKLIN in the communication, delivery and transmission of said document, writing and note.

(In violation of Title 18, United States Code, Sections 793(d) and 2)

This charge was based on Franklin faxing a document to Rosen on March 17, 2003:

On or about March 17, 2003, FRANKLIN faxed, from the Pentagon to ROSEN’s office fax machine, a document he had typed himself. The contents of this document appeared in the classified appendix of the classified draft internal policy document FRANKLIN had previously discussed with ROSEN and WEISSMAN on February 12, 2003.

In other words, the AIPAC complaint relied on § 2 to charge Rosen with aiding and abetting the disclosures in addition to the broader conspiracy. The charges against Assange go further by citing the additional actions covered by both paragraphs (a) and (b) of § 2, namely, aiding, abetting, as well as counseling, commanding, inducing or procuring, § 2(a), and willfully causing, § 2(b), an act to be done. The inclusion of these additional verbs seems intended to bolster the government’s theory that Assange’s encouraging Manning to continue to disclose material itself violated the Espionage Act (for instance, the government prominently cites Assange’s “curious eyes never run dry” comment in paragraphs 21, 24, and 27 of the indictment).

As noted above, there are untested questions concerning the scope of protections under Bartnicki v. Vopper,
the 2001 Supreme Court decision that holds that when a journalist receives information legally—even if the information was procured illegally by a source—First Amendment protections bar criminal charges against the journalist for publication.2

In a case decided by the Fifth Circuit shortly before *Bartnicki v. WFAA*, the court permitted a civil suit under federal and state wire-tapping laws to proceed against a television station and its reporter for the use and disclosure of intercepted cordless phone conversations when the reporter had some involvement in directing the scope of the interception.3

That said, it is difficult—absent some concrete aid to Manning like the password-cracking agreement—to distinguish the Assange allegations with respect to these Espionage Act and “principal liability” § 2 claims from traditional reporter-source relationship building.

Part of the *Peavy* allegations, for instance, was that the reporter told the couple that was intercepting the calls with a police scanner to record continuously to prevent challenges to the authenticity of the recording. The court found that allegation salient and suggested that a reasonable jury could find that the reporter had therefore “obtained” the interception of portions of the tape that the individuals doing the recording would not have otherwise recorded absent that instruction.4

Were that enough to graft principal liability on an investigative reporter for asking a source for specific types of information or documents, the ramifications for press freedom could be severe. Reporters will often reference things they are seeking in a roundabout way to avoid “solicitation” of specific information, but will sometimes ask for particular documents or pieces of information, particularly when they are vetting a piece for accuracy, seeking more context for a disclosure, or assessing potential harm to national security from publication.

In any event, the specific charges against Assange break down as follows:

• One count of conspiracy to violate the Espionage Act, § 793(g);
• Three counts of violating § 2 and § 793(b), which covers anyone who “copies, takes, makes, or obtains” tangible national defense information;
• Three counts of violating § 2 and § 793(c), which covers the receipt of tangible national defense information by anyone knowing or with reason to know that it was procured in violation of the Espionage Act;
• Three counts of violating § 2 and § 793(d), covering the communication, delivery, and transmittal of tangible and intangible national information by those with authorized access, where the person has reason to believe that the “information related to the national defense” could be used to the injury of the United States or to the advantage of any foreign nation; and
• The original CFAA conspiracy charge.

Of these charges, counts 15 through 17 are by far the most interesting. They all have the same general structure. The core allegation in count 15 looks like this:

C. Specifically, as alleged above, ASSANGE, having unauthorized possession of significant activity reports, classified up to the SECRET level, from the Iraq war containing the name of individuals, who risked their safety and freedom by providing information to the United States and our allies, communicated the documents containing name of those sources to all the world by publishing them on the Internet.

Counts 16 and 17 just substitute in a different description of the documents, but all emphasize that the documents “contain[ed] names of individuals, who risked their safety and freedom by providing information to the United States and our allies” and that Assange “communicated the documents containing names of those sources to all the world by publishing them on the Internet” (emphasis added).

As noted earlier, this is certainly a practical and ethical distinction between Assange and *The New York Times*, which reported on the same caches of documents but omitted that sensitive information. But it’s not a legal distinction. The government would have to allege harm to national security in any Espionage Act claim against any defendant. There’s no specific provision in the Espionage Act or case law that makes the identification of informants any more or less harmful to national security than the disclosure of other classified information.

This certainly makes Assange look callous and unethical, but it’s not a distinction that would prevent an Espionage Act charge in a future case where the national security harm does not flow from the identification of US informants.

The “General Allegations”

Unlike the CFAA indictment, this is a full-on “speaking indictment” that goes to great lengths to characterize Wikileaks as an “intelligence agency of the people.” This particular theory of liability is perhaps related to then–CIA director Mike Pompeo’s characterization of Wikileaks as a “hostile non-state intelligence agency” in 2017.5

The first paragraph of the indictment reads:

A. ASSANGE and WikiLeaks Repeatedly Encouraged Sources with Access to Classified Information to Steal and Provide It to WikiLeaks to Disclose.

JULIAN PAUL ASSANGE (“ASSANGE”) is the public face of “WikiLeaks,” a website he founded with others as an “intelligence agency of the people.” To obtain information to release on the Wikileaks

Summer 2019 | Communications Lawyer | 9
website, ASSANGE encouraged sources to (i) circumvent legal safeguards on information; (ii) provide that protected information to WikiLeaks for public dissemination; and (iii) continue the pattern of illegally procuring and providing protected information to WikiLeaks for distribution to the public.

The indictment also notes in the next paragraph that WikiLeaks, until September 2010, stated, “WikiLeaks accepts classified, censored, or otherwise restricted material of political, diplomatic, or ethical significance” (emphasis in indictment). Paragraph three goes on to note that Assange described Wikileaks in a presentation at a hackers’ conference as the “leading disclosure portal for classified, restricted or legally threatened publications.”

Paragraphs 4 through 7 describe WikiLeaks’s “most wanted leaks” list in 2009, which sought material “likely to have political, diplomatic, ethical or historical impact on release . . . and be plausibly obtainable to a well-motivated insider or outsider.”

Paragraph 5 notes that the “most wanted” US leaks include “bulk databases,” including the Intellipedia (a collection of three wikis—one unclassified and two classified), the Central Intelligence Agency’s Open Source Center database, and documents classified to the “secret” level, such as the Intellipedia’s SIGACTs various details on the informants who were identified in both the SIGACTs and the State Department cables. For instance, paragraph 40(e) reads:

e. Classified Document A5 was a 2010 State Department cable discussing human rights issues in Syria. Classified Document A5 named a human source of information located in Syria and indicated that the source’s identity needed to be protected. Classified Document A5 was classified at the SECRET level.

The same section also includes these details:

On May 2, 2011, United States armed forces raided the compound of Osama bin Laden in Abbottabad, Pakistan. During the raid, they collected a number of items of digital media, which included the following: (1) a letter from bin Laden to another member of the terrorist organization al-Qaeda in which bin Laden requested that the member gather the DoD material posted to WikiLeaks, (2) a letter from that same member of al-Qaeda to Bin Laden with information from the Afghanistan War Documents provided by Manning to WikiLeaks and released by WikiLeaks, and (3) Department of State information provided by Manning to WikiLeaks and released by WikiLeaks.

It is unclear whether the bin Laden
material incorporates details from the disclosures that would have been unavailable in the reporting in the news outlets that had the Manning caches.

Also, without minimizing the threat to informants posed by these disclosures, the indictment does not describe any specific harm that is known to have occurred. That said, the government has detailed a mitigation program it undertook when it learned about the possible disclosures. Reports on the possible damage from the disclosures suggested that they would not have a “significant impact” on US military operations in Afghanistan but that the “lives of cooperating Afghans, Iraqis and foreign interlocutors have been placed at increased risk.”

Finally, paragraphs 41 through 44 attempt to establish that Assange knew about the risk posed by publication. For instance, paragraph 44 reads:

On July 30, 2010, the New York Times published an article entitled “Taliban Study WikiLeaks to Hunt Informants.” The article stated that, after the release of the Afghanistan war significant activity reports, a member of the Taliban contacted the New York Times and stated, “We are studying the report. We knew about the spies and people who collaborate with U.S. forces. We will investigate through our own secret service whether the people mentioned are really spies working for the U.S. If they are U.S. spies, then we know how to punish them.” Then confronted about such reports, ASSANGE said, “The Taliban is not a coherent outfit, but we don’t say that it is absolutely impossible that anything we ever publish will ever result in harm—we cannot say that.”

Paragraphs 45 and 46 establish that Assange did not have the authorization to receive, possess, or communicate classified information.

Counts
The specific counts are:

- Count 1: Conspiracy to violate § 793(b)–(e) of the Espionage Act in violation of § 793(g).
- Count 2: Violation of § 793(b) and 18 U.S.C. § 2 in connection with Manning obtaining the Guantanamo Bay detainee assessment briefs.
- Count 3: Same as count 2, but with the State Department cables.
- Count 4: Same as count 2, but with the Iraq rules of engagement files.
- Count 5: Attempt to obtain national defense information from SIPRNet in violation of § 793(c) and § 2.
- Count 6: Unlawfully obtaining and receiving detainee assessment briefs in violation of § 793(c) and § 2.
- Count 7: Same as count 6, but with State Department cables.
- Count 8: Same as count 6, but with Iraq rules of engagement files.
- Count 9: Causing unlawful disclosure by Manning of detainee assessment briefs in violation of § 793(d) and § 2.
- Count 10: Same as count 9, but with State Department cables.
- Count 11: Same as count 9, but with Iraq rules of engagement files.
- Count 12: Causing Manning to communicate, deliver, and transmit the detainee assessment briefs to Assange in violation of § 793(e) and § 2.
- Count 13: Same as count 12, but with the State Department cables.
- Count 14: Same as count 12, but with the Iraq rules of engagement files.
- Count 15: “Pure publication” of the Afghanistan SIGACTs in direct violation of § 793(e).
- Count 16: Same as count 15, but with the Iraq SIGACTs.
- Count 17: Same as count 15, but with the State Department cables.
- Count 18: Conspiracy to violate the Computer Fraud and Abuse Act, 18 U.S.C. §§ 371 (the general conspiracy statute), 1030(a)(1) (the rarely used hacking access-restricted government information provision), 1030(a)(2) (unauthorized access to obtain information from government), and 1030(c)(2)(B)(ii) (establishing five-year sentence).

Endnotes
3. 221 F.3d 158, 172–73, 193–94 (5th Cir. 2000).
4. Id. at 172.
Overbroad Victims’ Rights Laws Impede Access to Public Records

BY DEANNA K. SHULLMAN AND GISELLE M. GIRONES

A more compassionate justice system for crime victims—that is what Marsy’s law, a constitutional amendment in California passed in 2008, sought to do. The law establishes specific rights for crime victims and was backed by billionaire Dr. Henry T. Nicholas, who was inspired to push for victim rights after his sister, Marsalee “Marsy” Nicholas, was murdered by her ex-boyfriend in 1983. A week after the murder, Dr. Nicholas and his mother, much to their surprise, were confronted by the accused murderer—they had not been informed of his release on bail. The law seeks to keep crime victims informed and provide them with specific rights, including legal standing at bail hearings, plea entries, sentencing, and parole hearings. Additionally, the law grants victims the right to prevent the disclosure of certain information that could be used to locate or harass the victim or the victim’s family. Does increased victims’ rights mean decreased access to public records?

Marsy’s Law—A Brief Look
Dr. Nicholas, through Marsy’s Law for All, has established initiatives around the country in an effort to ensure other states pass an equivalent constitutional amendment. In California, among the enumerated rights of notice and standing, the constitution grants victims the right to “prevent the disclosure of confidential information or records to the defendant, the defendant’s attorney, or any other person acting on behalf of the defendant, which could be used to locate or harass the victim or the victim’s family or which disclose confidential communications made in the course of medical or counseling treatment, or which are otherwise privileged or confidential by law.”1

Illinois, North Dakota, South Dakota, and Ohio followed suit. Voters in Montana had approved the proposed amendment in 2016, but the amendment was challenged and struck down on procedural grounds by the Montana Supreme Court.2 Notably, the Illinois and Ohio laws do not include a provision concerning disclosure of information or records.3 The North Dakota and South Dakota laws prevent “disclosure of information or records that reasonably could be used to locate or harass the victim or victim’s family, or which discloses confidential or privileged information about the victim, and to be notified of any request for such information or records.”4

In 2018, Marsy’s Law was approved by voters in Kentucky,6 Georgia, Florida, North Carolina, Nevada, and Oklahoma. The Georgia, Oklahoma, and North Carolina laws do not include a provision concerning disclosure of information. Nevada’s law mirrors California’s in preventing the disclosure of “confidential information or records” that could be used to locate or harass the victim or the victim’s family.6 Florida, like North Dakota, prevents “the disclosure of information or records that could be used to locate or harass the victim or the victim’s family, or which could disclose confidential or privileged information of the victim.”7 Ohio law grants victims the right to prevent disclosure of identifying information.

Ambiguity Eclipsing Access
Although Marsy’s Law is well-intentioned—to create protections for crime victims by providing them more access to information in the criminal process—the vagueness in some of the amendments has resulted in blanket refusal to disclose records otherwise open to the public.

Indeed, these concerns have arisen in those states that have implemented overbroad provisions for withholding records. Although the California law has been around for eleven years, there have not been many reported issues with access because the law limits the prevention of disclosure to records that are confidential or otherwise already protected as privileged. Similarly, Illinois, Ohio, Georgia, Oklahoma, and North Carolina do not include any provision on disclosure of information and likewise have not made headlines. In these states, particularly sensitive information, such as the identities of domestic violence and sex crime victims, is already protected under separate state laws.

But states that have made victim information confidential under their version of Marsy’s Law have—whether intentionally or not—seriously limited the public’s right of access to information about crimes in their states. These ambiguities have largely centered on two issues: (1) who is considered a “victim” and (2) whether the victim has to opt in to prevent disclosure of identifying information.

The Offender, Law Enforcement, and a Business—We’re All Victims
Marsy’s Law was created with the idea of protecting crime victims and their families—but who exactly is considered a “victim”? In South Dakota, the Attorney General’s Office refused to release the name of a Highway Patrol trooper who had shot a man twice.8 The investigative report claimed the trooper had conducted a traffic stop and the man threw an empty beer can at the trooper and...
then tackled and tried to steal his gun. The trooper then shot the man. Because of the struggle, the trooper claimed he was a “victim” under the law and invoked the disclosure exemption.

Similarly, in North Dakota, law enforcement have continued to invoke the law in connection with shootings. As recently as October 2018, a police officer who shot a man, and the man, both invoked the law preventing disclosure of their identities. These men each invoked the law despite the attorney general issuing written guidelines in 2017 that stated there was no right to prevent disclosure of the names of victims or their families under the law, unless you were a victim of domestic violence, human trafficking, or a sex crime, or are a minor. It is impossible to tell for certain how many officers were involved in shootings and how many of those have invoked the law, and correspondingly how many crime reports and other information have been withheld from public view on the contention that an officer involved in an on-duty shooting is a “victim” under Marsy’s Law. Where law enforcement misconduct is at issue, these laws can significantly keep the public in the dark.

Although not as a result of Marsy’s Law, the issue concerning release of the names of officers involved in shootings was before the California Supreme Court in 2014. The Long Beach Police Department had refused to give the Los Angeles Times the names of officers involved in a shooting after the officers mistook a garden hose for a gun. The California Supreme Court held police departments could only withhold names if there was evidence that supported the contention that the officer’s lives were actually in danger. The court clarified that mere speculation or assertions of unspecified endangerment were insufficient to “outweigh the public interest in access to . . . records” and evidence of threats of harm or harassment in connection with the use of force was required to prevent disclosure.

Aside from law enforcement, states may also experience issues with the release of business names and names of traffic accident victims due to the overbroad nature of the definition of “victim” in many states’ laws. In fact, the North Dakota Supreme Court recently affirmed an order requiring payment of restitution to an insurance company under the constitutional provision, for injuries inflicted upon its insured. Although the North Dakota Supreme Court declined to specifically find that a corporation meets the definition of a victim under the provision because it felt the definition did not conflict with the legislature’s expansion of restitution to “other recipients,” it would not be implausible to include corporations under the definition of “crime victim,” although the law likely intended to only protect natural persons. Recognizing these ambiguities, some states, like South Dakota, took measures to clarify the law to make it clear that police could disclose important information to get help from the public and limit who was actually covered by the definition of “victim.” Namely, the definition now narrows the scope of “victim” to “a person against whom a crime or delinquent act is committed.”

Prevention of Disclosure—an Automatic Right?

Another obstacle to access concerns the confusion surrounding the right of prevention itself. With respect to the states that have enacted the broad right of disclosure prevention, the majority have made it unclear as to whether this right is automatic upon the occurrence of the crime or whether it must be expressly invoked by the victim.

Supporters of Marsy’s Law claim the right is automatic, but such automatic sealing results in even greater negative access repercussions. Take South Dakota, for example, whose Office of Highway Safety shut down its crash report website upon implementation of the law in 2016, claiming that pursuant to the law, all crash report sales would be suspended. The Sioux Falls Police Department likewise refused to release crash reports and information concerning the locations of crimes. The automatic approach would mean law enforcement and other agencies would eventually strip all information concerning criminal incidents, including the location, from call logs. The South Dakota Attorney General ultimately proposed revisions to the law requiring victims to invoke the right in order to exercise protection, and agencies were otherwise not to automatically withhold such information. The law has since been amended to require victims to opt in to their rights. North Dakota remains vague as to whether the right is automatic or must be expressly invoked, although a judge recently rejected a victim’s request to close a courtroom during his testimony, finding the victim’s rights had to be balanced with constitutional guarantees of a public trial, and perhaps hinting that at least certain rights must be expressly invoked by the victim.

And Then There’s Florida (or Is It Floriduh?)

Amendment 6 was passed in Florida during the November 2018 election, enacting a version of Marsy’s Law into Florida’s constitution that includes a right to prevent disclosure. Agencies immediately began to withhold records from the public for fear of violating a crime victim’s now constitutional rights to prevent disclosure of identifying information. The public—and the press—immediately cried foul, sighting the equally constitutional right of access to public records in Florida. The right to privacy is expressly subordinate to the right of access in Florida. Agencies face legal peril when they deny access to these public records requests because the amendment does not provide any authority for the withholding of records. Florida law authorizes only the legislature to create exemptions and requires that such exemptions be limited to a single subject and contain only the exemption and provisions governing enforcement of the exemption, state with specificity its public necessity justifying the exemption, be narrowly tailored, and pass by a two-thirds vote of each house. Marsy’s Law passed as a constitutional amendment proposed by the Constitutional Revision Commission and does not comply with any of the constitutional requirements in enacting an exemption.

With respect to implementation,
the majority of agencies in Florida have struggled with whether agencies can automatically withhold records. The plain language of the amendment does not specify whether the right to have information withheld is automatic or must be expressly invoked. For example, the Tallahassee Police Department has decided not to release any information that could identify a victim in any crime, interpreting the law as an “automatic” guarantee of protection.32 The Tampa Police Department also has taken a conservative approach, withholding the names of crime victims and other identifying information based on the law.33 The Hillsborough County Sheriff’s Department has taken the same approach.34 Notably, the Hillsborough Sheriff’s Department, citing Marsy’s Law, redacted the names of victims in incident reports and criminal investigative records related to a double homicide that occurred in 1995. But the stark contrast in application of the law is clear. Within the same area as the Tallahassee Police Department, the Leon County Sheriff’s Office views the provision as requiring victims to “opt in” to the protection.35 The Pinellas County Sheriff’s Office also does not interpret the provision to allow for blanket withholding of records and instead requires that a victim ask for it.36 The offices in Pasco, Hernando, St. Petersburg, and Clearwater all take the same approach.37 Lakeland Police Department and Polk County Sheriff’s Office have elected to release victims’ names but not addresses.38

Another question affecting agencies is whether they will need to redact victims’ names from court files, which will undoubtedly create additional obstacles for both the agencies tasked with responding to public records requests and the public’s right to information contained in court records.39 In response to the confusion, the Florida Senate introduced a bill to ensure uniform applications of the law.40 A spokesperson for the senator who proposed the bill stated that the question of whether victims are automatically granted confidentiality was not addressed because the language makes it clear that such information is automatically protected.41 But the proposed bill did not receive any traction, as it was never heard in committee or introduced in the House, leaving Florida agencies without any guidance.42 The continued lack of clarity in the state is evidenced by the varying implementations of the law across the state.

It is evident that the law, as written, is vague and subject to inconsistent interpretations and applications. The result is a reduction in transparency and unlawful withholding of public records. Among all of the uncertainty, what is clear is that the law is directly in conflict with Florida’s guaranteed constitutional right to access to public records. It will be interesting to see whether the law will be challenged, as Montana’s and now Kentucky’s have been, based on procedural grounds. Alternatively, it may be up to the media to challenge the application of the law as a direct shield to Florida’s assurance of open government laws if the legislature does not soon chime in to implement the law consistent with the competing constitutional rights at stake.

Endnotes

2. In 2016, voters in Montana approved the amendment to the Montana Constitution. In June 2017, the Montana Association of Counties, the Lewis and Clark county attorney, an attorney representing crime victims, the Montana Association of Criminal Defense Attorneys, and the ACLU of Montana Foundation filed a petition with Montana’s Supreme Court challenging the constitutionality of the amendment. Montana Ass’n of Counties v. Att’y Gen., No. 17-0358 (Mt. 2017). The Montana Supreme Court ruled the manner in which the amendment had been submitted to voters violated the state constitutional requirement for a separate vote, and the amendment was declared void in its entirety. Id.
4. Due to rising concerns, as discussed further below, South Dakota voters were asked to support changes to the amendment to address certain access issues. See James Nord, South Dakota Could Be the First State to Tweak “Marsy’s Law”. PBS.ORG (May 14, 2018), https://www.pbs.org/newshour/nation/south-dakota-could-be-the-first-state-to-tweak-marsys-law. Namely, the changes require victims to opt in to their rights including prevention of disclosure to the public information that could be used to locate or harass the victim or the victim’s family. See Letter from S.D. Office of Att’y Gen., Attorney General’s Statement for Proposed Constitutional Amendment HJR 1004 (Revising Marsy’s Law) (Mar. 21, 2018), https://atg.sd.gov/docs/AG%20Statement%20for%20Initiated%20constitutional%20amendment%20HJR%203.21.2018.pdf. The amendment also does not limit law enforcement’s ability to share information with the public for the purposes of help in solving a crime. See S.D. CONST., art. 6, § 29(5). It also narrowed the definition of “victim” to mean a person against whom a crime or delinquent act is committed.
5. N.D. CONST. art. I, § 25(e).
6. The Kentucky amendment was subsequently challenged and found to be unconstitutional on procedural grounds by a circuit court judge. Whitney Westerfield v. David Ward, No. 2018-SC-000585-TG (Ky. 2019). The Kentucky Supreme Court heard oral arguments on February 8, 2019 and affirmed the lower court’s decision. Id.
7. NEV. CONST. art. I, § 8A(1)(d) (emphasis added). Victim is defined as any person “directly and proximately harmed by the commission of a criminal offense under any law of the State.” Id. § 8A(7).
8. FLA. CONST. art. I, § 16(b)(5).
10. In Wisconsin, the amendment will strengthen already-established crime victims’ rights by granting victims the right to, for example, be notified when the offender is free and the ability to be heard at any stage of the proceeding. See Patrick Marley, Constitutional Amendment for Crime Victims Put Off, Likely for a Year, J. SENTINEL (Jan 17, 2019), https://www.jsonline.com/story/news/politics/2019/01/17/constitutional-amendment-crime-victims-put-off-likely-year/2605746002/. The legislature has approved the amendment and will be before voters in the April 2020 election. See Phoebe Petrovic.


20. Id.


22. Id. at p. 4.

23. See supra note 4.


27. See supra note 4.


30. Id. § 23.

31. Id. § 24(c); see also Mem’l Hosp.–W. Volusia v. News-Journal Corp., 729 So. 2d 373, 380 (Fla. 1999) (“exemption from public records access is available only after the legislature has followed the express procedure provided in article I, section 24(c) of the Florida Constitution”); Cf. State v. Knight, 661 So. 2d 344 (Fla. 4th Dist. Ct. App. 1995).


35. See Burlew, supra note 30.


37. See Marrero, supra note 32.


40. Victim Rights, S.B. 1426 (Fla. 2019).


The Lanham Act and Its Origins

As the Court recounted in *Matal v. Tam*, “[t]rademarks and their precursors have ancient origins” and were “protected at common law and in equity at the time of the founding of our country.” For most of the 19th century, trademarks were protected under state laws. The first trademark lawsuits arose in the United States in the 1840s. In 1870, as trademark law developed and became a more international issue, Congress created the first federal statutory trademark law, which was revised in 1876 to add criminal penalties for trademark infringement. Soon after, however, constitutional issues arose regarding Congress’s power to create trademark law, and in 1879, the Supreme Court found the entire federal statutory trademark system unconstitutional. The confusion following this decision prompted ultimately unsuccessful efforts for a constitutional amendment, leading to the exclusively international trademark law of 1881. Congress then again revisited the subject and passed the trademark law of 1905.

Today, the registry of federal trademarks is governed by the Lanham Act, enacted in 1946, codified at 15 U.S.C. §§ 1051 et seq. The common law, however, survives today permitting, among other benefits, trademark infringement suits even in circumstances where a trademark application was not filed with the PTO. Though registration with the PTO is not required for a trademark to be protected, it confers a number of benefits to the registering party, including giving the party the right to use the mark nationwide and to bring an infringement suit in federal court. Moreover, after five years, registered trademarks can become “incontestable,” at which point the exclusive right to use the mark is conclusively established.

The Lanham Act grants the PTO administrative authority over trademark registration. Applications for registration are subject to the PTO’s approval. The Lanham Act contains several provisions that permit the PTO to reject trademarks from the principal register based on certain criteria. At issue in both the *Tam* and *Brunetti* cases were the prohibitions under Section 1052(a) of the Lanham Act, which permit the rejection of trademarks that “[consist] of or [comprise] immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

**Matal v. Tam**

Two years before the Court’s decision in *Brunetti*, on June 19, 2017, the Court in *Matal v. Tam* invalidated the Lanham Act’s bar on “the registration of trademarks that may ‘disparage . . . or bring . . . into contempt[ ] or disrepute’ any ‘persons, living or dead.’” The confusion of the Lanham Act’s disparagement clause was unconstitutional. The justices all agreed that the disparagement clause violates the First Amendment because it discriminated on the basis of viewpoint.

Simon Tam is the lead singer of the rock group The Slants. Tam contends that he chose this name for his band to “reclaim” the term and “diss associated derogatory term for Asian persons.” When Tam tried to register “THE SLANTS,” however, the PTO denied his application based on the Lanham Act’s prohibition of the registration of “disparaging” marks. In rejecting Tam’s registration application, the PTO determined that “there is . . . a substantial composite of persons who find the term in the applied-for mark offensive.” The PTO also relied on a finding that “the band’s name has been found offensive numerous times—citing a performance that was canceled because of the band’s moniker and the fact that several bloggers and commenters to articles on the band have indicated that they find the term offensive.” Tam unsuccessfully contested the denial of registration through the administrative appeals process and then took the case to federal court. On appeal, an en banc Federal Circuit Court found the Lanham Act’s disparagement clause facially unconstitutional under the First Amendment’s Free Speech Clause. The government filed a petition for certiorari.

In an opinion written by Justice Alito, the Supreme Court affirmed the Federal Circuit’s finding that the disparagement clause was unconstitutional. The Court held that the Lanham Act is subject to the Free Speech Clause and that trademarks are private, rather than government, speech. The Court determined that the disparagement clause denies registration to any mark that is offensive to a substantial percentage of the members of any group, and that constitutes viewpoint discrimination. The justices all agreed that the “public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.” In finding that the disparagement clause violates the First Amendment, the Court wrote, “[s]peech may not be banned on the ground that it expresses ideas that offend.”

With the Lanham Act’s disparagement clause invalidated, the viability of the Lanham Act’s neighboring prohibition of “immoral” or “scandalous” trademarks hung in the balance pending the Court’s review of Brunetti’s case.

**Iancu v. Brunetti**

As the Court wrote in *Brunetti*, when determining whether a mark should be rejected based on the registration of “immoral” or “scandalous” marks, the “PTO asks whether a substantial composite of the general public would find the mark shocking to the sense of truth, decency, or propriety, giving offense to the conscience or moral feelings, calling out for condemnation, disgraceful; offensive; disruptive; or vulgar.” The Court noted that the PTO treats “immoral” and “scandalous” as “two terms composing a single category.” Using these criteria, the PTO determined that the FUCT mark should not be added to the registry of federal trademarks.

In denying Brunetti’s registration application for FUCT, the PTO...
examin ing attorney determined that the mark was “vulgar” and “therefore unregistrable.”

On review, the PTO’s Trademark Trial and Appeal Board (the Board) found that the FUCT mark was “highly offensive” and that it had “decidedly negative sexual connotations.” The Board considered evidence of how Brunetti used the mark, finding that Brunetti’s website and products contained imagery, near the mark, of “extreme nihilism and anti-social behavior.” Based on this, the Board concluded that the mark communicated “misogyny, depravity, [and] violence” and, therefore, there was no question that FUCT is “extremely offensive” and that rejection of Brunetti’s application was warranted under the Lanham Act.

Brunetti then brought a facial challenge to the “immoral” or “scandalous” provision of the Lanham Act in the Court of Appeals for the Federal Circuit, which held that the prohibition violated the First Amendment. The Supreme Court then granted certiorari, as is usual when a lower court invalidates a federal statute.

Following oral argument on April 15, 2019, the Supreme Court issued its opinion on June 24, 2019. Justice Kagan, writing for the majority, held that the Lanham Act’s prohibition on registration of “immoral” or “scandalous” trademarks violates the First Amendment. Justice Kagan was joined by Justices Ginsburg, Thomas, Alito, Gorsuch, and Kavanaugh. Chief Justice Roberts and Associate Justices Breyer and Sotomayor dissented, in part.

The Court framed its analysis around whether the Lanham Act’s “immoral” or “scandalous” clause was viewpoint-neutral or viewpoint-based. If it was viewpoint-based, meaning the bar discriminates on the basis of viewpoint, then the statute violates the First Amendment. The Court concluded that the prohibition of the registration of “immoral” or “scandalous” marks is indeed viewpoint-based.

In finding that the facial viewpoint bias under Section 1052(a) of the Lanham Act results in viewpoint-discriminatory application, the Court emphasized that the PTO’s analysis determines whether the public

would view the mark as “shocking to the sense of truth, decency, or propriety.” To illustrate that the PTO’s application of the “immoral” or “scandalous” prohibition is not viewpoint-neutral, the Court set forth a number of examples of trademarks both registered and rejected by the PTO.

As the above examples make clear, the “rejected marks express opinions that are, at the least, offensive to many Americans.” The Court found that the prohibition of “immoral” or “scandalous” marks “distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation.” This facial viewpoint bias in the law results in viewpoint-discriminatory application because the “PTO has refused to register marks communicating ‘immoral’ or ‘scandalous’ views about (among other things) drug use, religion, and terrorism, but it has approved registration of marks expressing more accepted views on the same topics.”

Based on this analysis, the Court concluded that, like the neighboring disparagement clause invalidated in the Tam case, the “immoral” or “scandalous” clause also discriminates on the basis of viewpoint, in violation of the First Amendment. Further, the Court held that the “immoral” or “scandalous” prohibition is also substantially overbroad in that there “are a great many immoral and scandalous ideas in the world (even more than there are swearwords), and the Lanham Act covers them all. It therefore violates the First Amendment.”

In his concurring opinion, Justice Alito agreed that “a law banning speech deemed by government officials to be ‘immoral’ or ‘scandalous’ can easily be exploited for illegitimate ends.” Alito speculated that Congress, however, might be able to draft a more narrow prohibition, writing that the Court’s “decision does not prevent Congress from adopting a more carefully focused statute that

precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.”

Brunetti Partial Dissents Propose Narrowed Construction of “Scandalous”

All nine justices agreed that the term “immoral” runs afield of the First Amendment and is “not susceptible of a narrowing construction that would eliminate its viewpoint bias.” In their partial dissents, however, Justices Roberts, Breyer, and Sotomayor wrote that the prohibition of “scandalous” trademarks should stand because it “can be given a narrowing construction” to “cover only marks that offend because of their mode of expression.”

In his partial dissent, Chief Justice Roberts wrote that “the term ‘scandalous’ need not be understood to reach marks that offend because of the ideas they convey; it can be read more narrowly to bar only marks that offend because of their mode of expression—marks that are obscene, vulgar, or profane.”

According to Roberts, this is how the PTO already interprets “scandalous,” after the Court’s decision in Tam. Roberts concluded that prohibiting the registration of obscene, vulgar, or profane marks does not offend the First Amendment because while the “First Amendment protects the freedom of speech[,] it does not require

the registration of obscene, vulgar, or profane.

<table>
<thead>
<tr>
<th>REGISTERED BY THE PTO</th>
<th>REJECTED BY THE PTO</th>
</tr>
</thead>
<tbody>
<tr>
<td>D.A.R.E. TO RESIST DRUGS AND VIOLENCE</td>
<td>YOU CAN’T SPELL HEALTHCARE WITHOUT THC</td>
</tr>
<tr>
<td>SAY NO TO DRUGS—REALITY IS THE BEST TRIP IN LIFE</td>
<td>MARIJUANA COLA and KO KANE</td>
</tr>
<tr>
<td>PRAISE THE LORD and JESUS DIED FOR YOU</td>
<td>BONG HITS 4 JESUS</td>
</tr>
<tr>
<td>WAR ON TERROR MEMORIAL</td>
<td>BABY AL QAEDA and AL-QAEDA</td>
</tr>
</tbody>
</table>

Summer 2019  Communications Lawyer  17
Government to give aid and comfort to those using obscene, vulgar, and profane modes of expression.”

In his partial dissent, Justice Breyer determined that the government “has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech, and that it will not be associated with such speech.” And “when the Government registers a mark, it is necessarily ‘involved’ in promoting that mark.” In support of his position, Breyer cited scientific evidence that “suggests that certain highly vulgar words have a physiological and emotional impact that makes them different in kind from most other words.” On balance, Breyer found that the prohibition on registering “scandalous” marks does not work “harm to First Amendment interests that is disproportionate in light of the relevant regulatory objectives.” Breyer concluded that though the narrowing construction of the Lanham Act’s “scandalous” provision articulated by Justice Sotomayor “risks some harm to First Amendment interests,” it does not risk “very much,” and does not warrant the facial invalidation of the statute.

Finally, Justice Sotomayor’s partial dissent began with the dire prediction that the “Court’s decision today will beget unfortunate results.” Sotomayor wrote that, as a result of the Court’s opinion, “Government will have no statutory basis to refuse (and thus no choice but to begin) registering marks containing the most vulgar, profane, or obscene words and images imaginable.” Indeed, Sotomayor’s partial dissent predicts a “coming rush to register” similar profane, vulgar, and offensive trademarks. To avoid this paradigm, Sotomayor proposed a narrowed construction of the bar on the registration of “scandalous” marks, limiting its application to obscene, vulgar, and profane marks. Sotomayor urged that her constrained interpretation would “allow the PTO to restrict (and potentially promulgate guidance to clarify) the small group of lewd words or ‘swear’ words that cause a visceral reaction, that are not commonly used around children, and that are prohibited in comparable settings.” This, Sotomayor argues, “would save that duly enacted legislative text by rendering it a reasonable, viewpoint-neutral restriction on speech that is permissible in the context of a beneficial governmental initiative like the trademark-registration system.”

Looking Ahead
On the day of the decision, Erik Brunetti issued a press release declaring that “[t]oday is a good day for Americans” because “both liberal and conservative justices” have recognized “the freedom to express one’s viewpoint even if considered immoral by some.” It remains to be seen how Congress will react to the Brunetti decision, and whether it will attempt to pass new legislation to limit the registration of vulgar, obscene, and profane trademarks, as Justice Alito proposes. Whether Congress attempts to legislate in this area may depend, at least in part, on whether (now that these provisions of the Lanham Act have been invalidated) commerce is flooded by a sea of trademarks registering “the most vulgar, profane, or obscene words and images imaginable,” as foretold by Justice Sotomayor.

It is unclear, however, whether the scope of any such prohibition, no matter how constrained, could ever pass constitutional muster. The Court’s majority in Brunetti is doubtful. By definition, the category of “scandalous” marks includes “marks that offend by the ideas they convey” and, therefore, any such prohibition of “scandalous” marks will always discriminate “based on viewpoint” in violation of the First Amendment.

Endnotes
2. Brunetti’s trademark registration application stated that the name of the mark is “FRIENDS U CAN’T TRUST F.U.C.T.”
4. 137 S. Ct. 1744 (2017) [hereinafter Tam].
8. Id.; see also United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc., 128 F.3d 86, 92 (2d Cir. 1997) (“In 1879, the Supreme Court struck down a federal trademark law because it could not ‘find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes.’ Since the reach of the statute was not explicitly limited within the confines of Congressional power, the statute was found to be invalid.”) (citing Trade-Mark Cases, 100 U.S. at 96).
10. United We Stand Am., Inc., 128 F.3d at 92 (“The next trademark statute enacted in 1905, therefore, prohibited unauthorized use of a registered trademark ‘in commerce among the several States, or with a foreign nation, or with Indian tribes,’ language obviously intended to track the terms of the Commerce Clause.” (citing Law of Feb. 20, 1905, ch. 592, §16, 33 Stat. 724, 728)).
14. Id. § 1065.
15. Tam, 137 S. Ct. at 1753 (citing 15 U.S.C. Code § 1052(a), and noting that this “clause appeared in the original Lanham Act and has remained the same to this day); citing § 2(a), 60 Stat. 427”).
16. Id. at 1747.
17. Id.
19. Tam, 137 S. Ct. at 1754 (citing In re
Tam, 808 F.3d 1321, 1331 (Fed. Cir. 2015) (en banc).

20. Id.
21. Id. at 1755.
22. Id.
23. Id. at 1763 (citing Street v. New York, 394 U.S. 576, 592 (1969); Texas v. Johnson, 491 U.S. 397, 414 (1989) (“If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable”)).
24. Id. at 1751.
25. Iancu v. Brunetti, 2019 WL 2570622, at *3 (June 24, 2019) (citing In re Brunetti, 877 F.3d 1330, 1336 (Fed. Cir. 2017) (internal quotations omitted)).
26. Id.
27. Id. (citations omitted).
28. Id.
29. Id.
30. Id.
33. Id. at *5.
34. Id. at *3.
35. Id. at *6–7.
36. Id. at *8.
37. Id. at *6.
38. Id.
39. Id. at *11.
40. Id. at *6 (Alito, J., concurring).
41. Id.
42. Id. (Roberts, C.J., concurring in part and dissenting in part).
43. Id.
44. Id.
45. Id.
46. Id. at *7 (Breyer, J., concurring in part and dissenting in part).
47. Id.
48. Id. (citing M. Mohr, Holy S***: A BRIEF HISTORY OF SWEARING 252 (2013) (noting the “emotional impact” of certain profane words that “excite the lower-brain circuitry responsible for emotion,” resulting in “electrical impulses that can be measured in the skin”)).
49. Id. (citing Reed v. Town of Gilbert, 135 S. Ct. 2218, 2236 (2015)).
50. Id.
51. Id. at *10 (Sotomayor, J., concurring in part and dissenting in part).
52. Id.
53. Id.
54. Id.
55. Id.
58. Id. at *9.
Media Law Diversity Moot Court Competition: Winners & Best Brief

By Diana Lee and Catherine Martinez

Editors’ Note: The Forum on Communications Law First Amendment and Media Law Diversity Moot Court Competition, now in its twelfth year, is designed to introduce minority law students to the practice of media law and to many of the lawyers who are active in the media law bar.

The Competition provides participants the opportunity to develop their practical lawyering skills by, among other things, requiring each team of participants to prepare appellate briefs and present oral arguments before prominent judges and media law attorneys regarding timely issues of national significance in the field of media law.

The hypothetical legal issue posed to the 2018–2019 Moot Court Competition participants focused on whether the publication of a meme that added commentary to a frame of copyrighted video is protected as a fair use, and if not, whether the DMCA provides immunity for the material because it was uploaded by unpaid contributors to the site.

A committee of Forum attorneys scored the participants’ appellate briefs. The four teams with the highest scores advanced to the semifinal round of oral arguments during the Forum’s Annual Conference. The team with the highest-scoring brief was presented with the “Best Brief” award, and each member of the Best Brief team received $1,000. In addition, all semifinalists received complimentary registration to attend the Forum’s Annual Conference, round-trip transportation, and four nights’ hotel stay during the Annual Conference.

A distinguished panel of judges presided over the final arguments: Judge James E. Graves, Circuit Judge of the U.S. Court of Appeals for the Fifth Circuit; Justice Bridget McCormack, Chief Justice of the Michigan Supreme Court; and Judge Carla Wong McMillian, Judge of the Georgia Court of Appeals.

The 2019 competition resulted in the winning team of Catherine Martinez from Yale Law School and David Davis from Duke Law School, with Catherine Martinez also taking home the coveted title of Best Oralist. Diana Lee and Catherine Martinez of Yale Law School received this year’s Best Brief award; a copy of their brief is presented here:

No. 18-
UNITED STATES COURT OF APPEALS
FOR THE TWELFTH CIRCUIT

IDA BARNETT,
Plaintiff—Appellee,
v.
JOLTFIX PUBLISHING CORP.,
Defendant-Appellant.

On Appeal from the United States District Court for the District of Verona
Case No. 17-CV-11758

BRIEF OF APPELLANT JOLTFIX PUBLISHING CORP.

Diana Lee
Catherine Martinez
YALE LAW SCHOOL

Counsel for Appellant
JoltFix Publishing Corp.

STATEMENT OF FACTS

1. JoltFix is an online news site that maintains a paid staff of eight writers and a roster of approximately 120 volunteer Citizen Correspondents. Correspondents independently create and publish content to the JoltFix.com website. While Correspondents can sign up to cover specific stories posted to an online “Idea Board,” they also produce articles and videos for JoltFix on their own initiative.

2. Hilda Johnson is a Citizen Correspondent. On September 26, 2018, Johnson learned about a post by Ida Barnett on YorkvilleSkinny.com. Barnett’s post featured a video and brief item about Jerry Fitzpatrick, a fundamentalist Christian pastor who, at the time, was a candidate for the York County School Board.

On September 23, 2017, Barnett noticed a car with Fitzpatrick’s campaign sign in the parking lot of an adult novelty store and Triple-X movie theater that served as a front for prostitution. As Barnett drew near, she saw a man leaving the theater and walking towards the car. Believing the man to be Fitzpatrick, Barnett turned on her cellphone video and called out “Reverend Fitzpatrick” to the man. The video captures Barnett’s call and the man, Fitzpatrick, as he turns around.

Barnett uploaded the 20-second video to her personal “channel” on
a user-generated video hosting website, YourVideo.com. She also posted a brief item about the encounter to YorkvilleSkinny and embedded a YourVideo.com player.

Barnett’s post was widely shared in social media and became a topic of discussion in local political circles. After viewing the video, the chair of the county Republican committee called on Fitzpatrick to step aside as a candidate. Fitzpatrick withdrew his candidacy two days later, on September 25.

3. After learning about Barnett’s video, Johnson wrote a short post about Fitzpatrick’s candidacy and withdrawal for JoltFix.com. Johnson also screenshotted an image from Barnett’s video, which shows the moment Fitzpatrick turned to the camera with a startled look. Using an online “meme generator,” Johnson superimposed a caption across the width of the photo that states, “TFW they find out you’re a porn-again Christian.” Ptf. Ex. 2. The image accompanied Johnson’s blog post, which mentioned that Fitzpatrick withdrew his candidacy “after being caught by a local progressive activist patronizing a not-so-family-friendly establishment,” referencing Barnett. Ptf. Ex. 2. After Johnson uploaded the Meme to the Correspondent portal, a JoltFix editor reviewed the Meme, made no changes, and posted it on the morning of September 27.

4. Barnett became aware of Johnson’s JoltFix post after it was shared on social media. On the evening of September 27, Barnett submitted a takedown notice via a link on JoltFix.com. JoltFix provides the link in accordance with the DMCA’s notice-and-takedown requirements. 17 U.S.C. § 512(c)(1)(C)(3). JoltFix soon after contacted Johnson and investigated the video’s origins. Approximately 36 hours after Barnett lodged her complaint, JoltFix removed the post.

Despite the post’s removal, Barnett also demanded that JoltFix pay her a $500 freelancer fee for use of the image from her video. After receiving no response, Barnett registered the video with the U.S. Copyright Office on October 10, 2017. She thereafter filed suit in the U.S. District Court for the District of Verona, alleging that the Meme violated her copyright under the DMCA.

5. At the close of discovery, JoltFix moved for partial summary judgment as to the direct infringement claim on two grounds. First, the DMCA shielded JoltFix from liability for infringing content posted by a user. 17 U.S.C. § 512(c). Second, JoltFix contended that Johnson’s appropriation of a portion of the video for journalistic and parodic purposes qualified as “fair use.”

On June 21, 2018, the district court issued an opinion denying JoltFix’s motion for summary judgment. JoltFix timely appealed to this Court.

II. JoltFix is entitled to the DMCA Safe Harbor for Material Uploaded by an Unpaid, Third-Party User.

This Court reviews de novo a district court’s denial of summary judgment.

ARGUMENT


The DMCA provides that service providers are shielded from liability for infringing content posted “at the direction of a user.” 17 U.S.C. § 512(c).

The relevant question isn’t who is the ‘user,’ but rather, who directed the storage of the infringing content?” BWP Media USA Inc. v. Clarity Dig Grp., LLC, 820 F.3d 1175, 1181 (10th Cir. 2016). “[I]f the infringing content has merely gone through a screening or automated process, the ISP will generally benefit from the safe harbor’s protection.” Id.; see, e.g., UMG Recordings, Inc. v. Shelter Capital Summer 2019 Communications Lawyer 21
Apart from minor technical supervision independently created and used for the actions of its users, it is undisputed that Citizen Correspondents are entitled to the safe harbor for ISP to remove the allegedly infringing content posted. The statute shifts responsibility to the service provider when it becomes aware that content posted by its users.

Accordingly, the “DMCA’s protections are to ensure that liability by acting as a “gateway” for its users merely facilitates the Meme’s accessibility by acting as a “gateway” for its publication on the site. The company’s ability to revoke Correspondents’ contributions, all of which are posted.” Id. (emphasis added).

That is precisely what occurred in this case. Johnson decided to turn Barnett’s post into a JoltFix submission after learning about the post from her friend. On her own initiative, Johnson wrote a blog post about Fitzpatrick, screenshots an image from Barnett’s video, and transformed the image into a meme. After Johnson uploaded the Meme to the Citizen Correspondents portal, a JoltFix editor reviewed the Meme, “made no changes,” and posted it the following morning. Id. at 5. At no point did JoltFix select, curate, or alter the substance of the Meme. Id. Rather, the JoltFix editor merely facilitated the Meme’s accessibility by acting as a “gateway” for its publication on the site. The court recognized, “the decisive factor is control.” Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 4 (D. Verona June 21, 2018).

The fact that JoltFix may terminate Correspondents’ posting privileges does not alter this analysis. Although JoltFix has, on occasion, revoked the login credentials of Correspondents, it did so solely when their submissions “contain[ed] material deemed libelous, obscene, or of ‘poor quality’ inconsistent with the site’s editorial standards and tastes.” Barnett, No. 17-CV-11758, at 4. The company’s ability to revoke the privileges of Correspondents who submit material inconsistent with its purpose does not constitute active encouragement or inducement to upload infringing content to its site. BWP Media USA Inc. v. Clarity Dig. Grp., LLC, 820 F.3d 1175, 1181 (10th Cir. 2016). The Fourth Circuit has held, for example, that the operator of a commercial real estate website did not lose safe harbor eligibility by reviewing user-submitted photographs to determine if they were commercial property. CoStar, 164 F. Supp. at 692.

At bottom, the photos were uploaded at the user’s volition; the ISP did not review and select specific photos, but rather “screen[ed] to assess” whether they fell within the broad scope of the ISP’s goals. Id. By this same reasoning, JoltFix satisfies § 512(c)’s threshold requirement.


As an initial matter, the district court erred in ruling that the common law of agency determines eligibility for § 512(c). That provision nowhere states that liability for user-generated content is determined by agency law. Constr. for Creative Non-Violence v. Reid, 490 U.S. 730, 739 (1989) (“The starting point for our interpretation of a statute is always its language.”); cf. Viacom Int’l, Inc. v. YouTube, Inc., 676 F.3d 19, 36 (2d Cir. 2012) (same and noting that “if Congress had intended [the DMCA safe harbor] to be coextensive with vicarious liability, the statute could have accomplished that result in a more direct manner” (internal quotation marks omitted)).

Even assuming the law of agency applies, Citizen Correspondents are not agents of JoltFix. For an agency relationship to exist, “an agent must have authority to act on behalf of the principal,” and “[t]he person represented [must have] a right to control the actions of the agent.” Restatement (Third) of Agency § 1.01 cmt. c (Am. L. Inst. 2006). As the district court recognized, “the decisive factor is control.” Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 10 (D. Verona June 21, 2018); see Hollingsworth v. Perry, 570 U.S. 693, 695 (2013) (referring to control as one of “the basic features of an agency relationship”). Courts distinguish employees from independent contractors, for example, by examining a “putative employer[‘s]” right to supervise the individual, particularly...
relying on the details of the work.”

Sida of Hawaii, Inc. v. NLRB, 512 F.2d 354, 357 (9th Cir. 1975). Whereas employees “surrender” their activities and time to the “control of the master,” independent contractors render a service “under an agreement to accomplish results” and “retain[] control over the manner of doing [their work].”


Citizen Correspondents fall squarely outside the classic agency relationship of an employer and an employee. First, Joltfix expressly disclaims the formation of an employer/employee relationship in the Independent Contractor Agreement, including the ownership rights that an employer would typically claim by virtue of its control over the employee. See, e.g., 17 U.S.C. § 512(b) (providing that if a work is made for hire, “the employer or other person for whom the work was prepared is considered the author” and owns the copyright to the work). Thus, Correspondents retain all rights to their content posted through the Citizen Correspondents portal.

Second, as discussed above, Joltfix minimally reviews Correspondents’ work, checking only for “obvious spelling errors” and infringing content. Simon Dep. at 12. By contrast, the court in Mavrix noted that LiveJournal “maintain[ed] significant control” over its moderators by giving them “express directions about their screening functions, including criteria for accepting or rejecting posts,” as well as the authority to “reject submissions for reasons other than those provided by the rules.” Mavrix Photographs, LLC v. LiveJournal, Inc., 873 F.3d 1045, 1054 (9th Cir. 2017).

Third, unlike the service provider in Mavrix, Joltfix has not indicated that it exercises control over Citizen Correspondents’ schedules or manner of work. Id. at 1055; see NLRB v. Friendly Cab Co., 512 F.3d 1090, 1099 (9th Cir. 2008) (holding that taxi cab drivers were employees in part because “Friendly sought to control the means and manner of its drivers’ performance by regulating the manner in which they drive, imposing a strict disciplinary regime, . . . imposing a strict dress code, and requiring training in excess of government regulations”). The district court underscored the fact that the Correspondents live in the Metro City area and receive a single, one-day training on-site, but these factors are at best peripheral to the type of “control” that is at the heart of the agency relationship.

V. Joltfix Did Not Receive a Financial Benefit from Material Within Its Right and Ability to Control.

The DMCA shields service providers from liability if the provider “does not receive a financial benefit directly attributable to the infringing activity” over which “the service provider has the right and ability to control.” 17 U.S.C. § 512(c)(1)(B). Joltfix neither receives a financial benefit from the Meme nor has any right to control the Correspondents’ activity. It is therefore entitled to the safe harbor in § 512(c)(1)(B).

VI. Joltfix Did Not Have the Right and Ability to Control the Johnson Meme.

At a minimum, the “right and ability to control” the infringing activity requires “something more than the ability to remove or block access to materials posted on a service provider’s website.” UMG Recordings, Inc. v. Shelter Capital Partners LLC, 718 F.3d 1006, 1030 (9th Cir. 2017) (internal quotation marks omitted); Perfect 10, Inc. v. Cybernet Ventures, Inc., 213 F. Supp. 2d 1146, 1181 (C.D. Cal. 2002) ("[L]osing the safe harbor based on the mere ability to exclude users from the system is inconsistent with the statutory scheme"); Hendrickson v. eBay, Inc., 165 F. Supp. 2d 1082, 1093 (C.D. Cal. 2001).

Rather, the service provider must exert “substantial influence” on the “activities of its users” beyond the ability to control the site. UMG Recordings, 718 F.3d at 1030–31. Courts have held, for example, that control may exist where a web service gives participating websites “detailed instructions regarding issues of layout, appearance, and content” and “refuse[s] to allow sites to use its system until they comply with its dictates.” Cybernet, 213 F. Supp. 2d at 1173. Similarly, an online auction site may have control if it is “actively involved in the listing, bidding, sale, and delivery” of items offered for sale, eBay, 165 F. Supp. 2d at 1094, or “otherwise controls vendor sales by previewing products prior to their listing, editing product descriptions, or suggesting prices,” Viacom Int’l, Inc. v. YouTube, Inc., 676 F.3d 19, 38 n.13 (2d Cir. 2012) (citing Corbis Corp. v. Amazon.com, Inc., 351 F. Supp. 2d 1090, 1110 (W.D. Wash. 2004)).

Joltfix does not exercise such “close control” over Citizen Correspondents to remove it from safe harbor protection. UMG Recordings, 718 F.3d at 1030–31. As the district court recognized, Joltfix is not precluded from the safe harbor simply because it may remove or block access to content submitted by Citizen Correspondents. But the district court erred in advancing a novel interpretation of the DMCA that distinguishes between social-media/video-sharing platforms and a “traditional ‘publishing’ model” in which the “editor must first approve the user post before it becomes visible.” Barnett v. Joltfix Publ’g Corp., No. 17-CV-11758, at 12 (D. Verona June 21, 2018). To counsel’s knowledge, no court to interpret § 512(c)(1)(B) has held that safe harbor eligibility turns on when the ISP may remove user material. As the court explained in CoStar, an ISP that reviews user-submitted photographs for infringing content prior to publication does not have “any right to control its users” that would disqualify it from the safe harbor. CoStar Grp. Inc. v. Loopnet, Inc., 164 F. Supp. 2d 688, 704 (D. Md. 2001), aff’d, 373 F.3d 544 (4th Cir. 2004). By this same rationale, the fact that Joltfix briefly reviews user submissions before posting does not transform Joltfix into a “publishing” platform outside the DMCA safe harbor.

Nor does Joltfix exert control by providing technical support and a short training for Citizen Correspondents. The company’s technical service facilitates the site’s operation by enabling Correspondents to upload content to the portal; it is not active involvement or induce-ment. See Viacom, 676 F.3d at 38 (noting that “inducement of copyright infringement . . . might rise to the level of control under § 512(c)(1)(B)

Joltfix’s one-day training session familiarizes Correspondents with the company’s style and content standards and the importance of visual content. The training materials do
not approach the “detailed instructions” regarding “issues of layout, appearance, and content” that have disqualified ISPs from safe harbor eligibility in the past. Perfect 10, Inc. v. Cybernet Ventures, Inc., 213 F. Supp. 2d 1146, 1173 (C.D. Cal. 2002). While JoltFix may revoke the privileges of users whose content is deemed unsuitable for the company’s standards, it is not clear how often JoltFix has done so, and there is no indication that JoltFix conditions the use of its website on specific editorial requirements. Id.

VII. Joltfix Did Not Receive a Financial Benefit from the Meme.

Even if JoltFix had the right and ability to control the Meme, it did not receive a financial benefit from the Meme’s short life on the site. “Financial benefit exists where the availability of infringing material acts as a ‘draw’ for customers.” A&M Records, Inc. v. Napster, Inc., 239 F.3d 1004, 1023 (9th Cir. 2001). The “central question” of the financial benefit inquiry is “whether the infringing activity constitutes a draw for subscribers, not just an added benefit.” Ellison v. Robertson, 357 F.3d 1073, 1078 (9th Cir. 2004). Thus, “a plaintiff must demonstrate a causal relationship between the specific infringing activity at issue in the case and a financial benefit to the [provider].” Id. at 1079 (emphasis added); Perfect 10, Inc. v. CCBill LLC, 488 F.3d 1102, 1117–18 (9th Cir. 2007) (holding that the Ellison “direct financial benefit” vicarious liability standard applies under § 512(c)(1)(B)).

Ellison guides the financial benefit inquiry in this case. First, there is insufficient evidence that JoltFix’s “customers either subscribed because of the available infringing material or cancelled subscriptions because it was no longer available.” Ellison, 357 F.3d at 1079. JoltFix operates a soft paywall under which the first six articles viewed each month are free. Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 5 (D. Verona June 21, 2018). Thus, even if the Meme drew new users to the site, they would not have been charged a fee to view the post.

Moreover, the district court erred by suggesting that JoltFix is precluded from the safe harbor because the Meme was part of “aggregate content . . . for which JoltFix collects subscription fees.” Id. at 14. As the court in Ellison explained, an ISP must derive a direct financial benefit from the infringing content at issue before it is disqualified from the safe harbor in § 512(c)(1)(B). Ellison, 357 F.3d at 1079.

Second, “the connection between the infringing activity and [JoltFix’s advertising] income stream” is insufficiently direct to meet the financial benefit prong. Columbia Pictures Indus., Inc. v.Funny, 710 F.3d 1020, 1045 (9th Cir. 2013). In Funny, the court concluded that a website operator derived a direct financial benefit from copyrighted films based on the “vast amount” of infringing material available to users, which in turn attracted advertisers to the site. Id.; see also Arista Records LLC v. Myxer, Inc., No. CV 08-03935-GAF, 2011 WL 11660773, at *3 (C.D. Cal. Apr. 1, 2011) (concluding that it “remains unclear to what degree Plaintiff’s works serve as a ‘draw’” for users because the “infringing material represents only 1% of total uploaded material” on the site). By contrast, the record does not suggest that JoltFix promotes or primarily consists of infringing material. Barnett, No. 17-CV-11758, at 14 (noting that “nothing [in the JoltFix training materials] directly instructs the Correspondents to commit copyright infringement or directs them to places where infringing content will be found”). Indeed, JoltFix promptly investigated and removed the Meme after it was notified by Barnett. To hold JoltFix liable despite its compliance with the DMCAs’s notice-and-takedown requirements would eviscerate the § 512(c) safe harbor and undermine the very purpose of the Act.

VIII. Joltfix Is Entitled to the “Fair Use” Defense Under the Copyright Act.

Fair use is a mixed question of law and fact. Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 560 (1985). The Supreme Court has determined that in fair use cases, “[w]here the district court has found facts sufficient to evaluate each of the statutory factors, an appellate court ‘need not remand for further factfinding but may conclude as a matter of law that the challenged use does not qualify as a fair use of the copyrighted work.’” Id.

IX. Joltfix’s Publication of the Meme Was Newsworthy Content That Qualifies for the Journalistic “Fair Use” Defense.

The common law has long recognized that “some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright’s very purpose, [t]o promote the Progress of Science and useful Arts.” Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 575 (1994) (citing U.S. Const. art. 1, § 8, cl. 8). “Fair use doctrine ‘mediates between’ the property rights [copyright law] establishes in creative works, which must be protected up to a point, and the ability of authors, artists, and the rest of us to express them—ourselfs by reference to the works of others, which must be protected up to a point.” Carion v. Prince, 714 F.3d 694, 705 (2d Cir. 2013) (citing Blanch v. Koons, 467 F.3d 244, 250 (2d Cir. 2006)).

Congress codified the fair use doctrine in § 107 of the Copyright Act of 1976. TCA Television Corp. v. McCollum, 839 F.3d 168, 178 (2d Cir. 2016). Section 107 protects the use of copyrighted material for criticism, comment, and news reporting. 17 U.S.C. § 107. In codifying the “fair use” defense, Congress recognized four relevant factors: “(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.” Id.

These factors are not bright-line rules to be treated in isolation; rather, they must be assessed on a case-by-case analysis. Campbell, 510 U.S. at 577–78. And while defendants “bear the burden of proving that their use was fair, they need not establish that each of the factors set forth in § 107 weighs in their favor.” Swatch Grp. Mgmt. Servs. Ltd. v. Bloomberg L.P., 756 F.3d 73, 81 (2d Cir. 2014) (citations omitted). Indeed, the “ultimate test of fair use . . . is whether the copyright law’s goal of ‘promoting Progress of Science and useful Arts,’ ‘would be better served by allowing the use than by preventing it.” Castle Rock
X. JoltFix’s Publication of the Meme Was for the Purpose of News Reporting.

The district court erred in finding that the “sensationalism” of JoltFix’s published content was not the “type of ‘news reporting’ Congress sought to protect.” Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 17 (D. Verona June 21, 2018). The Ninth Circuit has recognized that “sensational coverage” of celebrities in gossip magazines qualifies as news reporting. Monge v. Maya Magazines, Inc., 688 F.3d 1164, 1173 (9th Cir. 2012). And while the Supreme Court has rejected “what amounts to a public figure exception,” Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 560 (1985), courts have also been “solicitous of the fair use defense in works, which though intended to be profitable, aspired to serve broader public purposes.” Twin Peaks Prods., Inc. v. Publ’ns Int’l, Ltd., 996 F.2d 1366, 1375 (2d Cir. 1993) (collecting cases); see also Murphy v. Millennium Radio Grp. LLC, 650 F.3d 295, 307 (3d Cir. 2011) (noting that “under many circumstances, reporters will indeed be able to claim a fair use defense against claims of infringement”).

JoltFix’s publication of the Meme serves such broader public purposes, namely in the service of news reporting on matters of public interest. JoltFix is a “popular online news site” with the “objective of appealing to a college-age audience unaccustomed to consuming mainstream news.” Barnett, No. 17-CV-11758, at 2–3. Moreover, the district court acknowledged that Barnett’s original post on YorkvilleSkinny “became a topic of discussion in local political circles,” id. at 12, recognizing the newsworthiness of the events captured in the video and the Meme.

Indeed, the publication of the Meme was not merely “sensationalistic[]” gossip. Id. at 17. JoltFix and Johnson’s motive in publishing the Meme was news reporting on local politics. The Meme was accompanied by text written by Johnson describing Fitzpatrick’s history as a “[f]ire-breathing morality crusader,” his “pray the porn away’ gospel,” and his candidacy for the York County School Board. Ptf. Ex. 2. Johnson also commented on Barnett’s role in Fitzpatrick’s withdrawal, noting that Fitzpatrick was “caught by a local progressive activist,” and offered commentary on Fitzpatrick’s stated reason for the withdrawal. Id. News outlets have often reported on scandals involving politicians and candidates for public office and such reporting has led to resignations in the past. JoltFix’s blog post about Fitzpatrick constitutes reporting on a matter of public concern—namely, the fitness of candidates for local government office—and is also part of an ongoing public dialogue about hypocritical behavior on the part of certain public figures. Notably, the Supreme Court has long recognized the importance of news reporting for public discourse on public officials. See, e.g., New York Times Co. v. Sullivan, 376 U.S. 254, 270–71 (1964). Contrary to the district court’s finding, JoltFix’s reporting on Fitzpatrick is exactly the type of “news reporting” Congress sought to protect in enacting § 107.

Further, the accompanying commentary confirms the Meme’s “informative function.” Nunez v. Caribbean Int’l News Corp., 235 F.3d 18, 22 (1st Cir. 2000). It “would have been much more difficult to explain the controversy” without the Meme because the Meme “was the story.” Id. The Meme is different from the mere reposting of the photo in Murphy v. Millennium Radio Grp. LLC, where “no similar broader news coverage or editorial commentary existed.” 650 F.3d 295, 307 (3d Cir. 2011). Moreover, the district court’s reliance on Balsley v. LFP, Inc. is misplaced. Balsley concerned the publication of a photo as part of a contest in Hustler, which publishes “graphic images and stories about sex.” 691 F.3d 747, 754 (6th Cir. 2012). The court found that the defendant’s use of the photo was “clearly for commercial purposes, rather than for non-commercial, educational purposes.” Id. at 759. The court noted that while the defendant argued at trial that the publication was an “informative commentary,” “the jury could have rejected that argument in light of the contest aspect of the piece, the picture and description of the Bosley photograph that appeared in Hustler, and the fact that the incident giving rise to the picture was three years old and no longer considered newsworthy.” Id.

In contrast, Johnson submitted the Meme to JoltFix as part of the established Citizen Correspondents program to produce news content for JoltFix’s website. Johnson wrote an informative blog post to accompany the Meme, reporting on the circumstances leading to Fitzpatrick’s withdrawal from the race. Further, the Meme was published on JoltFix’s website four days after Barnett posted the video and only two days after Fitzpatrick’s withdrawal. The Meme was “widely shared on social media,” Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 5 (D. Verona June 21, 2018), indicating both the timeliness and newsworthiness of and the public interest in the Meme at the time of its publication.

While the defendant in Balsley admitted that the purpose of the contest was to “encourage reader participation and interest in the magazine and to generate magazine sales,” Balsley, 691 F.3d at 754–55, there has been no such admission on the part of JoltFix. Rather, the publication of the Meme is directly in line with JoltFix’s role as an online news publication. Thus, the district court’s finding that the “nature and character of JoltFix’s use here is far more ‘promotional’ in nature than journalistic,” Barnett, No. 17-CV-11758, at 17, was clearly in error.

Finally, even if the Meme was commercial in nature, that is not dispositive. A.V. ex rel. Vanderhye v. iParadigms, LLC, 562 F.3d 630, 639 (4th Cir. 2009) (citing Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 147, 148 (1984)); Am. Geophysical Union v. Texaco Inc., 60 F.3d 913, 921 (2d Cir. 1994) (“Since many, if not most, secondary users seek at least some measure of commercial gain from their use, unduly emphasizing the commercial motivation of a copier will lead to an overly restrictive view of fair use.”). The district court correctly recognized that “republishing an image for journalistic storytelling purposes is not regarded as a strictly ‘commercial’ use.” Barnett, No. 17-CV-11758, at 17.
Nature.
The district court correctly found that the “‘factual’ quality of the [original] work is a consideration in Defendant’s favor in the fair-use calculus.” Id. at 18. “The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.” Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 563 (1985). Further, candid photos in a public setting—as was the case with Barnett’s original photo of Fitzpatrick—are “primarily factual,” Katz v. Google, Inc., 802 F.3d 1178, 1183 (11th Cir. 2015), therefore supporting JoltFix’s fair use defense.

XII. Joltfix’s Use of a Small Portion of the Copyrighted Material Was Reasonable in Light of JoltFix’s Purpose.
The third factor in § 107 considers “the amount and substantiality of the portion used in relation to the copyrighted work as a whole.” 17 U.S.C. § 107(3). In this inquiry, courts ask whether the quantity and value of the materials used, are reasonable in relation to the purpose of copying.” Blanch v. Koons, 467 F.3d 244, 257 (2d Cir. 2006). Indeed, “the extent of permissible copying varies with the purpose and character of the use.” Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605, 613 (2d Cir. 2006).

The Meme used only one frame of the twenty-second video. And while Harper & Row is relevant, it is not dispositive. There, the defendant copied and published verbatim portions of an unpublished manuscript in an article. 471 U.S. at 564. The article was “structured around the quoted excerpts which serve[d] as its dramatic focal points.” Id. at 566. The Supreme Court did not consider the transformative aspects, if any, of the rest of the article, nor did it credit the purpose of the takings. Id. at 564–66. But here, it was necessary for Johnson to use the frame to fulfill both JoltFix’s journalistic purpose and Johnson’s humorous commentary, even if that constituted the “heart” of Barnett’s work. Johnson’s work on the Meme is similar to that in Cariou v. Prince. There, a “well-known appropriation artist” incorporated images from a photographer’s published work into his art, altering some of the images. 714 F.3d 694, 699–701 (2d Cir. 2013).

The court recognized that the artist’s use of the works was still fair because it was necessary for the purpose. Id. at 710. Indeed, the “secondary use ‘must be [permitted] to ‘conjure up’ at least enough of the original’ to fulfill its transformative purpose.” Id. (citation omitted).

Moreover, Johnson needed the still frame to “conjure up” at least enough of the original.” Johnson’s commentary, “TFW they find out you’re a porn-again Christian,” necessarily relied on the still frame depicting the “moment at which Fitzpatrick’s face is identifiable and contorts in horrified recognition.” Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 19 (D. Verona June 21, 2018). “TFW” stands for “that feeling when,” id. at 5 n.2, and Johnson’s use of it directly comments on Fitzpatrick’s feelings at the very moment he turns to face Barnett. The Meme, even if taken from the original’s heart, was not excessive copying because it relied upon the still frame for the purpose of its use.

XIII. Because the Meme Is Not a Substitution, Its Publication Does Not Negatively Affect the Original Work’s Potential Market.
The fourth factor in the analysis is the “effect of the use upon the potential market for or value of the copyrighted work.” 17 U.S.C. § 107(4). “The focus here is on whether defendants are offering a market substitute for the original.” NXIVM Corp. v. Ross Inst., 364 F.3d 471, 481 (2d Cir. 2004). “When the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred,” as when it is duplicative. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 591 (1994).

Here, the Meme’s use of a single still image is qualitatively different from Barnett’s entire twenty-second video. The video depicts the parking lot of Club Erotica; the car with a “Fitzpatrick for School Board” sign; Barnett calling out, “Reverend Fitzpatrick”; and Fitzpatrick turning around, noticing Barnett’s camera, covering his head, running to the car, and driving away. The Meme is not a substitute because it depicts only a small portion of Barnett’s work. Users who wish to see Barnett’s entire encounter—which provides important information, such as confirmation that the person in the video was Fitzpatrick because of his response and the car with the Fitzpatrick sign—will not be satisfied by the Meme.

Additionally, Barnett has not demonstrated that she has lost any potential sales or licensing of the video.

Relatedly, YorkvilleSkinny focuses on a small town, while JoltFix has a nationwide audience. Barnett has failed to demonstrate that the Meme has usurped her market. Indeed, the Meme’s transformative nature may be the primary driver of traffic to JoltFix instead of YorkvilleSkinny, given the role of memes in today’s Internet culture.

Finally, Barnett already published the video online through YourVideo.com and YorkvilleSkinny. See Los Angeles News Serv. v. KCAL-TV Channel 9, 108 F.3d 1119, 1122 (9th Cir. 1997) (noting that because plaintiff had already published the content, the market factor weighed in defendant’s favor). Indeed, Barnett originally uploaded the video to YourVideo.com, which enabled users to share the video on their own pages. Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 2 (D. Verona June 21, 2018). Barnett’s post had also been shared several dozen times on social media. Id. Barnett contemplated and implicitly approved of sharing the video outside her website. Barnett therefore already accepted the possibility that the market for her video would be diminished as it was shared more and more on YourVideo.com or other social media.

Taken together, § 107’s four factors weigh in favor of fair use.
XIV. Johnson’s Added Content Sufficiently Transformed the Meme for the Purposes of the “Fair Use” Defense.

A work is transformative if it “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.” Campbell, 510 U.S. at 579. “If the secondary use adds value to the original—if [copyrightable expression in the original work] is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.” Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc., 150 F.3d 132, 142 (2d Cir. 1998) (citations omitted). The inquiry is “whether the new work uses the copyrighted material itself for a purpose, or imbues it with a character, different from that for which it was created.” TCA Television Corp. v. McCollum, 839 F.3d 168, 180 (2d Cir. 2016).

The district court erred in treating the addition of a “meme headline” as “minimal effort” that “seems no different than other minor alterations that have been held insufficiently ‘transformative’ to qualify for the fair-use defense.” Barnett, No. 17-CV-11758, at 22. The district court pointed to Monge v. Maya Magazines, Inc., wherein a gossip magazine added headlines or captions to photos, 688 F.3d 1164, 1174 (9th Cir. 2012), and Barcroft Media, Ltd. v. Coed Media Group, LLC, in which a gossip website added a column heading to photos, 297 F. Supp. 3d 339 (S.D.N.Y. 2017).

But Johnson’s work is different from the gossip magazine and website in Monge and Barcroft Media. Rather than only captioning the events in Barnett’s video or adding a column heading or title, Johnson created a humorous joke criticizing Fitzpatrick and his response. “TFW when they find out you’re a porn-again Christian” calls to mind both Fitzpatrick’s fundamentalism and anti-porn sermons and plays on the words “born-again Christian.” The Meme does not merely describe the events in the image or provide a column heading; rather, it adds “meaning or information” and “imbue[s] the original[]” with “new creative or expressive purpose.” Barcroft Media, 297 F. Supp. 3d at 352–53.

The district court’s comparison of the Meme to the remixed movie trailers in Video Pipeline v. Buena Vista Home Entertainment and the hashtag in North Jersey Media Group v. Pirro is inappropriate for the same reasons. In Video Pipeline, the Third Circuit held that the remixed movie trailers “did[not] add significantly to [plaintiff’s] original expression,” relying in part on Video Pipeline’s own admission that the remixing “involved no new creative ingenuity.” 342 F.3d 191, 199 (3d Cir. 2003). In North Jersey Media Group, the district court noted that “it can be argued that no part of the [image] constitutes an original idea,” and that defendants’ addition of #neverforget “merely amounted to exclaiming ‘Me too.’” 74 F. Supp. 3d 605, 617 (S.D.N.Y. 2015). In contrast, the Meme was the very kind of “new information, new aesthetics, new insights and understandings . . . that the fair use doctrine intends to protect.” Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc., 150 F.3d 132, 142 (2d Cir. 1998). It involved creative, referential humor and added commentary on both Fitzpatrick’s hypocrisy in his private life, versus his public persona, and the public’s reaction to Barnett’s original video.

Further, the Meme is a parody. The district court correctly noted that if the Meme is parodic, “JoltFix is entitled to considerably more latitude, because a parody obviously must borrow from the work being parodied.” Barnett v. JoltFix Publ’g Corp., No. 17-CV-11758, at 22 (D. Verona June 21, 2018) (citing Rogers v. Koons, 960 F.2d 301, 310 (2d Cir. 1992)). Courts “will treat a work as a parody if its aim is to comment upon or criticize a prior work by appropriating elements of the original.” Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1268–69 (11th Cir. 2001). “[T]he heart of any parodist’s claim . . . is the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.” Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 580 (1994).

While the district court correctly acknowledged that part of the Meme’s function was to “comment on candidate Fitzpatrick’s perceived hypocrisy,” the district court erred in dismissing the Meme’s additional parodic comment on Barnett’s video. The district court mistakenly asserted that the “subject matter of the JoltFix story and illustration are Fitzpatrick’s failed candidacy, not Fitzpatrick’s appearance in the video.” Barnett, No. 17-CV-11758, at 23.

To the contrary, Johnson’s parodic content plays directly with the encounter in the video. It notes Barnett calling out to Fitzpatrick; indeed, Barnett and her audience, including the chair of the county Republican committee that called on Fitzpatrick to withdraw after viewing the video, id. at 2, are the “they” referred to in the Meme. It also provides commentary on Fitzpatrick’s realization that Barnett was filming him with a camera. Johnson directly references Barnett, writing that Fitzpatrick withdrew “after being caught by a local progressive activist,” and mocks Fitzpatrick’s stated reason for the withdrawal as “spend[ing] more time with the proverbial family.” Ptf. Ex. 2. “[A]s long as the parody ‘reasonably could be perceived as commenting on the original or criticizing it, to some degree,’ it may constitute fair use.” Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 801 (9th Cir. 2003) (quoting Campbell, 510 U.S. at 580–81). The Meme clearly comments on the original video in acknowledging the effect it had on Fitzpatrick’s candidacy as well as humorously joking about not only Fitzpatrick’s response to Barnett, but also his “[feeling when] they find out you’re a porn-again Christian.” The Meme’s content is clearly a creative, parodic commentary on the original copyrighted work sufficient to transform the still image for the purposes of JoltFix’s fair use defense.

Conclusion

For these reasons, the Court should reverse the district court’s decision.

Dated: November 19, 2018
Respectfully submitted,

Is/ Counsel for Appellant JoltFix Publishing Corp.
Officers, Governing Committee, and Editors 2018 – 2019

Chair
David Giles
The E.W. Scripps Company

Immediate Past Chair
Carolyn Y. Forrest
Fox Television Stations, LLC

Budget Chair
James T. Borelli

Membership Co-Chair
Robb S. Harvey
Waller Lansden Dortch & Davis, LLP
Cynthia Counts
Duane Morris LLP

Editors
Lee S. Brenner
Venable LLP
Amanda M. Leith
NBCUniversal Media LLC
Drew Shenkman
Cable News Network

ABA Staff
Forum Director
Yolanda Muhammad
Yolanda.Muhammad@americanbar.org

Designer
Cory Ottenwess
ABA Publishing

Governing Committee

Members
Lynn D. Carrillo (2019)
Tom Curley (2021)
Rachel R. Fugate (2019)
Kaitlyn Gurney (2021)
Robb S. Harvey (2019)
Robin Luce-Herrmann (2021)
Steven P. Mandell (2020)
Eric Schroeder (2021)
Nathan Siegel (2020)
Nabiha B. Syed (2020)
Lee R. Williams (2021)

Program Chairs

Privacy and Data Security CLE
Program Chair
Adrienne Fowler
Harris Wiltshire & Grannis LLP

Representing Your Local Broadcaster Program Chair
Kathleen Kirby
Wiley Rein LLP

Division Co-chairs

Eastern
Stephanie Abrutyn
S. Jenell Trigg
Carol J. LoCicero

Central
Elizabeth Ryder
Natalie J. Spears
Leita Walker

Western
Lisa Rafferty
Steven D. Zansberg