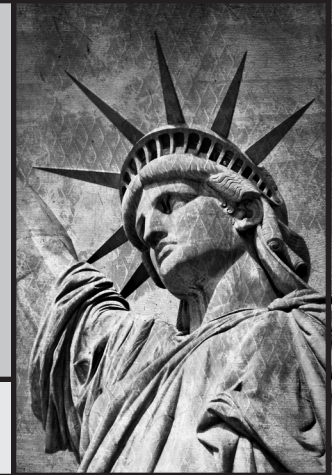


Freedom of Speech in the United States

Thomas L. Tedford
The University of North Carolina at Greensboro

Dale A. Herbeck
Northeastern University



Annual Update

Autumn 2023

The U.S. Supreme Court issued consequential decisions dealing with affirmative action, voting rights, student loans, immigration, Indigenous sovereignty, and labor unions during its 2022–2023 term, but it did not produce a blockbuster ruling equivalent to last year’s decision in *Dobbs v. Jackson Women’s Health Organization*. This controversial ruling abandoned 50 years of precedent and took away the constitutional right to abortion. There were few surprises, as the Court finished its second term with six Republican and three Democratic appointees.

Ethics watchdog and media organizations criticized several sitting justices for accepting lavish gifts and luxury trips provided by close personal friends, failing to disclose the details of real estate transactions, and signing lucrative book contracts. The House of Delegates of the American Bar Association adopted a resolution calling for a binding code of ethics for the Supreme Court, modeled after the Code of Judicial Conduct for federal judges. Citing concerns about the separation of powers, Chief Justice John G. Roberts, Jr., “respectfully declined” an invitation to appear before the Senate Judiciary Committee at a public hearing devoted to the Supreme Court’s ethical principles and practices. In an interview with writers from the *Wall Street Journal*’s editorial page, Justice Samuel A. Alito, Jr., went even further, proclaiming, “Congress did not create the Supreme Court. . . . No provision in the Constitution gives them the authority to regulate the Supreme Court—period.”

A series of controversial decisions in recent years and growing concerns about judicial ethics undermined public confidence in the judiciary. A survey by NPR, PBS NewsHour, and the Marist Institute for Public Opinion found that public confidence in the Supreme Court had fallen to a 50-year low. Just 26 percent of Americans reported great confidence in the Court in 2021. That percentage fell to 18 percent in 2022. At the other end of the spectrum, 36 percent reported hardly any confidence, up from 21 percent. The remaining 46 percent had “only some” confidence in the institution.

The Supreme Court decided several significant free speech cases in the 2022–2023 term. Cases involving a graphic designer in Colorado and threatening Facebook posts received most of the attention, but the justices also heard cases involving an attorney who encouraged illegal immigration, liability for social media posts, Andy Warhol’s use of a copyrighted photo, and the name and shape of a dog toy. Several lower court cases are also worth noting. A defamation lawsuit brought by Dominion Voting Systems against Fox News was settled out of court. A jury awarded writer E. Jean Carroll \$5 million in damages against ex-President Donald Trump

for sexual assault and defamation. Finally, the Supreme Court has granted certiorari to several free speech cases that will be heard during the 2023–2024 term.

The complete text of this update and a library of landmark free speech decisions can be found on the website for the book:

<http://www.tedford-herbeck-free-speech.com>

* * *

Chapter 3: Political Heresy

United States v. Hansen (encouraging or inciting unlawful immigration)

303 Creative v. Elenis LLC (compelled speech)

Counterman v. Colorado (true threats)

Chapter 4: Defamation

Out of Court Settlement in *Dominion Voting Systems v. Fox News Network*

E. Jean Carroll Wins Lawsuit against Former President Donald J. Trump

An Organizational Note about *Twitter, Inc. v. Taamneh* and *Gonzalez v. Google LLC*

Twitter, Inc. v. Taamneh (aiding and abetting terrorism)

Gonzalez v. Google LLC (Section 230 immunity)

Chapter 13: Copyright

Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith (transformative use)

Jack Daniel's Properties, Inc. v. VIP Products LLC (trademarks)

Looking to the Future

* * *

Chapter 3: Political Heresy

U.S. Supreme Court

Case: *United States v. Hansen*, 143 S.Ct. 1932 (decided June 30, 2023).

Subject: The encouragement provision of Section 1324 of the U.S. Code is not unconstitutionally overbroad.

Summary: Attorney Helaman Hansen promoted a “Migration Program” that promised the “quickest and easiest way to get citizenship here in America.” The program claimed that undocumented immigrants who joined the program would be adopted by U.S. citizens and thus become eligible for citizenship. Hansen began by selling memberships for a modest \$150, but that fee increased over time: some immigrants paid \$10,000 to join his program. Between October 2012 and January 2016, he enrolled more than 450 noncitizens and collected almost \$2 million in membership fees. Once they enrolled, Hansen encouraged program members to enter the U.S. illegally and to overstay their visas.

There is no path to citizenship through adult adoption. When federal officials discovered the fraudulent scheme, Hansen was arrested and charged with, among other things, violating Section 1324(a)(1)(A)(iv) of the U.S. Code, which forbids “encouraging or inducing an alien

to come to, enter, or reside in the United States, knowing or in reckless disregard of the fact that such coming to, entry, or residence is or will be in violation of law.” Violating the encouragement provision carries a maximum penalty of five years imprisonment. A separate penalty enhancement provision raises this maximum to ten years if the violation is committed “for the purpose of commercial advantage or private financial gain.”

After an eleven-day trial in federal court in 2017, Hansen was convicted of two counts of encouraging and inducing illegal immigration, three of wire fraud, and twelve of mail fraud. He was sentenced to twenty years in prison and ordered to pay more than \$570,000 in restitution to his victims. In a February 2022 decision, the Ninth Circuit Court of Appeals affirmed the fraud convictions. It overturned the two counts of “encouraging unlawful immigration,” ruling that the law was overbroad and unconstitutional because “many commonplace statements and actions could be construed as encouraging or inducing an undocumented immigrant to come to or reside in the United States.”

The U.S. Department of Justice appealed, arguing that the Supreme Court “recognized more than a century ago, without discussing the First Amendment, that Congress’s power to define immigration goes hand-in-hand with its ability to prohibit encouraging someone to violate those laws.”

In 2022, in a 7-2 decision, the Supreme Court held that the encouragement provision did not violate the right to free speech guaranteed by the First Amendment. Justice Amy Coney Barrett wrote the majority opinion, joined by conservative justices (Chief Justice John G. Roberts, Jr., Justice Clarence Thomas, Samuel A. Alito, Jr., Neil M. Gorsuch, and Brett M. Kavanaugh) and one progressive justice, Elena Kagan. Justice Ketanji Brown Jackson wrote a dissenting opinion that Justice Sonia Sotomayor joined.

In the majority opinion, Justice Barrett took an approach to the encouragement provision that differed from that of the lower court. The Ninth Circuit had looked to the plain meanings of “encouraging” and “inducing,” but she interpreted them as terms that Congress used in a specialized, criminal-law context. When Congress uses such language, Justice Barrett reasoned, “it presumably knows and adopts the cluster of ideas that were attached to each borrowed word.” In this instance, Congress intended to forbid “the intentional solicitation or facilitation of certain unlawful acts,” aiding and abetting illegal immigration. Under this interpretation, she said, solicitation requires intentionally encouraging an unlawful act, and facilitation requires assisting a lawbreaker with the intent to further the commission of an offense.

By narrowing the reach of Section 1324, Justice Barrett dispensed with Hansen’s overbreadth claim and saved the statute. “The provision has a wide legitimate reach insofar as it applies to nonexpressive conduct and speech soliciting or facilitating criminal violations of immigration law. Even assuming that clause (iv) reaches some protected speech, and even assuming that its application to all of that speech is unconstitutional, “the ratio of unlawful-to-lawful applications is not lopsided enough to justify the ‘strong medicine’ of facial invalidation for overbreadth.”

Justice Ketanji Brown Jackson, in a dissenting opinion joined by Justice Sonia Sotomayor, argued that “the encouragement provision is unconstitutional under our First Amendment overbreadth doctrine.” The problem, she explained, was that the statute’s “use of the terms ‘encourage’ and ‘induce’ seems to encompass any and all speech that merely persuades, influences, or inspires a noncitizen to come to, enter, or reside in this country in violation of law, [which would] put all manner of protected speech in the Government’s prosecutorial crosshairs. It would reach, for example, the grandmother who says she misses her noncitizen

grandchild, leading the grandchild to move illegally to the United States. It would also apply to the doctor who informs a noncitizen patient that a necessary medical treatment is more readily available in the United States, influencing the patient to stay beyond the expiration of his visa to await treatment. The college counselor who advises an undocumented student that she can obtain a private scholarship to attend college in the United States, inspiring the student to reside here, would also fall within the scope of the statute.”

The Supreme Court decision upholding the encouragement provision produced mixed reviews. Some commentators praised the decision, claiming that it affirms an important principle: Citizens have the right to challenge laws limiting speech if the law “prohibits a substantial amount of protected speech” relative to its “legitimate sweep.” Esha Bhandari, Hansen’s lawyer and deputy director of the American Civil Liberties Union’s Speech, Privacy, and Technology Project, also lauded the holding: “The Supreme Court has drastically limited the encouragement provision to apply only to intentional solicitation or facilitation of immigration law violations.” Other commentators voiced concerns about the decision’s potential impact. “Whether it’s actually a win for free speech proponents or not,” attorney Rachel Barkin warned, “the ruling demands unwavering vigilance in monitoring the government’s response to the narrowed scope of the provision. *Hansen* serves as a reminder that freedom of speech fundamentally depends upon citizens raising challenges when the government attempts to exceed the boundaries set by long-standing First Amendment precedent.”

U.S. Supreme Court

Case: *303 Creative v. Elenis LLC*, 143 S.Ct. 2298 (decided June 30, 2023).

Subject: The First Amendment prohibits Colorado from forcing a website designer to create expressive designs that communicate messages with which the designer disagrees.

Summary: Lorie Smith owns 303 Creative, a Colorado design studio that provides website and graphic design, marketing strategy, and social media management to her clients. She says she will serve any client (regardless of race, creed, sexual orientation, or gender), but will not create content that contradicts her Christian beliefs. On her website, Smith explains that she “will decline any request—no matter who makes it—to create content that contradicts the truths of the Bible, demeans or disparages someone, promotes atheism or gambling, endorses the taking of unborn life, or promotes a concept of marriage that is not solely the union of one man and one woman.”

Smith claims she cannot practice her beliefs because of two provisions in Colorado’s Anti-Discrimination Act (CADA). The first is an Accommodation Clause that prohibits businesses that are open to the public from “directly or indirectly” refusing “to an individual or a group, because of . . . sexual orientation . . . the full and equal enjoyment of the goods, services, facilities, privileges, advantages, or accommodations of a place of public accommodation.” The second provision, a Communications Clause, prohibits a public accommodation from making a statement “that indicates that the full and equal enjoyment of the goods, services, facilities, privileges, advantages, or accommodations of a place of public accommodation will be refused . . . or that an individual’s patronage . . . is unwelcome, objectionable, unacceptable, or undesirable because of . . . sexual orientation.”

With the aid of the Alliance Defending Freedom, a conservative legal group, Smith went to federal court, seeking an order prohibiting Colorado from enforcing the

CADA and alleging that both clauses of the law violated her First Amendment rights. The Accommodation Clause compelled her to create websites for weddings for same-sex couples. The Communications Clause prevented her from explaining why she was unwilling to provide these services. A federal district judge held that the CADA did not violate Smith's free speech rights.

The Tenth Circuit Court of Appeals affirmed that decision, acknowledging that the "creation of wedding website is pure speech" and that CADA "compels" Smith to create speech that "celebrates" same-sex unions, but holding that CADA could withstand constitutional scrutiny as it was narrowly tailored to ensure LGBTQ couples have access to the same goods and services available to straight couples. "LGBT consumers may be able to obtain wedding-website design services from other businesses," the Tenth Circuit concluded, "yet LGBT consumers will never be able to obtain wedding-related services of the same quality and nature as those that Appellants offer. Thus, there are no less intrusive means of providing equal access to those types of services."

The Supreme Court agreed to hear the case and to decide "whether applying a public-accommodation law to compel an artist to speak or stay silent violates the Free Speech Clause of the First Amendment." The justices took up a set of facts similar to those in *Masterpiece Cakeshop v. Colorado Civil Rights Commission*, a 2017 case involving a baker who refused to create a wedding cake celebrating a same-sex marriage. In that case, the Court ruled in favor of the baker on free exercise grounds, taking care to avoid the free speech question.

Since *Masterpiece Cakeshop*, the ideological composition of the Supreme Court has changed. Justice Anthony M. Kennedy, who wrote the majority opinion in *Masterpiece Cakeshop*, has retired. Justice Ruth Bader Ginsberg, the first justice to officiate at a same-sex wedding, has died. They were replaced by more conservative justices, nominated by then-President Trump, who sympathized with challenges brought by religious interests. Their successors, Justices Brett M. Kavanaugh and Amy Coney Barrett, are noticeably more conservative in their judicial philosophy.

The Supreme Court ruled in favor of Smith in a 6-to-3 decision that was sharply divided along ideological lines. Justice Neil M. Gorsuch, writing for the majority, said the First Amendment's protections belong to all, not just to speakers whose motives the government finds worthy, and including "speakers whose motives others may find misinformed or offensive." His opinion was joined by the other conservative justices, Chief Justice John G. Roberts, Jr., and Justices Clarence Thomas, Samuel A. Alito Jr., Brett M. Kavanaugh, and Amy Coney Barrett.

"In this case," Justice Gorsuch explained, "Colorado seeks to force an individual to speak in ways that align with its views but defy her conscience about a matter of major significance." Forcing Smith to design websites for same-sex couples, he continued, "would allow the government to force all manner of artists, speechwriters, and others whose services involve speech to speak what they do not believe on pain of penalty. . . . The government could require 'an unwilling Muslim movie director to make a film with a Zionist message,' or 'an atheist muralist to accept a commission celebrating Evangelical zeal,' so long as they would make films or murals for other members of the public with different messages. Equally, the government could force a male website designer married to another man to design websites for an organization that advocates against same-sex marriage." He concluded that allowing Colorado to compel Smith to design some websites would set a dangerous precedent, as "countless other creative professionals, too, could be forced to choose between remaining silent, producing

speech that violates their beliefs, or speaking their minds and incurring sanctions for doing so.” When public accommodation laws and the Constitution collide, the First Amendment must prevail. “Were the rule otherwise, the better the artist, the finer the writer, the more unique his talent, the more easily his voice could be conscripted to disseminate the government’s preferred messages. That would not respect the First Amendment; more nearly, it would spell its demise.”

Justice Sonia Sotomayor authored a dissenting opinion that was joined by the other two liberal justices, Elena Kagan and Ketanji Brown Jackson: “Today the Court, for the first time in its history, grants a business open to the public a constitutional right to refuse to serve members of a protected class.” She denounced the ruling as “heartbreaking,” and “familiar”: “When the civil rights and women’s rights movements sought equality in public life, some public establishments refused. Some even claimed, based on sincere religious beliefs, constitutional rights to discriminate. The brave Justices who once sat on this Court decisively rejected those claims.” To punctuate the depth of her disagreement, she read parts of her dissent from the bench. (Because they are rare, oral dissents are dramatic, as the dissenting justice speaks to an audience that includes her colleagues.)

Justice Sotomayor argued that the Colorado law does not compel speech; it regulates discriminatory conduct. Under CADA, “the business is free to include, or not to include, any lawful message it wants in its wedding websites. The only thing the business may not do is deny whatever websites it offers on the basis of sexual orientation. . . . The refusal to deal with or to serve a class of people is not an expressive interest protected by the First Amendment.” Although *303 Creative v. Elenis* was of particular interest to the LGBT community, she warned, “the decision’s logic cannot be limited to discrimination on the basis of sexual orientation or gender identity. The decision threatens to balkanize the market and to allow the exclusion of other groups from many services. . . . A website designer could equally refuse to create a wedding website for an interracial couple, for example. How quickly we forget that opposition to interracial marriage was often because ‘Almighty God . . . did not intend for the races to mix.’ Yet the reason for discrimination need not even be religious, as this case arises under the Free Speech Clause. A stationer could refuse to sell a birth announcement for a disabled couple because she opposes their having a child. A large retail store could reserve its family portrait services for ‘traditional’ families. And so on.”

Reactions to the *303 Creative* decision mirrored the division within the Supreme Court. Conservatives and religious groups celebrated the majority opinion. Kristen Waggoner, the lawyer representing Smith on behalf of the Alliance Defending Freedom, said, “The U.S. Supreme Court rightly reaffirmed that the government can’t force Americans to say things they don’t believe. The court reiterates that it’s unconstitutional for the state to eliminate from the public square ideals it dislikes, including the belief that marriage is the union of husband and wife.” Cardinal Timothy M. Dolan of New York said, “This case was never about discrimination. It was about moral disagreement. The government must allow room for people to disagree on hot-button issues. It’s even more important when the person disagreeing has an unpopular view.”

Others embraced the concerns set out in Justice Sotomayor’s dissenting opinion. President Biden issued a statement labeling the outcome “disappointing,” and warned that it “weakens longstanding laws that protect all Americans against discrimination in public accommodations—including people of color, people with disabilities, people of faith, and women.” Echoing this sentiment, Katherine M. Franke, professor of law and director of the Center for Gender and Sexuality Law at Columbia University, predicted the decision would

be “a green light for people to engage in what was previously understood as discrimination . . . People feel that they now are immune from any kind of consequences for engaging in that kind of violent bigoted speech.”

U.S. Supreme Court

Case: *Counterman v. Colorado*, 143 S.Ct. 2106 (decided June 27, 2023).

Subject: To establish a “true threat,” the state must prove recklessness by demonstrating that the defendant had a subjective understanding of the statement’s threatening nature.

Summary: Coles Whalen is a Denver-based singer-songwriter who performs country and pop music. She has toured in the United States and Canada, released six albums, and performed almost a thousand shows. In 2014, Billy Raymond Counterman began sending Whalen unsolicited and unwanted messages on Facebook. Some were prosaic (“Good morning sweetheart”), but others implied he was stalking her (“Was that you in the white Jeep?”) or that they were engaged in a personal relationship (“I am going to the store would you like anything?”).

Afraid to engage with Counterman, Whalen ignored thousands of his posts and repeatedly blocked his social media accounts. He responded by creating new profiles, messaging Whalen through her website, and contacting her friends and bandmates. The messages continued until the Spring of 2016 when Counterman told Whalen to “Fuck off permanently,” that “Staying in cyber life is going to kill you,” and that “You’re not good for human relations. Die.”

Fearing for her personal safety and well-being, Whalen hired an attorney. After discovering that Counterman had two convictions for stalking and threatening women, she sought help from law enforcement. Counterman was arrested and charged with stalking under a Colorado statute that prohibits “repeatedly . . . making any form of communication with another person” in “a manner that would cause a reasonable person to suffer serious emotional distress and does cause that person . . . to suffer serious emotional distress.”

After a three-day trial, Counterman was convicted by an Arapahoe County jury and sentenced to four and a half years in prison. His attorneys appealed, claiming that Counterman’s posts were not true threats, which meant his speech was entitled to First Amendment protection. They argued that Counterman was mentally ill, that he never intended to harm Whalen, and that his illness prevented him from understanding that she might perceive his messages as threatening.

In rejecting Counterman’s claim, the Colorado Court of Appeals held that the conviction only requires proof that the speaker “knowingly” made repeated communications. It does not “require that a perpetrator be aware that his or her acts would cause a reasonable person so suffer serious emotional distress.” Applying this “objective ‘reasonable person’ standard,” the Court of Appeals concluded in July 2021, “Counterman’s messages were true threats—threats that are not protected speech under the First Amendment (or the state constitution). . . . Considered in context and under the totality of the circumstances, an intended or foreseeable recipient would reasonably perceive [the messages] as a serious expression of intent to commit an act of unlawful violence.” When the Colorado Supreme Court declined review, Counterman appealed to the U.S. Supreme Court.

In a 7–2 decision, the Supreme Court vacated Counterman’s conviction, announced a new standard for assessing “true threats,” and remanded the case to the lower courts. The majority

included the three liberal justices (Elena Kagan, Sonia Sotomayor, and Ketanji Brown Jackson) who were joined by Chief Justice John G. Roberts, Jr., along with Justices Brett M. Kavanaugh, Neil M. Gorsuch, and Samuel A. Alito, Jr. Justice Sotomayor wrote a concurring opinion that Justice Gorsuch joined. Justice Thomas wrote a dissenting opinion and also joined a dissenting opinion by Justice Barrett.

The majority opinion by Justice Elena Kagan noted that “courts are divided about (1) whether the First Amendment requires proof of a defendant’s subjective mindset in true threats cases, and (2) if so, what *mens rea* standard is sufficient.” When assessing what *mens rea* (level of intent or knowledge) standard should be employed, Justice Kagan suggested three options: purpose, knowledge, or recklessness.

If a purpose standard were applied, the state would need to prove a person “consciously desires a result . . . when he wants his words to be received as threats.” To prove purpose, the state must prove that Counterman intended for Whalen to feel threatened. A knowledge standard would require the state to prove that the speaker “is aware that a result is practically certain to follow.” To demonstrate knowledge, the state must prove that Counterman knew his speech was threatening. The final standard, recklessness, applies when the speaker “consciously disregards a substantial and justifiable risk that the conduct will cause harm to another.” This third standard, Justice Kagan explained, “involves insufficient concern with risk, rather than awareness of impending harm.” To prove recklessness, the state must convince the jury that Counterman was “aware that others would regard his statements as threatening violence and delivers them anyway.”

Justice Kagan concluded that the recklessness standard “offers the right path forward.” Though imperfect, it strikes the appropriate balance because “it offers enough ‘breathing space’ for protected speech without sacrificing too many of the benefits of enforcing laws against true threats. As with any balance, something is lost on both sides: The rule today is neither the most speech-protective nor the most sensitive to the dangers of true threats.”

The majority remanded the case to the lower courts because Counterman had been convicted under a reasonable-person standard. Justice Kagan noted that “the prosecution based its case solely on [Counterman’s] ‘repeated . . . communications’” with Whalen. To demonstrate recklessness, the state would need to convince the jury that Counterman was aware that his statements might be perceived as threatening.

Justice Sotomayor agreed with the judgment, but not the majority’s reasoning. Because Counterman’s behavior involved stalking, she argued, the Court should leave for “another day the question of the specific means required to prosecute true threats generally.” In a “climate of intense polarization,” she warned, “it is dangerous to allow criminal prosecution for heated words based solely on an amorphous recklessness standard.” Instead, she urged lower courts to apply the actual malice standard in *New York Times v. Sullivan* to define recklessness in true-threat prosecutions. “The equivalent to *Sullivan* for true threats,” she explained, “would require a high degree of awareness that a statement was probably threatening or serious doubts as to the threatening nature of the statement.”

In her dissenting opinion, Justice Barrett argued that true threats are not worthy of First Amendment protection because they “carry little value and impose great cost.” She claimed the majority “unjustifiably grants true threats preferential treatment” and makes it more difficult for authorities to prosecute menacing speech. “A delusional speaker may lack awareness of the threatening nature of her speech; a devious speaker may strategically disclaim such awareness; and a lucky speaker may leave behind no evidence of mental state for the

government to use against her,” she warned. “The Court’s decision thus sweeps much further than it lets on.”

The decision in *Counterman v. Colorado* produced mixed reviews from scholars. “This is a sensible approach to addressing the issue of threatening messages,” Erwin Chemerinsky, dean of the University of California at Berkeley School of Law, wrote. “The justices found the right middle ground, balancing the need to protect people who fear for their safety against opening the door to more prosecutions for pure expression.” Other commentators complained that the Supreme Court was more concerned with protecting speakers such as Counterman than victims such as Whalen. Mary Anne Franks, a law professor at the University of Miami, warned, “Justice Elena Kagan’s majority opinion focused not on the life-threatening, objectively reasonable, statistically documented fear and silencing of stalking victims, but on the hypothetical fear of hypothetical speakers whose speech could hypothetically be mistaken for threats.”

Chapter 4: Defamation

The Supreme Court’s *New York Times v. Sullivan* decision (1964) has been celebrated as a landmark decision. Justice Brennan’s majority opinion held that “shielding criticism of official conduct” was “the central meaning of the First Amendment.” To create the “breathing space” required for free speech, he embraced “the principle that debate on public issues should be uninhibited, robust, and wide-open, and that it may well include vehement, caustic, and sometimes unpleasantly sharp attacks on government and public officials.”

The Supreme Court has not heard a press freedom case in 20 years, but there might be some interest in revisiting *New York Times v. Sullivan*. In two cases where the Court declined to hear appeals involving unsuccessful defamation claims, two sitting justices, Clarence Thomas and Neil M. Gorsuch, have independently called on the Court to reconsider the actual malice standard. Justice Thomas called on the Supreme Court to overrule the *Times-Sullivan* decision because it could not be reconciled with the “original intent of the Framers.” Justice Gorsuch thought the “media landscape” had changed and argued that the justices should reconsider the *Times-Sullivan* decision to see whether the actual malice test was too speech protective.

Under the unwritten “rule of four,” the Supreme Court only grants a petition for review if there are four votes to do so. Granting certiorari would not obligate the justices to overrule *Times v. Sullivan*, as the Court could soften the protection provided by the actual malice rule to alleviate concerns that Justice Gorsuch identified. Some critics have suggested, for example, replacing the actual malice standard with a “highly unreasonable conduct” standard. Weakening the standard would, they argue, make it easier for plaintiffs to prevail in defamation suits.

Given the ongoing concerns with *Times v. Sullivan*, there was considerable interest in two defamation cases in 2023 that involved public figures and the actual malice rule. Neither lawsuit reached the Supreme Court, but the outcomes illustrate why *Times v. Sullivan* is considered a momentous decision. In the words of British Historian Timothy Garton Ash, it is “probably the most influential judgment in modern First Amendment jurisprudence.”

Case: Out of Court Settlement in *Dominion Voting Systems v. Fox News Network*.

Dominion Voting Systems sued Fox News Network for defamation in March 2021, alleging that Fox News hosts and guests had falsely claimed that Dominion’s voting machines had been

rigged to steal the 2020 presidential election for Joe Biden, and seeking 1.6 billion in damages. The Fox News claims repeated part of then-President Trump's effort to remain in power.

Fox sought to have the case dismissed, but Delaware Superior Court Judge Eric M. Davis ruled that the statements at issue were false and ordered a trial to determine whether the network had acted with actual malice. Dominion used the discovery process to acquire internal Fox communications and to depose executives, hosts, and employees. As the trial date approached, several prominent media lawyers suggested Dominion might be able to prove Fox News acted with actual malice, the standard set out in *Times v. Sullivan*. Lyrisa Lidsky, a constitutional law professor at the University of Florida observed, "Dominion would potentially have a strong case against the former President for making defamatory and false statements about them with reckless disregard for the truth, though the ultimate success of that case might depend on a jury's evaluation of witness credibility."

On April 18, 2023, after the jury had been selected and sworn in, Judge Davis announced that the parties had reached an out-of-court settlement. Under the terms of the agreement, the Fox News Network agreed to pay Dominion \$787.5 million in damages, one of the largest defamation settlements in U.S. history. Fox was not required to apologize, but it released the following statement: "We acknowledge the Court's rulings finding certain claims about Dominion to be false. This settlement reflects Fox's continued commitment to the highest journalistic standards."

"This is an example of how plaintiffs can win—and win big—under the actual malice standard," said Rodney A. Smolla, a law professor and one of the Dominion's attorneys. "This takes some of the oxygen out of that argument [that libel cases are unwinnable]." If the case had gone to trial, the jury would have been forced to decide whether Fox had acted with actual malice. If the jury had found in favor of Dominion, Fox could have been required to pay billions in damages. A decision favoring Fox would have raised questions about whether the actual malice rule makes it almost impossible to hold the media accountable for reckless and damaging lies.

Case: E. Jean Carroll Wins Lawsuit against Former President Donald J. Trump.

In 2019, author E. Jean Carroll accused then-President Trump of sexually assaulting her in 1996, an allegation that Trump vehemently denied. Later that year, Carroll sued Trump for defamation, alleging that he had damaged her reputation, harmed her professionally, and caused emotional pain. Because Trump had denied the allegations during his presidency, the Department of Justice (DOJ) asserted that he was responding in an official capacity and that, under the Federal Tort Claims Act, the DOJ had the authority to defend him and to move the trial from state to federal court. That lawsuit, called *Carroll 1*, has been tied up in appeals while this claim is resolved.

After leaving office, Trump published a lengthy post on Truth Social, his social media platform, denouncing Carroll and calling her allegations "a complete con job" and a "hoax and a lie, just like all the other hoaxes that have been played on me for the past seven years." Carroll filed a second lawsuit, called *Carroll 2*, claiming the post defamed her. This lawsuit also included a civil battery charge that was possible because New York state had adopted an Adult Survivors Act, allowing victims a special one-year window to sue for sexual abuse even if the statute of limitations for criminal charges had expired.

The *Carroll 2* trial started on April 25, 2023. The jurors reached a unanimous decision on May 9, 2023, after three hours of deliberation. Based on the preponderance of the evidence,

they found that Carroll had not proven that Trump raped her (which requires proof of penetration), but that he had sexually abused her (which requires touching the genitals without consent) and had defamed her when he falsely denied assaulting her. Applying the actual malice rule set out in *Times v. Sullivan*, the jury also found that Carroll had offered clear and convincing evidence that Trump's statements were false, and that he either knew they were false or acted with a reckless disregard for the truth. The jury awarded Carroll \$5 million in damages: \$3 million for proving her defamation claim, and \$2 million for her civil battery claim.

Further developments have occurred in both *Carroll 1* and *Carroll 2*. In *Carroll 1*, the DOJ reversed itself, announcing that "it lacks adequate evidence to conclude that the former President was sufficiently actuated by a purpose to serve the United States Government to support a determination that he was acting within the scope of his employment when he denied sexually assaulting Ms. Carroll and made the other statements regarding Ms. Carroll that she has challenged in this action." This announcement clears the way for *Carroll 1* to go to trial in January 2024.

The decision in *Carroll 2* produced another round of legal wrangling. Trump appealed the jury verdict, asking the judge to order a new trial or reduce the damages. Judge Lewis A. Kaplan declared the appeal "unpersuasive," noting that "the jury's unanimous verdict was almost entirely in favor of Ms. Carroll." Meanwhile, Carroll moved to amend the complaint in *Carroll 1*, arguing that Trump had made more defamatory statements when he criticized the *Carroll 2* decision. Trump subsequently sued Carroll for defamation after a CNN interview about the jury's decision, in which she said Trump had raped her. This claim was defamatory, the lawsuit argued, because the jury had found him liable for sexual assault, not rape. Judge Kaplan dismissed this suit on August 7, 2023, writing, "Indeed the jury's verdict in *Carroll II* establishes, as against Mr. Trump, the fact that Mr. Trump 'raped her,' albeit digitally rather than with his penis." Trump's attorney immediately announced plans to appeal the judge's decision.

An Organizational Note about *Twitter, Inc. v. Taamneh* and *Gonzalez v. Google LLC*

The Supreme Court heard oral arguments in two cases concerning whether social media companies are liable for content that third parties post on their platforms. The cases deal with acts of international terrorism, but also raise questions about Section 230 of the Communications Decency Act of 1996, the statute that protects companies such as Facebook, Twitter, and Google from most liability for third-party content that appears on their platforms. Although dozens of lower court decisions deal with Section 230, the Supreme Court has never ruled on the protection that it confers.

Twitter, Inc. v. Taamneh and *Gonzalez v. Google LLC* also reach some of the same questions that defamatory speech raises. To what extent do social media companies bear legal responsibility for the content shared on their platforms? Are companies responsible if they fail to remove defamatory or dangerous content? These two cases also raise new questions. Are social media companies liable for recommendations made by algorithms that direct users to dangerous content? What role should humans play in determining what content is recommended?

U.S. Supreme Court

Case: *Twitter, Inc. v. Taamneh*, 143 S Ct. 1206 (decided May 18, 2023).

Subject: A social media company did not “knowingly” aid and abet ISIS in its terrorist attack on a nightclub in Istanbul.

Summary: A Jordanian citizen, Nawras Alassaf, was one of 39 people killed in a terrorist attack on the Reina nightclub in Istanbul on January 1, 2017. The terrorist organization known as the Islamic State of Iraq and Syria (ISIS) claimed responsibility. Instead of targeting ISIS, the Taamneh family, relatives of Nawras Alassaf, sued three of the largest social media companies: Facebook, Twitter (rebranded as X), and Google (which owns YouTube) under 18 U.S. Code Section 2333, the Antiterrorism Act, which permits U.S. nationals who have been “injured . . . by reason of an act of international terrorism” to file a civil suit for damages. The family alleged that the social media companies aided and abetted ISIS and were liable for the Reina attack because they knew that terrorists used their platforms and, despite extensive media coverage and government pressure, did not prevent ISIS from sharing content on their platforms.

A federal district court dismissed the complaint, but the Ninth Circuit Court of Appeals reversed, holding that the plaintiffs had a plausible case for aiding and abetting, and bore some liability for the Reina attack. The social media companies appealed to the Supreme Court, which granted certiorari.

Writing for a unanimous Court, Justice Clarence Thomas noted that “we generally do not think that internet or cell service providers incur culpability merely for providing their services to the public writ large. Nor do we think that such providers would normally be described as aiding and abetting, for example, illegal drug deals brokered over cell phones—even if the provider’s conference-call or video-call features made the sale easier.”

In an attempt to establish liability, the Taamneh family claimed the companies were aware of ISIS’ activities and had failed to stop the terrorists from using their platforms, but the lawsuit failed to prove a connection between the companies and the terrorists. In this case, Justice Thomas explained, “the nexus between defendants and the Reina attack is far removed.” To prove the point, he added that the companies’ “relationship with ISIS and its supporters appears to have been the same as their relationship with their billion-plus other users: arm’s length, passive, and largely indifferent.”

Although the plaintiffs failed in this case, Justice Thomas did not “rule out the possibility that some set of allegations involving aid to a known terrorist group would justify holding a secondary defendant liable for all of the group’s actions or perhaps some definable subset of terrorist acts.” To illustrate, he offered two scenarios: a company that provides routine services “in an unusual way or provides such dangerous wares that selling those goods to a terrorist group could constitute aiding and abetting a foreseeable terror attack,” and a platform that “consciously and selectively chose to promote content provided by a particular terrorist group.” In these circumstances, “the defendants would arguably have offered aid that is more direct, active, and substantial than what we review here.”

Justice Ketanji Brown Jackson added a two-paragraph concurring opinion, which stressed that the Court’s decision was “narrow in important respects.” Although she said there was insufficient evidence to proceed in this instance, she held out the possibility that “other cases presenting different allegations and different records may lead to different conclusions.”

U.S. Supreme Court

Case: *Gonzalez v. Google LLC*, 143 S.Ct. 1191 (decided May 18, 2023).

Subject: The Court declined to decide whether Section 230 of the Communication Decency Act immunized a computer service provider for recommendations made by an algorithm.

Summary: A U.S. citizen, Nohemi Gonzalez, was killed in a terrorist attack at La Belle Equipe Bistro in Paris on November 13, 2015. A day after the attack, the Islamic State of Iraq and Syria (ISIS), in a written statement and a YouTube video, claimed responsibility for a series of coordinated attacks in the French capital that resulted in 129 deaths. Gonzalez's parents and brothers sued Google (which owns and operates YouTube), alleging that it aided and abetted international terrorism because it allowed ISIS to use YouTube "to recruit members, plan terrorist attacks, issue terrorist threats, instill fear, and intimidate civilian populations." Google invoked Section 230 of the Communications Decency Act, which provides interactive computer services (such as YouTube, Google, Facebook, or Twitter) with immunity for information shared by third-party users.

The U.S. Court of Appeals for the Ninth Circuit held that Section 230 shields Google from liability for hosting third-party content, acknowledging that "There is no indication the drafters of Section 230 imagined the level of sophistication algorithms have achieved. Nor did they foresee the circumstance we now face, in which the use of powerful algorithms by social media websites can encourage, support, and expand terrorist networks." The court was unwilling to stand in for Congress, however: "Whether social media companies should continue to enjoy immunity for the third-party content they publish, and whether their use of algorithms ought to be regulated, are pressing questions that Congress should address."

The Gonzalez family appealed to the Supreme Court, focusing on how service providers recommend content to users. These recommendations are often made by automated algorithms that select material based on information the service provider has about the user. By tailoring recommendations to a specific user, the algorithms offer engaging content, keep users online, and maximize advertising revenue. According to one study, 70 percent of the time that users spend viewing YouTube is spent on algorithm-based recommendations. Because YouTube is actively curating content, the Gonzalez family argued that the Supreme Court should hold that "the protections of Section 230 are limited to a publisher's traditional editorial functions, such as whether to publish, withdraw, postpone or alter content provided by another, and do not additionally include recommending writings or videos to others."

The Supreme Court issued decisions in *Twitter v. Taamneh* and *Gonzalez v. Google* on May 18, 2023. The *Twitter* decision avoided Section 230 altogether, holding that the claims against the social media companies were not permitted under the Antiterrorism Act. In an unsigned per curiam opinion, the justices remanded *Gonzalez* to the Ninth Circuit with instructions to reconsider the case in light of the opinion in *Twitter*. The Court declined to address the application of Section 230 to a complaint "that appears to state little, if any, plausible claim for relief."

By declining to rule on the scope of Section 230, the *Twitter* and *Gonzalez* decisions preserved the status quo. Had either case imposed liability based on the social media companies' use of algorithms, it would have undercut the immunity provided by Section 230, forcing platforms to engage in much more content moderation. Patrick Toomey, deputy director of the ACLU's National Security Project, praised the decision: "Twitter and other

apps are home to an immense amount of protected speech, and it would be devastating if those platforms resorted to censorship to avoid a deluge of lawsuits over their users' posts."

Chapter 13: Copyright

U.S. Supreme Court

Case: *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 143 S.Ct. 1258 (decided May 18, 2023).

Subject: The commercial use of a Lynn Goldsmith photograph of Prince by the Andy Warhol Foundation is not transformative and is not a defense in copyright infringement.

Summary: While on assignment for *Newsweek* magazine in 1981, photographer Lynn Goldsmith took a series of portraits of Prince Rogers Nelson, a promising musician later known as Prince. The photographs were never published, but in 1984, *Vanity Fair* paid \$400 to license one of Goldsmith's black-and-white portraits for use in an article about the artist. Andy Warhol created a highly colorized work from that image, using Prince's head and a small portion of his neckline. Warhol's image, along with a story about the musician by Tristan Vox titled "Purple Fame," appeared in the November 1984 issue of *Newsweek*.

Goldsmith had granted permission for a single use in *Vanity Fair*, but Warhol created fifteen additional works, all variations on the same photograph. The result was the acclaimed Prince Series, which includes twelve silkscreen paintings, two screen prints on paper, and two drawings. After Warhol died in 1987, the Andy Warhol Foundation (AWF) transferred custody of the works to the Andy Warhol Museum, which licensed the images for editorial, commercial, and museum usage. When Goldsmith learned that the AWF had licensed Condé Nast to use one of the images, *Orange Prince*, she sought compensation from AWF. Instead of paying, AWF went to court seeking a declaratory judgment of noninfringement or alternatively, a ruling that the Prince Series was fair use.

Federal District Judge John G. Koeltl ruled in favor of the AWF, arguing that the Prince Series "transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure." Warhol's images "have a different character," giving them "an aesthetic and character different from the original." This change in quality explains why the image "is immediately recognizable as a 'Warhol' rather than as a photograph of Prince—in the same way that Warhol's famous representations of Marilyn Monroe and Mao are recognizable as 'Warhols,' not as realistic photographs of those persons." Because Warhol had transformed the portrait, the use of Goldsmith's copyrighted work was ruled a fair use and not copyright infringement.

The Second Circuit Court of Appeals disagreed, noting that "Warhol created the series chiefly by removing certain elements from the Goldsmith photograph, such as depth and contrast, and embellishing the flattened images with 'loud, unnatural colors.'" Although the "alterations may change the Goldsmith Photograph in ways that give a different impression of its subject, the Goldsmith Photograph remains the recognizable foundation upon which the Prince Series is built." The court rejected the claim that Warhol's distinctive images are original works: "Entertaining that logic would inevitably create a celebrity-plagiarist privilege; the more established the artist and the more distinct that artist's style, the greater leeway that artist would have to pilfer the creative labors of others."

AWF appealed to the Supreme Court, which granted certiorari but limited the case to whether the first fair-use factor—the purpose and character of the use, including whether such

use is commercial or for nonprofit educational purposes—weighed in favor of either party. Put more directly, the Court asked, was Warhol’s silkscreen a transformative use of Goldsmith’s photograph? In a 7-2 decision, the Court held that the Warhol images were not transformative and served the same commercial purpose: magazine art. The parties agreed that other fair use factors also favored Goldsmith, and the Court affirmed the Second Circuit decision.

Justice Sotomayor began the majority opinion by acknowledging that the case involved the work of two artists, Andy Warhol and Lynn Goldsmith. Warhol’s work is famous, but “Goldsmith’s original works, like those of other photographers, are entitled to copyright protection, even against famous artists.” There are limits on this protection, however. Taking from a copyrighted work might be fair use, Justice Sotomayor explained, “if, among other things, the use has a purpose and character that is sufficiently distinct from the original.” In this instance, “Goldsmith’s original photograph of Prince, and AWF’s copying use of that photograph in an image licensed to a special edition magazine devoted to Prince, share substantially the same purpose, and the use is of a commercial nature.”

By narrowly focusing on AWF’s attempt to license *Orange Prince* for a commercial purpose, rather than the originality of Warhol’s art, Justice Sotomayor skirted the question of whether Warhol transformed Goldsmith’s photograph. It was enough, she said, that *Orange Prince* served “substantially the same purpose” as Goldsmith’s original. Both images appeared in stories about Prince, and the use was clearly commercial. Because there was no dispute between the parties that the other fair use factors weighed in Goldsmith’s favor, the majority affirmed the Second Circuit decision.

Justice Gorsuch wrote a concurring opinion, joined by Justice Jackson, emphasizing that the question before the Court was “narrow,” limited to one of the four factors used to determine fair use. Relying on the statute’s language, he explained that “nothing in the law requires judges to try their hand at art criticism and assess the aesthetic character of the resulting work. Instead, the first statutory fair-use factor instructs courts to focus on ‘the purpose and character of *the use*, including whether *such use is of a commercial nature or is for nonprofit educational purposes*.’” He concluded that the case was a “comparatively modest inquiry focused on how and for what reason a person is using a copyrighted work . . . not on the moods of any artist or the aesthetic quality of any creation.”

In her dissenting opinion, joined by Chief Justice Roberts, Justice Kagan asserted that the majority approach was flawed: “Before today, we assessed ‘the purpose and character’ of a copier’s use by asking the following question: Does the work ‘add something new, with a further purpose or different character, altering the original with new expression, meaning, or message’? When it did so to a significant degree, we called the work ‘transformative’ and held that the fair-use test’s first factor favored the copier (though other factors could outweigh that one.” Instead of applying the transformative use test, the majority “holds that because Warhol licensed his work to a magazine—as Goldsmith sometimes also did—the first factor goes against him. It does not matter how different the Warhol is from the original photo—how much ‘new expression, meaning, or message’ he added.”

To Justice Kagan, “that doctrinal shift ill serves copyright’s core purpose,” fostering creativity. Instead of focusing on the AWF’s commercial licensing of the Goldsmith photograph, she would consider whether *Orange Prince* was itself a transformative use. Focusing on Warhol’s contribution is appropriate, she continued, because much artistry—be it visual, musical, or literary—draws on the work of others. Past precedent provided “‘breathing space’ for artists to use existing materials to make fundamentally new works, for the public’s

enjoyment and benefit.” In remaking the first factor’s focus on purposes and character and constricting fair use, Justice Kagan lamented, “the majority hampers creative progress and undermines creative freedom.”

The Supreme Court decision was a clear victory for copyright holders such as Goldsmith because it limits the transformative use doctrine. However, the magnitude of the victory will depend on how lower courts apply the decision. As the majority framed the case, it was a simple dispute over “portraits of Prince used to depict Prince in magazine stories about Prince.” Other infringement claims may be more complicated. For example, how much leeway does an artist have when borrowing from an existing work? If the original and secondary works have a similar purpose and character, the majority said it would require a “compelling justification” to conclude that a work is transformative, but the Court did not articulate a standard for making such an assessment.

U.S. Supreme Court

Case: *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 143 S.Ct. 1578 (decided June 8, 2023).

Subject: The humorous use of a trademark is not entitled to heightened First Amendment protection.

Summary: Jasper Newton “Jack” Daniel was born in 1850 and learned the distilling trade as a teenager. After he received an inheritance from his father’s estate, Daniel registered a distilling business, purchased land, and opened his distillery close to mineral-rich springs near Lynchburg, Tennessee. One of Daniel’s signature brands, Old No. 7, likely refers to the registration number that the federal government assigned to his distillery.

VIP Products manufacturers Silly Squeakers, chewable dog toys resembling popular beverage bottles, such as Doggie Walker, Dos Perros, Heini Sniff’n, Smella Arpa, and Mountain Drool. In July 2013, VIP introduced the Bad Spaniels Silly Squeaker, a toy similar in shape and size to a Jack Daniels whiskey bottle. The faux bottle had a black label with stylized white text and a white filigree border with the product’s name (Bad Spaniels) in a font and with an arch resembling those on a Jack Daniels label. Instead of the phrase “Old No. 7 Brand Tennessee Sour Mash Whiskey,” the label on the dog toy declares, “The Old No. 2. on your Tennessee Carpet.” The label on a Jack Daniel’s bottle claims the contents are 40 percent whiskey by volume; Bad Spaniels purports to be “43% poo” and “100% smelly.”

A tag attached to the Silly Squeaker states the dog toy is “not affiliated with Jack Daniel Distillery” and that it is intended as a parody intended “to conjure your imagination of a dog’s perspective of human brands” while “poking fun at a dog’s life in a way that your dog is sure to enjoy.” Executives at Jack Daniel’s Properties, Inc., (JDPI) did not find the toy amusing. In a lawsuit filed in 2014, the distillery claimed it held numerous trademarks, including Jack Daniel’s name and “Old No. 7,” the brand’s distinctive logo and stylized labels, and the recognizable shape of its bottles. In one of its briefs, JDPI explained its concern: “Jack Daniel’s loves dogs and appreciates a good joke as much as anyone. But Jack Daniel’s likes its customers even more, and doesn’t want them confused or associating its fine whiskey with dog poop.” The distiller argued that there was potential for confusion, as consumers might mistakenly believe JDPI produced or approved the dog toy. The distiller also asserted the Silly Squeaker diluted the Jack Daniel’s brand by associating its “famed whiskey with . . . dog excrement.”

After a four-day bench trial, a federal district judge ruled in favor of JDPI. Based on surveys commissioned by the distiller, the judge found that some consumers would likely

believe JDPI originated, sponsored, or approved the Silly Squeaker. In addition, the court held that the reference to “dog poo” tarnished Jack Daniel’s distinctive mark. The judge enjoined VIP “from sourcing, manufacturing, advertising, promoting, displaying, shipping, importing, offering for sale, selling or distributing the Bad Spaniels dog toy” to prevent future damage.

VIP appealed. The Ninth Circuit Court of Appeals reversed, holding that the Silly Squeaker qualified as a form of “artistic expression.” As such, the dog toy was protected speech unless JDPI could prove one of two requirements set out in *Rogers v. Grimaldi*, a 1989 Second Circuit decision. Under the *Rogers* test, a plaintiff must “show that the defendant’s use of the mark is either (1) ‘not artistically relevant to the underlying work’ or (2) ‘explicitly misleads consumers as to the source or content of the work.’” Acknowledging that the dog toy was “not the equivalent of the Mona Lisa,” the Ninth Circuit nonetheless held that it was “an expressive work” that satisfied the first element of the *Rogers* test because it communicated a “humorous message.” Concerning the second element, the appellate court held that the Silly Squeaker was easily distinguished from the Jack Daniels brand. “Although VIP used JDPI’s trade dress and bottle design to sell Bad Spaniels,” the Ninth Circuit concluded, the “humorous message” was “protected by the First Amendment.”

The Supreme Court has never embraced the *Rogers* test, and the justices rejected how the Ninth Circuit applied it in this instance. In a unanimous decision by Justice Elena Kagan, the Court held that the test does not apply when the alleged infringer uses a trademark “in the way the Lanham Act cares most about: as a designation of source for the infringer’s own goods.” Such a use was very different from using a trademark in a parody, as “consumers are not so likely to think that the maker of a mocked product is itself doing the mocking.” To illustrate this distinction, Justice Kagan offered the example of a song titled “Barbie Girl.” When the toymaker Mattel, which owns the trademark to the Barbie doll, sued for trademark infringement, the lawsuit failed because “a consumer would no more think that the song was ‘produced by Mattel’ than they would, ‘upon hearing Janis Joplin croon ‘Oh Lord, won’t you buy me a Mercedes Benz?’ . . . suspect that she and the carmaker had entered into a joint venture.” When lower courts have cited *Rogers*, it was strictly limited to products that use the mark in a “non-source identifying way.”

Having limited the *Rogers* test, Justice Kagan returned to the foundational principles of trademark law. Quoting a leading treatise, she noted the central function of trademarks is “to indicate the source of goods, and so to distinguish them from ones manufactured and sold by others.” “The cardinal sin under the law,” she continued, is to undermine the ability to determine the source of goods, and “confusion is most likely to arise when someone uses another’s trademark as a trademark . . . rather than for some other expressive function.” Thus, the Ninth Circuit was “mistaken to believe that the First Amendment demanded” protection for the Silly Squeaker. “When a mark is used as a mark,” Justice Kagan concluded, the requirement that the trademark owner provides evidence of a likelihood of confusion is sufficient to satisfy the “interest in free expression.”

The Supreme Court remanded the case to the lower courts to consider “whether the Bad Spaniels marks are likely to cause confusion.” The dog toy “conjures up” enough of the trademark to draw a connection to Jack Daniel, but to succeed, “the parody must also create contrasts, so that its message of ridicule or pointed humor comes clear.” If VIP can demonstrate that the dog toy communicates such a message, a lower court might conclude that “it is not often likely to create confusion.” Until the case is resolved, the Bad Daniels Silly Squeaker remains on the market.

The ruling was unanimous, but Justice Sonia Sotomayor wrote a concurring opinion, joined by Justice Samuel A. Alito, Jr., that showed some sympathy for parodies. When assessing research commissioned by trademark holders purporting to show that consumers might be confused by the infringing product, she encouraged lower courts not to give “uncritical or undue weight to surveys.” This skepticism was necessary, Justice Sotomayor explained, as “cleverly designed surveys could also prompt confusion,” which would give “well-heeled brands with the resources” for surveying consumers “an effective veto over mockery. After all, no one likes to be the butt of a joke, not even a trademark.”

Justice Gorsuch contributed a one-paragraph concurring opinion, in which Justices Thomas and Barrett joined. The majority did not embrace the *Rogers* test, but Justice Gorsuch encouraged lower courts to handle it “with care” as “it is not obvious that *Rogers* is correct in all its particulars.” He did not detail his concerns, concluding, “all this remains for another day . . . and lower courts should be attuned to that fact.”

Looking to the Future

The Supreme Court has already granted certiorari in two cases involving freedom of speech that will be heard during the upcoming 2023–2024 term, *Vidal v. Elster* and *O’Connor-Ratcliff v. Garnier*. Before deciding on a writ of certiorari for a third case, the justices asked the solicitor general, who represents the federal government in cases before the Supreme Court, for the federal government’s views on controversial Texas and Florida laws that bar social media companies such as Facebook and Twitter from censoring speech based on the speaker’s viewpoint. The case challenging the Texas law (known as House Bill 20) is *NetChoice v. Paxton*. The challenge to the Florida law (titled Stop Social Media Censorship Act) is *NetChoice v. Moody*.

The first case, *Vidal v. Elster*, involves a U.S. Patent and Trademark Office decision to deny a trademark request. The case started in 2018, when Steve Elster tried to register “Trump Too Small” and use the trademark on T-shirts he planned to sell. The phrase refers to a comment by Senator Marco Rubio in a campaign speech during the 2016 Republican presidential primaries. Responding to opposing candidate Donald Trump’s repeated use of the condescending nickname “little Rubio,” he admitted that he was shorter than Trump. Pausing for effect, he then quipped that Trump had small hands for his height, adding, “and you know what they say about guys with small hands. You can’t trust ‘em.” (Trump responded during a televised debate several days later. “Look at those hands, are they small hands?” After showing his hands to the audience, Trump added, “And he referred to my hands— ‘if they’re small, something else must be small.’ I guarantee you there’s no problem. I guarantee.”)

The U.S. Patent and Trademark Office (USPTO) denied the application, citing Section 1052(c) of the Lanham Act, which prohibits federal registration of any trademark that “consists of or comprises a name . . . identifying a particular living individual except by his written consent,” or the name “of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.” Elster appealed to the Trademark and Trial Appeal Board (TTAB), which upheld the denial because the mark identified the former president without permission. Having exhausted his appeals with the agency, Elster sued Kathi Vidal, the Under Secretary of Commerce for Intellectual Property and Director of the USPTO, in federal court.

The U.S. Court of Appeals for the Federal Circuit reversed the TTAB’s decision. In a unanimous decision, the court noted that Elster’s trademark involved criticism of a government

official, “speech that is otherwise at the heart of the First Amendment.” Neither interest identified by the government, privacy and the right of publicity, justified denying Elster’s request for a trademark. Concerning the privacy interest, the Appellate Court explained, “There can be no plausible claim that President Trump enjoys a right of privacy protecting him from criticism in the absence of actual malice—the publication of false information ‘with knowledge of its falsity or in reckless disregard of the truth.’” The right of publicity was more complicated, but the Appellate Court noted that “the government has no valid publicity interest that could overcome the First Amendment protections afforded to the political criticism embodied in Elster’s mark. As a result of Trump’s status as a public official, and because Elster’s mark communicates his disagreement with and criticism of the then-President’s approach to governance, the government has no interest in disadvantaging Elster’s speech.” Having dispensed with both interests, the court concluded the “application of section 2(c) to Elster’s mark is unconstitutional under any conceivable standard of review.”

The United States appealed the Federal Circuit’s decision to the Supreme Court, noting that “No one doubts that political speech is ‘at the heart’ of what the First Amendment protects . . . Section 1052(c) is not a restriction on speech; it is a viewpoint-neutral condition on a government benefit. The refusal under Section 1052(c) to register marks, like respondent’s, that criticize a government or public figure does not ‘limit’ political speech.” In other words, according to the government’s petition for writ of certiorari, Elster is free to discuss Trump’s physique and criticize policies, but he is not entitled to trademark his criticism, and the Appeals Court erred in holding that the refusal to register a mark that included Trump’s name violated the First Amendment.

The government argued that the justices should take the case because the Supreme Court routinely grants review when a court of appeals invalidates the application of a federal statute. It pointed to two cases involving the denial of a trademark on First Amendment grounds. In *Metal v. Tan* (2017), the Court had considered the decision to deny a trademark to “The Slants,” the name of an Asian American rock band, because the trademark would disparage persons of Asian descent. Although the decision was splintered, the justices agreed on the key point: The prohibition on trademarks that disparage members of racial or ethnic groups violated the First Amendment. In *Iancu v. Brunetti* (2019), the Court had considered the decision to deny a trademark to a line of clothing sold under the brand name “FUCT.” On a 6-to-3 decision, the justices held that the ban on “immoral or scandalous” trademarks constituted viewpoint discrimination and violated the First Amendment.

In its petition, the government distinguished *Vidal v. Elster* from the previous cases. “Unlike *Metal* and *Iancu*,” it argued, “the Lanham Act provision at issue ‘does not involve viewpoint discrimination;’” and Section 1052(c) does not restrict speech because it is disparaging, immoral, or scandalous. Rather, it “makes unavailable the commercial benefits the federal registration of a mark entails. The determination whether and under what circumstances a particular mark may be used is controlled by other provisions of federal and state law.” The Supreme Court should take the case, the petition concluded, because it “cleanly presents the question whether a viewpoint-neutral bar on the registration of a trademark is ‘a condition on a government benefit or a simple restriction on speech.’”

The Supreme Court granted the petition and scheduled oral arguments for Fall 2023, with a decision likely in mid-2024. The case bears watching, as it will require the justices to revisit the tension between trademark law and the First Amendment evident in *Metal* and *Iancu*.

The second case the justices agreed to hear, *O'Connor-Ratcliff v. Garnier*, consolidates a pair of lawsuits filed against public officials who blocked access to the social media accounts they use to communicate with the public. One suit involved Michelle O'Connor-Ratcliff and T.J. Zane, elected school board members for the Poway Unified School District, a few miles north of San Diego. When they ran for their positions in November 2014, the candidates opened Facebook and Twitter accounts to promote their candidacies. After they were elected, they continued to use their personal social media accounts for public communication. To their chagrin, two parents, Christopher and Kimberly Garnier, posted hundreds of repetitive comments voicing their concerns about race relations in the school district. After deleting or hiding the comments, O'Connor-Ratcliff and Zane grew frustrated and blocked the Garniers from posting on their accounts. The Garniers sued, arguing that the school board members violated the First Amendment when they blocked specific community members from social media pages related to the school board members' duties.

The companion case, *Lindke v. Freed*, had similar facts. James R. Freed, the city manager of Port Huron, Michigan, used his Facebook account to comment on various subjects. In his profile, he identified himself as "Daddy to Lucy, Husband to Jessie and City Manager, Chief Administrative Officer for the citizens of Port Huron, MI." Many of his posts involved purely personal matters, but he also posted on political issues, such as the city's response to COVID-19. Kevin Lindke, a Port Huron resident, disapproved of how Freed handled the pandemic and posted disparaging comments. Freed deleted the criticism and eventually blocked Lindke. Like the Garniers, Lindke sued, arguing that preventing access violated his First Amendment rights.

The cases produced contradictory results. In *O'Connor-Ratcliff v. Garnier*, in a unanimous decision, the Ninth Circuit Court of Appeals ruled in favor of the Garniers, emphasizing that "social media will continue to play an essential role in hosting public debate and facilitating the free expression that lies at the heart of the First Amendment." Although the school district did not create, control, or fund the content, O'Connor-Ratcliff and Zane included their school board titles on their pages and shared school-district business and news with the public. "When state actors enter that virtual world and invoke their government status to create a forum for such expression," the court concluded, "the First Amendment enters with them." In *Lindke v. Freed*, however, in another unanimous decision, the Sixth Circuit Court of Appeals came to the opposite conclusion, ruling in favor of Freed. The city manager "did not operate his page to fulfill any actual or apparent duty of his office," the court explained. "And he didn't use his governmental authority to maintain it. Thus, he was acting in his personal capacity—and there was no state action. James Freed didn't transform his personal Facebook page into official action by posting about his job. Instead, his page remains personal."

The losing party in each case appealed to the Supreme Court. Given the conflict between the Sixth and Ninth Circuits' decisions, it was not surprising that the Supreme Court agreed to hear the case. To reconcile the decisions, the justices must determine when a public official's social media activity becomes state action subject to the First Amendment, and thus determine when personal social media accounts become official accounts.

The first time the Supreme Court considered whether government officials can block people from accessing a social media account they use to communicate with the public was in 2019, in *Knight Institute v. Trump*. The Knight First Amendment Institute and seven individuals sued when then-President Trump blocked them from the @realDonaldTrump Twitter account because they criticized his presidency and policies. In a unanimous decision,

the Second Circuit Court of Appeals held that blocking critics violated the First Amendment. “Once the President has chosen a platform and opened up its interactive space to millions of users and participants,” the court noted, “he may not selectively exclude those whose views he disagrees with.” Trump appealed to the Supreme Court in August 2020, but Joe Biden was elected president before the justices could consider his appeal. On January 19, 2021, the Justice Department asked the Court to declare the Second Circuit decision moot. To close the books, the Supreme Court vacated the decision and remanded *Knight First Amendment Institute v. Trump* back to the Second Circuit on April 5, 2021.