

NYSBA

FALL/WINTER 2017 | VOL. 28 | NO. 3

# Entertainment, Arts and Sports Law Journal



A publication of the Entertainment, Arts and Sports Law Section  
of the New York State Bar Association



[www.nysba.org/EASL](http://www.nysba.org/EASL)

## Remarks from the Chair

I am pleased to report that EASL continues to expand its offerings and scope, thanks to 19 increasingly active committees and the exemplary efforts of our Executive Committee members and committee co-chairs. This fall, we reached across the pond, inviting **Neil Adleman** of Harbottle & Lewis LLP (London) to compare and contrast the legal and business issues for West End and Broadway productions, titled *London's West End and Broadway—Worlds Apart (Or Not)*. Thanks to our Theatre and Performing Arts Committee Co-Chair **Jason Baruch**, the program, held at the Mary Rogers Room at the Dramatist's Guild, was innovative, informative, and well-attended. EASL also partnered with the Food, Drug and Cosmetic Law Section to produce a variety panel program with three components: *Inside Auction Houses—Legal Issues* (created by our Fine Arts Committee), *Law and Business of Food Trucks*, and *Celebrity Endorsements—Legal Considerations*. Registrants had the option of attending one, two, or all three panels. With this inventive success, we will continue to be creative in our program planning and partnering with other Sections to diversify our offerings.

Rounding out our fall events, we concluded with our annual Music Business Law Conference at New York Law School. EASL has been offering this program for a number of years, and each year our attendance numbers grow thanks to the tireless efforts of our core committee members: **Marc Jacobson, Steve Rodner, Joyce Dollinger, Andy Seiden, Paul LiCalsi, Chris Hull, Rosemarie Tully, and yours truly**. This year a panel on *Licensing Music for Broadway* made its debut to a welcoming audience, and

edgy topics, such as *Global Database issues* and *Music Publishing and Digital Media*, served to foster an opportunity for animated dialogue and debate among attendees.

On January 23, 2018, our Annual Meeting programming will focus on legal aspects of how, when and where audio and visual entertainment content and related services are provided, through a panel entitled *Audio-Visual Distribution in the 21st Century*. We will also be partnering with the Intellectual Property (IP) Law Section for our post-program reception later that day. The Annual Meeting will provide a variety of opportunities to connect with your EASL colleagues and make new acquaintances with our IP colleagues.

Please consider this a heartfelt invitation to our members to continue to join us and participate further in our ongoing efforts to bring all things related to law and entertainment, arts and sports into your professional lives, and for those who are interested and curious, to become members!!!

All the Best,  
Diane Krausz



## Editor's Note

The Trump administration changes rules and regulations at a rapid pace. We at the *EASL Journal* are doing everything that we can to keep you abreast of how these changes affect the entertainment, arts and sports law worlds. For more regular updates between *Journals*, please visit the EASL Blog, available at <http://nysbar.com/blogs/EASL/>.

I look forward to hearing comments and to receiving submissions from you. Enjoy reading!

Elissa D. Hecker practices in the fields of copyright, trademark and business law. Her clients encompass a



large spectrum of the entertainment and corporate worlds. In addition to her private practice, Elissa is also a Past Chair of the EASL Section, Co-Chair and creator of EASL's Pro Bono Committee, Editor of the EASL Blog, Editor of *Entertainment Litigation, Counseling Content Providers in the Digital Age*, and *In the Arena*, a member of the Board of Editors for the *NYSBA Bar Journal*, Chair of the Board of Directors for Dance/NYC, a Trustee and member of the Copyright Society of the U.S.A (CSUSA), former Co-Chair of CSUSA's National Chapter Coordinators, and Associate Editor and member of the

Board of Editors for the *Journal* of the CSUSA. Elissa is a repeat Super Lawyer, Top 25 Westchester Lawyers, and recipient of the CSUSA's inaugural Excellent Service Award. She can be reached at (914) 478-0457, via email at [eheckeresq@eheckeresq.com](mailto:eheckeresq@eheckeresq.com) or through her website at [www.eheckeresq.com](http://www.eheckeresq.com).

The next *EASL Journal* deadline  
is Friday, December 29, 2017

# Table of Contents

	Page
Remarks from the Chair.....	2
Editor’s Note .....	2
Pro Bono Update.....	4
What’s Happening at EASL?.....	4
Law Student Initiative Writing Contest.....	6
The Phil Cowan Memorial/BMI Scholarship Writing Competition .....	7
NYSBA Guidelines for Obtaining MCLE Credit for Writing.....	9
TELEVISION AND RADIO COMMITTEE: Television and Radio Law in the 21st Century, at the Legal Age of Maturity in New York State .....	11
(Barry Skidelsky)	
SPORTS AND ENTERTAINMENT IMMIGRATION: A Brief Overview of Immigration Policy and Activities Under the Trump Administration from January 20, 2017 to Present Day .....	20
(Michael Cataliotti)	
RESOLUTION ALLEY: Arbitration of Art and Cultural Heritage Disputes.....	31
(Theodore K. Cheng)	
HOLLYWOOD DOCKET: Making the Perfect Pitch.....	34
(Neville L. Johnson and Douglas L. Johnson)	
All’s Fair (Use) in Love and Trademarks.....	38
(Cheryl Davis)	
By Inviting Canadian and Mexican Schools, the NCAA May Be Forfeiting on Amateurism .....	42
(Jason Chung)	
EASL Annual Music Business and Law Conference Meeting Photos.....	44
Join an EASL Committee .....	46
Tax Trick: Why the New York Rangers Will Be the Away Team for the 2018 Winter Classic.....	53
(Daniel S. Greene)	
Appropriation at Augusta: An Illustration of the Battle Over the Publicity Right and the First Amendment...59	
(Ryan Hersh)	
The Law Goes to Broadway.....	67
(Bennett Liebman)	
KRELL’S KORNER: There Was Once a Ballpark—Mourning the Dodgers, Meeting the Mets, William Shea, and the Rise and Fall of the Continental League.....	75
(David Krell)	
The Entertainment, Arts and Sports Law Section Welcomes New Members .....	83
Section Committees and Chairpersons.....	84
Section Officers and Editor.....	86

# Pro Bono Update

By Elissa D. Hecker, Carol Steinberg, Kathy Kim and Irina Tarsis  
Pro Bono Steering Committee

## Clinics

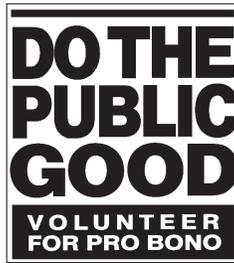
Our next Clinic will take place on Sunday, February 25th in conjunction with the IP Section, at Dance/NYC's Annual Symposium, held at the Gibney Dance Center. Stay tuned for more information.

\*\*\*\*\*

## Clinics

Elissa D. Hecker and Kathy Kim coordinate legal clinics with various organizations.

- Elissa D. Hecker, eheckeresq@eheckeresq.com
- Kathy Kim, KathyK@productions101.com



## Speakers Bureau

Carol Steinberg coordinates Speakers Bureau programs and events.

- Carol Steinberg, elizabethcjs@gmail.com or www.carolsteinbergesq.com

## Litigations

Irina Tarsis coordinates pro bono litigations.

- Irina Tarsis, tarsis@gmail.com

We look forward to working with all of you, and to making pro bono resources available to every EASL member.

## WHAT'S HAPPENING AT EASL?

### Entertainment, Arts and Sports Law Section Blog

The Blog provides a Forum and News Source on Issues of Interest. The Blog acts as a new informational resource on topics of interest, including the latest Section programs and initiatives, as well as provides a forum for debate and discussion to anyone in the world with access to the Internet. It is available through the New York State Bar Association website at <http://nysbar.com/blogs/EASL>

To submit a Blog entry, email Elissa D. Hecker at [eheckeresq@eheckeresq.com](mailto:eheckeresq@eheckeresq.com)

### EASL Member Community

*What Are Member Communities?*

The member communities are private, online professional networks, built on the concept of listserves that offer enhanced features such as collaboration tools and document libraries. They offer you a variety of tools to help you connect, network and work collaboratively with fellow NYSBA members.

To participate, each member has a profile based on their basic membership information. You can enhance your profile by adding your photo, professional affiliations, volunteer activities and other accomplishments. You have the option to pull information from your LinkedIn profile, or even link to your personal blog or other social media feeds.

*How Can I Use It?*

Seamlessly integrated with [nysba.org](http://nysba.org), no additional login or password is needed to enter a community. You just need to be a NYSBA member.

Just like a listserv, members of a specific community can share information with one another using email. Documents are emailed among members using links as opposed to email attachments, as attachments can be problematic with spam filters or limits on file size. Members can receive community emails as the messages are posted, or in digest form. These resource libraries have no space limitations, accept all file types, and can be organized using folders. Any member of a community can contribute to the library.

If you are a member of a NYSBA Section, Committee or Task Force, and working to develop a report, white paper, policy change or recommendation, an online community is the perfect forum for you and your colleagues. You have a dedicated space designed to facilitate an efficient and collaborative work effort, find us at [www.nysba.org/easlcommunity](http://www.nysba.org/easlcommunity).

# *Pro Bono Opportunities Guide*

**[www.nysba.org/probono](http://www.nysba.org/probono)**

*Want to volunteer?*

This easy-to-use guide will help you find the right volunteer pro bono opportunity. You can search by county, subject area, and population served.



**N Y S B A**  
**DO THE**  
**PUBLIC**  
**GOOD**  
**VOLUNTEER**  
**FOR PRO BONO**

*Questions about  
pro bono service?*  
[www.nysba.org/probono](http://www.nysba.org/probono)  
(518) 487-5641  
[probono@nysba.org](mailto:probono@nysba.org)



The New York State Bar Association  
Entertainment, Arts and Sports Law Section  
**Law Student Initiative  
Writing Contest**

The Entertainment, Arts and Sports Law (EASL) Section of the New York State Bar Association offers an initiative giving law students a chance to publish articles both in the *EASL Journal* as well as on the EASL Web site. The Initiative is designed to bridge the gap between students and the entertainment, arts and sports law communities and shed light on students' diverse perspectives in areas of practice of mutual interest to students and Section member practitioners.

Law school students who are interested in entertainment, art and/or sports law and who are members of the EASL Section are invited to submit articles. This Initiative is unique, as it grants students the opportunity to be *published and gain exposure* in these highly competitive areas of practice. The *EASL Journal* is among the profession's foremost law journals. Both it and the Web site have wide national distribution.

### Requirements

- **Eligibility:** Open to all full-time and part-time J.D. candidates who are EASL Section members. A law student wishing to submit an article to be considered for publication in the *EASL Journal* must first obtain a commitment from a practicing attorney (admitted five years or more, and preferably an EASL member) familiar with the topic to sponsor, supervise, or co-author the article. The role of sponsor, supervisor, or co-author shall be determined between the law student and practicing attorney, and must be acknowledged in the author's notes for the article. In the event the law student is unable to obtain such a commitment, he or she may reach out to Elissa D. Hecker, who will consider circulating the opportunity to the members of the EASL Executive Committee.
- **Form:** Include complete contact information, name, mailing address, law school, phone number and email address. There is no length requirement. Any notes must be in *Bluebook* endnote form. An author's blurb must also be included.
- **Deadline:** Submissions must be received by **Friday, December 29, 2017**.
- **Submissions:** Articles must be submitted via a Word email attachment to [echeckeresq@echeckeresq.com](mailto:echeckeresq@echeckeresq.com).

### Topics

Each student may write on the subject matter of his/her choice, so long as it is unique to the entertainment, art and sports law fields.

### Judging

Submissions will be judged on the basis of quality of writing, originality and thoroughness.

Winning submissions will be published in the *EASL Journal*. All winners will receive complimentary memberships to the EASL Section for the following year. In addition, the winning entrants will be featured in the *EASL Journal* and on our Web site.

# Phil Cowan Memorial/BMI Scholarship Writing Competition



Law students, take note of this publishing and scholarship opportunity: The Entertainment, Arts & Sports Law Section of the New York State Bar Association (EASL), in partnership with BMI, the world's largest music performing rights organization, has established the Phil Cowan Memorial/BMI Scholarship! Created in memory of Cowan, an esteemed entertainment lawyer and a former Chair of EASL, the Phil Cowan Memorial/BMI Scholarship fund offers *up to two awards of \$2,500 each on an annual basis* in Phil Cowan's memory to a law student who is committed to a practice concentrating in one or more areas of entertainment, art or sports law.

The Phil Cowan Memorial/BMI Scholarship has been in effect since 2005. It is awarded each year at EASL's Annual Meeting in January in New York City.

## The Competition

Each Scholarship candidate must write an original paper on any legal issue of current interest in the area of entertainment, art or sports law.

The paper should be twelve to fifteen pages in length (including *Bluebook* form footnotes), double-spaced and submitted in Microsoft Word format. **PAPERS LONGER THAN 15 PAGES TOTAL WILL NOT BE CONSIDERED.** The cover page (*not* part of the page count) should contain the title of the paper, the student's name, school, class year, telephone number and email address. The first page of the actual paper should contain only the title at the top, immediately followed by the body of text. The name of the author or any other identifying information must not appear anywhere other than on the cover page. All papers should be submitted to designated faculty members of each respective law school. Each designated faculty member shall forward all submissions to his/her Scholarship Committee Liaison. The Liaison, in turn, shall forward all papers received by him/her to the three (3)

Committee Co-Chairs for distribution. The Committee will read the papers submitted and will select the Scholarship recipient(s).

## Eligibility

The Competition is open to all students—*both J.D. candidates and L.L.M. candidates*—attending eligible law schools. "Eligible" law schools mean all accredited law schools within New York State, along with Rutgers University Law School and Seton Hall Law School in New Jersey, and up to ten other accredited law schools throughout the country to be selected, at the Committee's discretion, on a rotating basis.

## Free Membership to EASL

All students submitting a paper for consideration, who are NYSBA members, will immediately and automatically be offered a free membership in EASL (with all the benefits of an EASL member) for a one-year period, commencing January 1st of the year following submission of the paper.

## Yearly Deadlines

**December 12th:** Law School Faculty liaison submits all papers she/he receives to the EASL/BMI Scholarship Committee.

**January 15th:** EASL/BMI Scholarship Committee will determine the winner(s).

*The winner(s) will be announced, and the Scholarship(s) awarded at EASL's January Annual Meeting.*

## Submission

All papers should be submitted via email to Beth Gould at [bgould@nysba.org](mailto:bgould@nysba.org) no later than December 12th.

## Prerogatives of EASL/BMI's Scholarship Committee

The Scholarship Committee is composed of the current Chair of EASL and, on a rotating basis, former EASL Chairs who are still active in the Section, Section District Representatives, and any other interested member of the EASL Executive Committee. *Each winning paper will be published in the EASL Journal and will be made available to EASL members on the EASL website.* BMI reserves the right to post each winning paper on the BMI website, and to distribute copies of each winning paper in all media. *The Scholarship Committee is willing to waive the right of first publication so that students may simultaneously submit their papers to law journals or other school publications. In addition, papers previously submitted and published in law journals or other school publications are also eligible for submission to The Scholarship Committee.* The Scholarship Committee reserves the right to submit all papers it receives to the *EASL Journal* for publication and the EASL Web site. The Scholarship Committee also reserves the right to award only one Scholarship or no Scholarship if it determines, in any given year that, respectively, only one paper, or no paper, is sufficiently meritorious. All rights of dissemination of the papers by each of EASL and BMI are non-exclusive.

## Payment of Monies

Payment of Scholarship funds will be made by EASL/BMI directly to the law school of the winner, to be credited against the winner's account.

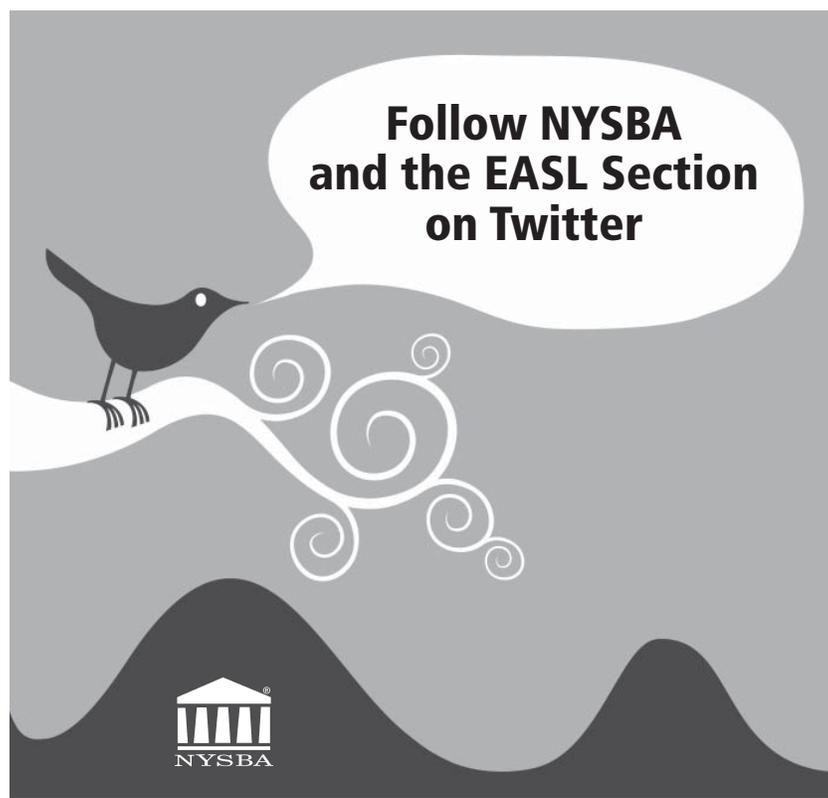
## About BMI

BMI is an American performing rights organization that represents approximately 700,000 songwriters, composers, and music publishers in all genres of music. The non-profit making company, founded in 1940 collects license fees on behalf of those American creators it represents, as well as thousands of creators from around the world who chose BMI for representation in the United States. The license fees BMI collects for the "public performances" of its repertoire of approximately 10.5 million compositions are then distributed as royalties to BMI-member writers, composers and copyright holders.

## About the New York State Bar Association/EASL

The 72,000-member New York State Bar Association is the official statewide organization of lawyers in New York and the largest voluntary state bar association in the nation. Founded in 1876, NYSBA programs and activities have continuously served the public and improved the justice system for more than 125 years.

The more than 1,500 members of the Entertainment, Arts and Sports Law Section of the NYSBA represent varied interests, including headline stories, matters debated in Congress, and issues ruled upon by the courts today. The EASL Section provides substantive case law, forums for discussion, debate and information-sharing, pro bono opportunities, and access to unique resources including its popular publication, the *EASL Journal*.



**Follow NYSBA  
and the EASL Section  
on Twitter**

**visit**

**[www.twitter.com/nysba](http://www.twitter.com/nysba)**

**and**

**[www.twitter.com/  
nysbaEASL](http://www.twitter.com/nysbaEASL)**

and click the link to follow us and stay up-to-date on the latest news from the Association and the Entertainment, Arts and Sports Law Section

# NYSBA Guidelines for Obtaining MCLE Credit for Writing

Under New York's Mandatory CLE Rule, MCLE credits may be earned for legal research-based writing, directed to an attorney audience. This might take the form of an article for a periodical, or work on a book. The applicable portion of the MCLE Rule, at Part 1500.22(h), states:

*Credit may be earned for legal research-based writing upon application to the CLE Board, provided the activity (i) produced material published or to be published in the form of an article, chapter or book written, in whole or in substantial part, by the applicant, and (ii) contributed substantially to the continuing legal education of the applicant and other attorneys. Authorship of articles for general circulation, newspapers or magazines directed to a non-lawyer audience does not qualify for CLE credit. Allocation of credit of jointly authored publications should be divided between or among the joint authors to reflect the proportional effort devoted to the research and writing of the publication.*

Further explanation of this portion of the rule is provided in the regulations and guidelines that pertain to the rule. At section 3.c.9 of those regulations and guidelines, one finds the specific criteria and procedure for earning credits for writing. In brief, they are as follows:

- The writing must be such that it contributes substantially to the continuing legal education of the author and other attorneys;
- it must be published or accepted for publication;
- it must have been written in whole or in substantial part by the applicant;

- one credit is given for each hour of research or writing, up to a maximum of 12 credits;
- a maximum of 12 credit hours may be earned for writing in any one reporting cycle;
- articles written for general circulation, newspapers and magazines directed at nonlawyer audiences do not qualify for credit;
- only writings published or accepted for publication after January 1, 1998 can be used to earn credits;
- credit (a maximum of 12) can be earned for updates and revisions of materials previously granted credit within any one reporting cycle;
- no credit can be earned for editing such writings;
- allocation of credit for jointly authored publications shall be divided between or among the joint authors to reflect the proportional effort devoted to the research or writing of the publication;
- only attorneys admitted more than 24 months may earn credits for writing.

In order to receive credit, the applicant must send a copy of the writing to the New York State Continuing Legal Education Board, 25 Beaver Street, 8th Floor, New York, NY 10004. A completed application should be sent with the materials (the application form can be downloaded from the Unified Court System's Web site, at this address: [www.courts.state.ny.us/mcle.htm](http://www.courts.state.ny.us/mcle.htm) (click on "Publication Credit Application" near the bottom of the page)). After review of the application and materials, the Board will notify the applicant by first-class mail of its decision and the number of credits earned.

NEW YORK STATE BAR ASSOCIATION

Looking for past issues?  
Entertainment, Arts and Sports Law Journal



[www.nysba.org/EASLJournal](http://www.nysba.org/EASLJournal)



# In The Arena: A Sports Law Handbook

*Co-sponsored by the New York State Bar Association and the Entertainment, Arts and Sports Law Section*

As the world of professional athletics has become more competitive and the issues more complex, so has the need for more reliable representation in the field of sports law. Written by dozens of sports law attorneys and medical professionals, *In the Arena: A Sports Law Handbook* is a reflection of the multiple issues that face athletes and the attorneys who represent them. Included in this book are chapters on representing professional athletes, NCAA enforcement, advertising, sponsorship, intellectual property rights, doping, concussion-related issues, Title IX and dozens of useful appendices.

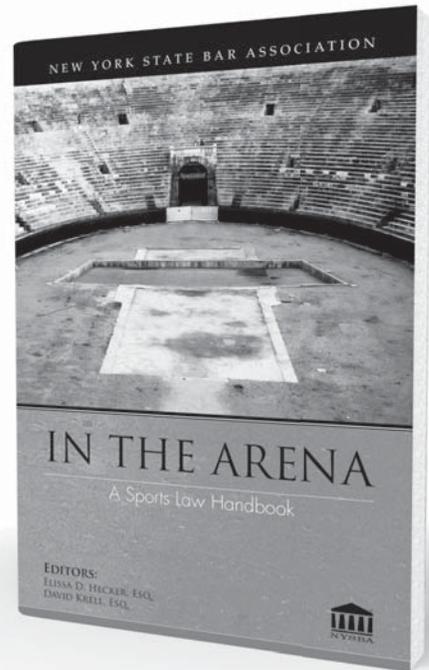
## Table of Contents

Intellectual Property Rights and Endorsement Agreements  
 How Trademark Protection Intersects with the Athlete's Right of Publicity  
 Collective Bargaining in the Big Three  
 Agency Law  
 Sports, Torts and Criminal Law  
 Role of Advertising and Sponsorship in the Business of Sports  
 Doping in Sport: A Historical and Current Perspective  
 Athlete Concussion-Related Issues  
 Concussions—From a Neuropsychological and Medical Perspective  
 In-Arena Giveaways: Sweepstakes Law Basics and Compliance Issues  
 Navigating the NCAA Enforcement Process  
 Title IX  
 Mascots: Handle With Care  
 An Introduction to European Union Sports Law  
 Dental and Orofacial Safety

## Get the Information Edge

1.800.582.2452    [www.nysba.org/pubs](http://www.nysba.org/pubs)

Mention Code: PUB8859N    \*Discount valid through February 8, 2018



### EDITORS

**Elissa D. Hecker, Esq.**  
**David Krell, Esq.**

### PRODUCT INFO AND PRICES

2013 | 539 pages | softbound  
 PN: 4002

Non-Members \$80  
**NYSBA Members \$65**

Order multiple titles to take advantage of our low flat rate shipping charge of \$5.95 per order, regardless of the number of items shipped. \$5.95 shipping and handling offer applies to orders shipped within the continental U.S. Shipping and handling charges for orders shipped outside the continental U.S. will be based on destination and added to your total.



# Television and Radio Law in the 21st Century, at the Legal Age of Maturity in New York State

By Barry Skidelsky

As 2017 ends and 2018 begins, electronic media continues to evolve, presenting new challenges and opportunities. The tempo of technological, economic and legal changes is *accelerando*, as the law and everyone from creators to consumers still struggle to adapt. This article provides an overview and update about a few key issues and developments, as well as some hopefully helpful context concerning 21st century television and radio.

Traditional media companies of every size have become multi-platform digital services, not only distributing information and entertainment content, but also providing e-commerce and other blossoming innovative services. They are facing intensifying and unprecedented competition across the globe from other incumbents and new entrants, who merge and make other strategic alliances unimaginable to many just two decades ago.

The traditional television and radio business model, which until relatively recently was based on advertising



revenue derived from the sale of commercial spots placed inside and interrupting linear audio-visual or audio programming, has been supplemented, if not supplanted, by newer business models. These mix product placement, native, behavioral and targeted advertising, subscriptions, social media, data mining, various video-on-demand (VOD) offerings and more—all marketed to an engaged user base able to access more content and services nearly anytime, anywhere, and on any device. Long gone are scenes like the one below.

In short, the worlds of entertainment, media, telecommunications, and technology have collided (not merely converged) as part of a 21st century big bang, creating uncertainty as to who can offer the biggest bang to win consumers' ears, eyes, minds and money. Adding to this uncertainty are federal and state legislatures, administrative agencies and courts, each struggling to keep up with (if not get ahead of) these disruptive changes in the increasingly overlapping worlds or fields mentioned above.



## Entertainment Law

One major issue in the forefront of entertainment law is copyright licensing, particularly applicable to over-the-air (OTA) transmissions by radio and television stations, as well as to broadcast stations, cable systems, satellite operators and others who digitally distribute music (among other copyrightable content) online or to mobile devices such as smartphones and tablets. Unlike their counterparts in other countries, traditional terrestrial radio and television broadcasters in the United States have long been exempt from having to pay copyright royalties for OTA public performances of sound recordings. However, these broadcasters must obtain copyright licenses and pay royalties for OTA public performances of the musical compositions (as distinguished from the sound recordings).

Typically, this is done through blanket licenses for music radio stations and per-program licenses for television and talk radio stations issued by three established performance rights organizations (PROs), ASCAP, BMI and SESAC, and by a nascent fourth PRO called Global Music Rights (GMR).<sup>1</sup>

ASCAP and BMI are subject to decades-old antitrust consent decrees made with the Department of Justice (DOJ), which not only restrict the rates and other terms of copyright licenses offered by these two PROs, but also provide for enforcement or dispute resolution in the “rate courts” located at the U.S. District Court for the Southern District of New York.<sup>2</sup>

Following much more recent antitrust litigation commenced against SESAC by the Radio Music Licensing Committee (RMLC), a national trade organization representing most U.S. commercial radio stations, an agreement was made in 2015 that called for resolution of the parties’ radio music licensing dispute by arbitration rather than by the court. In late July 2017, a resolution was announced where licensing rates were lowered overall but both sides claimed victory.<sup>3</sup>

However, as of this writing, GMR and the RMLC are embroiled in bi-coastal antitrust litigation, where each is essentially accusing the other of anti-competitive conduct. First, the RMLC filed its complaint against GMR in Philadelphia at the U.S. District Court for the Eastern District of Pennsylvania.<sup>4</sup> That prompted a so-called “knee-jerk” complaint by GMR against the RMLC in Los Angeles at the U.S. District Court for Central California,<sup>5</sup> which without doubt was at least in part motivated by GMR’s inability to make a deal with the commercial radio industry association.

The parties’ respective motions to dismiss and/or consolidate were denied, and the court in Los Angeles agreed to a stay while the war waged on in Philadelphia. In addition, a temporary license agreement between the RMLC and GMR was put into effect.<sup>6</sup>

Meanwhile, the Television Music Licensing Committee (TVMLC), a national trade organization representing most U.S. commercial television stations, was (as of this writing) negotiating with ASCAP for a copyright license effective retroactively to January 1, 2017 (although an interim agreement was also put into effect). That matter will hopefully be resolved without more court intervention.

Further, with regard to the ASCAP and BMI consent decrees, in May 2017 the TVMLC filed an amicus brief with the Second Circuit urging reversal of a widely reported 2016 decision from the Southern District of New York.<sup>7</sup> This controversy was triggered by a relatively recent review of the consent decrees conducted by the DOJ, which concluded in August 2016 with an interpretation by the DOJ that threatened to change the way PROs license music co-authored by writers from different PROs (i.e., “split works”—which raise the issue of “fractional versus “full works” licensing). In the DOJ’s view, the consent decrees require ASCAP and BMI to offer full-work licenses. That view was rejected by the Southern District (which favored BMI’s interpretation), and the government appealed. BMI’s competitors have filed amicus briefs with the Second Circuit in support of BMI’s defense of the DOJ’s appeal, and at last report oral arguments were scheduled for December 1, 2017. Obviously, this music copyright licensing case has far-reaching implications.

The music industry has also been pushing to get legislation passed that would create a new federal copyright for public performance of sound recordings by OTA radio and television broadcast stations. However, their strenuous and ongoing lobbying efforts have been unsuccessful to date, and related copyright litigation under various state laws or common law regarding sound recordings made before 1972 (which are not protected by federal copyright law) have likewise not favored copyright holders. However, broadcasters, cable systems, satellite operators and others who digitally distribute music (among other copyrightable content), including online or to mobile devices such as smartphones and tablets, must separately license sound recording digital performance rights pursuant to the Digital Performance Right in Sound Recordings Act.<sup>8</sup>

A complex statutory license scheme for “digital audio transmissions” has emerged, which requires payment of royalties to Sound Exchange (a collective originally organized by the major record labels) and puts limits on repeating songs and interactivity (such as listeners being able to request specific songs), enabling non-interactive streaming services to rely on statutory licenses. In contrast, many so-called “pure-play” digital streaming services have been compelled to negotiate direct licenses (rather than use statutory licenses) for their interactive digital public performances.

2017 also saw FilmOnX (formerly known as Aereokiller) take another hit against its efforts to exploit the U.S. Supreme Court’s 2014 decision in the widely known *Aereo*

case.<sup>9</sup> FilmOnX sought to have its online television or video service characterized as a cable service entitled to a compulsory or statutory copyright license under § 111 of the Copyright Act.

Unfortunately for this defendant, in *Fox TV v. Aereokiller*,<sup>10</sup> the Ninth Circuit reversed a lower court decision that favored FilmOnX but was at odds with every other federal court that had previously decided this issue (including the Second Circuit, Southern District of New York, District of Columbia, and Northern District of Illinois), notwithstanding that the appellate court in California found the language of § 111 to not clearly favor arguments made by either party. Faced with interpreting an ambiguous statute, the Ninth Circuit (as did the Second Circuit in 2012's *WPIX v. Ivi*<sup>11</sup>) turned to the Copyright Office for guidance, and gave it deference. For 25 years, the Copyright Office had opined that to qualify as a cable system, a provider needed control over communications facilities with a decidedly "local" presence—which is the exact opposite of the internet at large.

Although the Ninth Circuit opted for deference under a more stringent standard known as "Skidmore" deference, it noted that even under the less differential "Chevron" standard (on the Second Circuit relied in *Ivi*) the outcome of its decision would have been the same. Apart from the copyright issue, the difference in standards of deference given to the Copyright Office by each of the Second and Ninth Circuits (the two federal appellate courts that are most closely tied to copyright and entertainment) also has much further implications.<sup>12</sup>

## Communications Law

On the heels of the Presidential inauguration of Donald Trump in January 2017, Republican Ajit Pai was then promoted from Commissioner to Chairman of the Federal Communications Commission (FCC). This did not require confirmation or approval of the Senate.

At the time, there were only three commissioners sitting at the FCC (two Republicans and one Democrat), which easily enabled the new Republican administration to quickly undo several actions of the prior Democratic administration. Although soon thereafter two more commissioners (one from each party) joined to fill all five seats, and although the FCC is purportedly an "independent" federal agency, actions by FCC commissioners have historically followed political party lines.

However, the recent deregulatory tilt by the current FCC Republican majority favoring certain big businesses has been decried by the agency's Democratic commissioners as a corporate giveaway that merely gives lip service to competition and consumer protections. The shift also troubles other big businesses, who feel disadvantaged by these federal favors. For example, one action in early 2017 led by Chairman Pai to reinstate the so-called "UHF

discount" rule (which was abolished by the prior Democratic administration).<sup>13</sup>

This quasi repeal and replacement had the effect of liberalizing the number of television stations one entity may own in a local market. The FCC's about-face was particularly beneficial to the publicly traded Sinclair Broadcast Group, at the time already the country's largest television station group owner, whose application to purchase major market television stations from the Chicago-based Tribune was then pending at the FCC.

Following FCC approval and closing of the deal, Sinclair now has even greater national reach, reportedly up to 70% of U.S. households.

Under the reinstated "UHF discount" rule, UHF television stations (originally considered an inferior service when launched decades ago, but due to advances in technology and engineering are ironically today more valuable than VHF television stations), or more precisely the "attributable interests" relevant to ownership and control of these UHF stations, are discounted for purposes of compliance with federal broadcast station ownership limits.<sup>14</sup>

In part, arguably responding to what the Democratic FCC commissioners, some competitors and public interest advocacy groups view as yet another corporate giveaway by the federal government, the agenda for the FCC's monthly meeting to take place in December 2017 calls for renewed consideration of broadcast ownership rules (including *inter alia* the UHF discount rule and its relationship to a 39% national TV ownership limit). It is widely expected by industry observers that the national and local broadcast ownership limits will continue forward on their deregulatory trajectory.

These actions, among other recent developments, including *inter alia* liberalized limits on alien or foreign ownership in all types of U.S. communications facilities, help foster a more robust environment or active market for acquisitions, divestitures, equity and debt financings (and possibly a concomitant increase in valuations and related multiples). Several other huge mergers and acquisition deals have already been announced, an emerging trend across multiple communications sectors.<sup>15</sup>

The current FCC's deregulatory tilt put into high gear in early 2017 has likewise accommodated publicly traded Entercom Communications (Entercom), who in March 2017 filed an FCC application to purchase CBS Radio. That accommodation may be seen in a September 2017 FCC decision,<sup>16</sup> which denied a petition for reconsideration objecting to the termination of a license renewal hearing previously designated against one of Entercom's radio stations in Sacramento, KDND, in connection with a contest gone bad—really bad. This station held a contest called "Hold Your Wee for a Wii," in which contestants were required to continually drink large amounts of wa-

ter while being prohibited from urinating. Sadly, this resulted in the tragic death of one of the contestants. Details of the contest and the serious issues raised are described in the FCC's Hearing Designation Order.<sup>17</sup>

Citing the petitioner's lack of formal standing as a "party in interest," and rejecting his argument that the issues surrounding this one particular station should be considered in connection with Entercom's character and basic qualifications to hold any FCC licenses (which arguably impacted the company's other stations as well as the then-pending CBS transaction), the FCC allowed Entercom to surrender its FCC license for KDND, thus making the renewal hearing moot. The CBS merger was subsequently approved, moving up Entercom from being the country's fourth largest radio station group owner to its second (behind only top ranked iHeart).

Despite the current federal government's often articulated bias in favor of "free market" forces, one mega-media merger is in fact being challenged by the current administration. In November 2017, the DOJ filed suit in the U.S. District Court for the District of Columbia to block AT&T's proposed acquisition of Time Warner (TW).<sup>18</sup>

Unusual for several reasons, this antitrust challenge is reportedly the first horizontal merger case brought by the DOJ in decades. It brings to mind the challenge to the vertical merger of Comcast and NBCU, which principally imposed behavioral conditions to get that deal approved and closed in 2011. In the current case of AT&T and TW, particular structural conditions, such as divestitures, were sought by the DOJ but rejected by the parties. The unofficial word on the street is that President Trump's disfavor of "fake news" on CNN (part of the TW family) may have influenced this matter; but, in general the current federal administration continues along its "free market" path of deregulatory inclinations.

As elaborated below, the current FCC administration quickly reversed direction and began the process of rolling back several other key regulatory decisions of the prior administration, perhaps most notably those concerning so-called "net neutrality," a matter of significant impact for the fields of telecommunications, media and technology (collectively, TMT) and entertainment. In any event, whatever actions the FCC may take next about this and other crucial matters will surely be challenged administratively and judicially.

Meanwhile, following the conclusion of the so-called television "incentive auction" earlier in 2017, the FCC is now tackling its "re-packing" process. It is changing TV station channel allotments, after some stations agreed to surrender spectrum (either by going off the air or by entering into transmission facility sharing arrangements) in exchange for auction proceeds from wireless carriers and others who wanted to obtain and repurpose that spectrum to meet an ever-growing demand for mobile broadband services. This development will *inter alia* enable

even more competition in the market for multi-channel video programming distribution.<sup>19</sup>

Additional FCC efforts are currently underway to free up and reallocate more spectrum (including *inter alia* the sharing of particular frequency bands by various government and private users), as well as to foster more wired and wireless broadband deployment, including advancement of next generation mobile technology (e.g., from 4G/LTE to 5G). Unfortunately, additional FCC spectrum auctions are temporarily on hold while certain financial wrinkles are being ironed out.

Today's "mobile first" digital media world is also an impetus behind the FCC's recently approved change in broadcast television station technical standards, another development based on technology advances regarding video compression and more. A coalition of broadcast and consumer electronics industry representatives had petitioned the FCC to authorize the use of this new standard, known as ATSC 3.0, on a voluntary basis. This voluntary transition is in contrast to the mandatory digital television (DTV) transition completed in 2009.

As the FCC noted in its Notice of Proposed Rule-Making, ATSC 3.0 is scalable, interoperable and adaptable.<sup>20</sup> It also has the potential to greatly improve broadcast signal reception on television receivers without outdoor antennas, and even more importantly, in automobiles and on other mobile devices.<sup>21</sup>

ATSC 3.0, a promising new technical standard for television, replaces the current ATSC 1.0 or DTV standard (ATSC 2.0 technology was surpassed before it could be implemented). It will enable television broadcasters to offer further enhanced and innovative new features, including 4K and ultra high definition pictures, superior and immersive audio (not unlike the leaps in audio quality made in shifts from AM to FM or from LPs to CDs), localized or targeted content, datacasting and interactive services. This upgraded technology is intended to merge the capabilities of OTA broadcasting with the broadband viewing and information delivery methods of the Internet. Essentially, ATSC 3.0 will be a hybrid television distribution platform, where higher quality audio and video content will be broadcast OTA, while additional content or interactive services (such as targeted ads) will be delivered over internet connections for integration with the programs.

This new standard will require a different kind of TV tuner, which will function in a home as a home gateway that connects to a home's Wi-Fi router. It will not be backwards compatible, but as the proposed rule-making calls for a voluntary transition, it will still be a few years before consumers must acquire adapters or buy new televisions, as they eventually will have to do. However, unlike the DTV transition, consumers alone will bear those costs without benefit of any federal subsidy.

The implications of ATSC 3.0 for content, distribution and consumer electronic players are huge. Successful tests have been completed in several American markets, and South Korea (where two top consumer electronics manufacturers, Samsung and LG, are both headquartered) has already chosen ATSC 3.0 as that country's "next-generation TV" standard.

Of course, as today's smart televisions, smartphones, smart speakers (such as Amazon Echo and Google Home, which are making voice control the new touch) and other devices become smarter, the issues concerning data or cyber-security and privacy they and the adoption of ATSC 3.0 raise will dramatically increase in complexity—which are topics worthy of much greater focus than can be only summarily mentioned in passing here. For a quick dip into some of those waters, check out this November 2017 news item about hacking incidents involving HBO.<sup>22</sup>

Finishing some thoughts on ATSC 3.0 developments, some U.S. television broadcasters have been so eager to be "first movers" to provide free OTA television directly to smartphones that they began pushing mobile phone manufacturers to install new ATSC 3.0 "TV chips" in their devices, even before this new technical standard was formally adopted.

There is also a similar effort under way by the U.S. radio industry to have wireless carriers in this country activate the "FM chips" that many mobile phone manufacturers already have installed in their devices. Unfortunately, some wireless carriers have been reluctant to activate these FM chips, or even publicize their existence, in fear that they will lose data usage revenue when users listen to free OTA broadcasts. Jeff Smulyan, the forward-thinking CEO of radio group owner Emmis Radio, has been a key figure in this FM chip effort and a vocal supporter of the related free NextRadio app. Summer 2017 hurricanes along the Gulf States alone make a compelling public safety case for widespread adoption of this technology.<sup>23</sup>

Obviously, technology does not stand still. It evolves in an ever-growing pace, which is especially true in the area of electronic media. The habits and demands of listeners and viewers dramatically change, and what began as radio and television is now audio-visual content consumed in a variety of new ways through a growing range of media sources, devices, apps and other delivery methods or distribution platforms.

Prominent among these distribution platforms is the public Internet, which has become a major source of audio-visual content for consumers—particularly for those born in the modern digital age, who as cable cord-cutters, cable cord-shavers or cable cord-nevers seem to be coming to a better appreciation of free OTA radio and television.

In August 2017, the *Wall Street Journal* published an interesting article about some millennials (and oth-

ers) who discovered an amazing hack enabling them to watch television without paying a cable company—OTA television.<sup>24</sup> OTA television is also an under-appreciated solution for many viewers whose favorite television programs, including major sports events, get blacked out or held hostage during recurring battles between television broadcasters and Multi-Channel Video Distributors (MVPDs), such as cable systems and satellite operators—which often occurs in connection with the FCC's so-called must-carry regime.

In general, an eligible television broadcaster can require that a cable system "must-carry" its programming, or instead it can elect to negotiate a "retransmission consent" agreement with the cable operator. The retransmission consent election cycles occur every three years, and October 1, 2017 was the deadline for television stations to make their elections for the current three-year cycle starting January 1, 2018. Almost immediately, impasses were met by ABC and CBS in their respective retransmission consent negotiations with MVPDs.

When there is an impasse in "retrans" negotiations, mediation may help the parties achieve a prompt and cost-effective resolution. However, more often television broadcasters will try to break that impasse by revoking the cable systems' retransmission rights. That strategy usually works, eventually, but in the interim viewers cannot watch the games or see the shows. An easy solution to that problem for viewers is to disconnect the cable and watch OTA television (and, if necessary, to purchase indoor antennas that are inexpensive). Retrans consent agreements are also one way in which a television broadcaster can obtain additional concessions from MVPDs, including having its primary and supplemental programming streams known as multi-cast channels or diginets (discussed next) carried on a satellite or cable channel lineup.

Free OTA television includes free access to DTV multicast channels or sub-channels, which often carry programming for targeted audiences from so-called digital networks or "diginets." In effect, each television station has a "bit budget," which it can adjust to provide multiple streams beyond the main signal. Those additional streams can be programmed locally or affiliated with one or more diginets. Diginets have become so valuable that the E.W. Scripps company<sup>25</sup> recently sold some broadcast television stations and used the funds to buy from Jonathan Katz (a former Turner broadcast programming executive) his four diginets (Bounce, Grit, Escape and Laff), each of which reaches more than 80% of all U.S. households.<sup>26</sup>

As cable systems are currently and notoriously suffering major losses in video subscribers, they must increasingly rely on their pricing power and the higher margins associated with the broadband access side of their business models. Meanwhile, the entire traditional audiovisual ecosystem is becoming more fragmented than ever, largely due to increasing competition from newer digital

media players that have emerged and experienced unprecedented growth in the last two decades. Among them are so-called Over-The-Top (OTT) video services, which provide content and services over the internet rather than over the air.

### **Increasing Digital Media Competition**

These new competitors to traditional radio and television broadcasters include “spoken-word” podcasters, an audio-on-demand (AOD) business model that has low barriers to entry, avoids the expensive music copyright licensing maze, and is an increasingly popular form of “narrow-casting” (as contrasted with broadcasting), in which both National Public Radio and NYC Public Radio have excelled. New digital media competitors also include a number of streaming services.

Some of the streaming services began with and/or maintain a focus on music, such as Spotify, Pandora, Dezer and Kurt Hanson’s AccuRadio.com, while bigger and better-known film and television or video streaming services such as Netflix, Hulu and YouTube (including its newly launched YouTube TV), among others, further contribute to today’s expanding digital media smorgasbord. Unfortunately, this abundant buffet of choice has made it difficult, if not impossible, for consumers to easily navigate or search through all of the over-the-air, cable, satellite, mobile, and online offerings that comprise today’s digital media universe (or even through just one cable system’s program offerings).

Despite obvious business and legal hurdles, it seems like the whole world wants to keep jumping on the media content bandwagon that was once dominated by traditional television, radio and print. For example, AT&T (once just a traditional telecom provider offering only voice services), currently makes available not only data services, but also its own video offerings—such as AT&T’s Direct TV satellite service and its companion Direct TV Now streaming service. Even the relatively younger social media giant Facebook is pushing further into this space, such as with its new “Watch” service, which allows communities of users to upload and share video content (launched while Facebook simultaneously tackles the DMCA/copyright notice-and-take-down game of whack-a-mole, by developing technology that can preemptively identify and block infringing content).

Device manufacturers also want in. For example, in August 2017, streaming device manufacturer Roku joined the fray by starting a free online movie service. Roku also has an initial public offering in the works, as does Spotify (the world’s largest paid music streaming service), although Spotify has plans to go public while skipping a traditional IPO and instead listing directly on the New York Stock Exchange. As of this writing, Spotify was discussing this unconventional route with federal regulators at the Securities and Exchange Commission.

These and other factors bode well for further innovation and investment, including additional mergers and acquisitions, as well as joint venture activity, across multiple TMT and entertainment sectors. Industry insiders predict that that trend is to further industry consolidation.

In radio, this occurred on a previously unprecedented scale when iHeart (formerly known as Clear Channel) and Cumulus consolidated that broadcast sector after each became a public company.<sup>27</sup> Bob Pittman, iHeart’s current CEO, started in radio. When he assumed his current role in 2011, he knew that both enormous challenges and opportunities lay ahead. Building on the strong personal relationship that radio has with its audience, he managed to morph that brand up a thousand ways from Pittsburgh (OTA, digital, live events, etc.), reflecting a noteworthy strategic decision and tactics to combine not only traditional and digital media, but also other entertainment, communications and technology assets.

Interestingly, the phenomenal growth of competitive digital media in the 21st century that enabled some of today’s biggest successes has also made strange bedfellows among some of them. For example, the streaming service Pandora, which has been bleeding money—facing not only slower revenue growth but also mounting losses as it tries to adapt its business model to better compete—in June 2017 accepted a \$480 million investment from a major competitor, satellite radio provider Sirius XM. Pandora also then gave Sirius XM 19% of its ownership and three Board of Director seats.

In August 2017, another novel alliance was made, when wireless carrier T-Mobile began offering Netflix to its customers in hopes of boosting both their subscriber counts and average revenue per user (ARPU). In that same month, Amazon closed on its purchase of Whole Foods, which also helped advance the notion that for digital media to survive and flourish going forward, novel alliances, new business models, and new ways of thinking must be developed.

Of course, none of this growth in the digital media space could have occurred without the emergence of broadband and the associated technology law policy of an open internet. The internet allows us to store, access and share information in ways not imaginable by many when the Telecommunications Act of 1996 was enacted into law at the close of the 20th century.

### **Technology Law**

This technology law policy issue regarding an open internet or “net neutrality” has been a point of contention among network users and access providers since the mid-1990s. Both sides of this issue have zealously lobbied Congress with multiple attempts to pass bills containing net neutrality provisions, but those bills were not passed into law.

Most recently, this issue has become a serious matter of larger public concern that warrants some brief historical context here to better understand it, where we are right now, and where we are all headed in this country. The D.C. Circuit's 2016 panel decision in *United States Telecom Association v. FCC*<sup>28</sup> lays out the history of internet regulation and the last few battles in this war without end, starting with a statement that this case was the third time in seven years that the court confronted an effort by the FCC to compel internet openness; the principle that broadband providers must treat all internet traffic the same, regardless of source.

The court's first decision, *Comcast v. FCC*,<sup>29</sup> held that the FCC failed to cite any statutory authority that would justify its order compelling a broadband provider to adhere to certain open internet practices. In response, this time relying on § 706 of the Telecommunications Act of 1996, the FCC issued an order imposing transparency, anti-blocking and anti-discriminatory requirements on broadband service providers.

That led to the court's second opinion, *Verizon v. FCC*,<sup>30</sup> which held that § 706 does give the FCC authority to enact open internet rules. Nonetheless, the court vacated the anti-blocking and antidiscrimination provisions, because the FCC had chosen to classify broadband service as an "information" service under the Telecommunications Act, which expressly prohibited the FCC from applying common carrier regulations to such services.

In turn, the FCC then promulgated its 2015 "Open Internet Order,"<sup>31</sup> in which it reclassified broadband service as a "telecommunications" service subject to common carrier regulation under Title II of the U.S. Communications Act of 1934. Title II, as amended, gave the FCC the power to regulate common carriers, and required that the carriers furnish communications facilities and services upon reasonable request, at just and reasonable rates, and without unjust or unreasonable discrimination.<sup>32</sup>

Various broadband providers and their associations challenged the Open Internet Order, which characterized them as common carriers subject to Title II regulations, raising arguments that the FCC's authority to do so was either non-existent or exercised in an arbitrary and capricious manner. The D.C. Circuit's panel decision in 2016 rejected those challenges, and upheld the FCC's Open Internet Order.

As the panel explained, the internet is one of the most significant technological advancements of the 20th century, and it includes four major participants: end-users, broadband providers, backbone networks and edge providers. Most end-users connect to the internet through a broadband provider, which delivers high-speed internet access using technologies such as fiber optics, cable modem service, and digital subscriber line (DSL) service. Broadband providers interconnect with backbone networks—long-haul fiber optic links and high-speed rout-

ers capable of transmitting vast amounts of data. Edge providers, such as Netflix, YouTube and Amazon, provide content or services over the internet. In recent years, some edge providers have connected directly to broadband providers' networks, thus avoiding the need to interconnect with the backbone, while enabling faster and better connections for end users.

The many proponents of internet openness—which in part include content creators, consumer oriented groups, free speech advocates, and other public interest organizations—all worry about the relationship among broadband providers, edge providers and consumers. They fear that broadband providers might block end-users from accessing content or services provided by certain edge providers or might slow and degrade the quality of the users' access to them—either as a means of favoring their own competing content or services, or to enable the providers to charge and collect more fees from certain edge providers, who, in turn, pass through those higher costs to end users.

On May 1, 2017, the D.C. Circuit denied a requested rehearing *en banc* of the panel decision in *USTA v. FCC*, while at the same time it addressed concerns raised about Supreme Court precedent relating to the FCC's authority (which was here found to exist and to have been properly exercised) and the First Amendment (which was here found to be more appropriately applicable to speakers rather than to purportedly indiscriminate conduits for speech).<sup>33</sup> The court went on to further hold that *en banc* review would be particularly unwarranted "at this point in time" in light of the uncertainties surrounding the fate of the FCC's Open Internet Order, as "the *en banc* court could find itself examining and pronouncing on the validity of a rule that the agency had already slated for replacement."<sup>34</sup>

The court was referring to the intervening and ongoing efforts of FCC Chairman Pai (a former lawyer for Verizon) to vitiate the 2015 Open Internet Order and otherwise roll back the net neutrality rules, via *inter alia* a Notice of Proposed Rule-Making (NPRM) issued on April 27, 2017 that is ironically entitled "Restoring Internet Freedom."<sup>35</sup> Many are asking, freedom for who?

In part, the NPRM (which is also currently on the FCC's agenda for its meeting on December 14, 2017) proposes to eliminate the Open Internet Order's classification of broadband internet access service as a "telecommunications" service subject to common carrier regulation under Title II of the Communications Act, and to reinstate the more lightly regulated "information" service classification. To date, more than 20 million public comments were filed with the FCC about this issue (the public comment filing window, as briefly extended to make the window open for a total of only three months, closed on August 31, 2017). Most commenters are generally against repeal and for retention of the current broadband net neutrality rules.

However, Chairman Pai already signaled his views, by claiming that the Open Internet Order had injected uncertainty into the marketplace, restricted innovation and chilled investment. He dismissed giving consideration based on the volume or number of public comments filed alone, claiming in part that this rollback will lower consumers' costs.

Pai's other efforts to roll back the net neutrality rules as soon as possible following his promotion from Commissioner to Chairman at the FCC in January 2017 include the February 2017 decision to rescind an earlier determination that AT&T and Verizon Wireless violated net neutrality rules with paid data exemptions known as "zero rating practices." Such practices allow AT&T and Verizon Wireless to stream their own video services (DirecTV and go90, respectively) on their own mobile networks, without counting against customers' data caps, while the carriers charge other video providers for the same data exemptions or "paid prioritization" (an obvious incentive to disadvantage competitors who also provide audio-visual content).

The FCC's likely further rollback of net neutrality rules and policies adopted in the prior administration's Open Internet Order—which prohibit discriminatory use of data caps (and of blocking, speed or signal degradation, and even subscriber "authentication" in connection with so-called TV Everywhere)—will enable vertically integrated MVPDs to more easily harm not only competition, but also consumers (who will likely face higher, rather than lower, costs).

Other net neutrality related rollback efforts in 2017 include the FCC's shakeup of the public subsidy program commonly known as "Lifeline." Originally intended to help lower income consumers obtain and pay for plain old telephone services (POTS), the subsidy program was subsequently expanded to include broadband services as part of a publicized effort to help bridge the so-called "digital divide."

In early 2017, the Republican-led FCC reversed an earlier decision of the prior Democratic administration that approved nine companies as eligible broadband providers under the federal Lifeline program. The reversal also noted that the FCC would relinquish to the individual states, on a going forward basis, the federal agency's responsibility for designating eligible Lifeline providers. In addition, President Trump signed a law in April 2017 overturning internet privacy protections previously enacted by the prior administration that would have prevented broadband service providers from tracking and selling their customers' data. The foregoing merely reflects some of the current battles being fought in this crucial and ongoing war relating to internet access broadband service and net neutrality.

On one side of this war is the Internet Association, a group representing major technology titans, such as Mi-

crosoft, Alphabet (formerly known as Google), Facebook, Amazon, Netflix and Twitter. They say that dismantling the net neutrality rules is what will create uncertainty in the market, upset the careful balance that has led to the current "virtuous circle of innovation" in the broadband ecosystem, and harm consumers (an argument also supported by 12 state attorneys general, who, citing consumer protection concerns, jointly urged the FCC not to overturn the net neutrality rules). Those who create, own or license information and entertainment content (but do not own broadband pipes themselves) also generally sit on this side of the table and favor retention of the current Open Internet Order and its regulatory structure.

On the other side are the major broadband Internet Service Providers (ISPs). These include Verizon, AT&T, Charter (the owner of Spectrum Cable, formerly known as Time Warner Cable), and Comcast (owner of NBC Universal), who collectively urge the FCC to reverse the current broadband net neutrality rules.

Both sides have been lobbying hard on several fronts. Although this crucial matter will surely head back from the FCC to court, unless and until Congress steps in to enact significant legislative reforms (involving both the Communications Act and the Copyright Act, which many agree are outdated or out of synch with today's realities), we will all continue to be victims of shifting sands—the endless oscillating cycle of regulation, deregulation and reregulation that follows each election of a new President.

Surely, we can all agree that, in the 21st century's digital and global economy, broadband is no longer a luxury. It is a necessity. Like electricity and telephone service that emerged in the 20th century, broadband represents a critical public utility infrastructure and foundation for economic growth, job creation, free speech, the free flow of ideas, and more.

Broadband technology continues to redefine not only the converged worlds of TMT and entertainment, but also other fields of great public interest including *inter alia* finance, energy, education, health care and public safety. Accelerating changes in technology, and an inability of the law to keep up (let alone get ahead of them), create profound near and long-term consequences for individuals, companies, governments and other organizations alike.

*As changes occur so rapidly with these issues, please visit the EASL Blog regularly for up-to-date developments.*

## Endnotes

1. GMR was organized in 2013 by Irving Azoff. After luring more than 200 artists away from ASCAP, BMI and SESAC with the promise of much higher royalty payments, GMR developed a client roster of famous songwriters including, *inter alia*, John Lennon, Bruce Springsteen, Prince, and Drake.
2. Historically, one judge handles ASCAP cases, while another handles BMI cases.

3. See [variety.com/2017/music/news/sesac-radio-music-licensing-committee-price-war-1202511443](http://variety.com/2017/music/news/sesac-radio-music-licensing-committee-price-war-1202511443).
4. *RMLC v. GMR*, U.S. Dist. Ct. E.D. PA (civil action no. 16-6076).
5. *GMR v. RMLC*, U.S. Dist. Ct. C.D. CA (civil action no. 2:16-cv-09051).
6. More details are available at, inter alia, GMR's website ([www.globalmusicrights.com](http://www.globalmusicrights.com)).
7. *USA v. BMI*, 207 F. Supp. 3d 374 (2016). More info about this case is at [www.law360.com/articles/925904/doj-asks-2nd-circ-to-overturn-bmi-fractional-license-ruling](http://www.law360.com/articles/925904/doj-asks-2nd-circ-to-overturn-bmi-fractional-license-ruling) (reg. required or see Google cache).
8. Public Law § 104-39, 109 Stat. 336.
9. 134 S. Ct. 2498 (2014).
10. 861 F.3d 1002 (9th Cir. 2017).
11. 691 F.3d 275 (2d Cir. 2012).
12. *Compare Chevron v. NRDC*, 467 U.S. 837 (1984) with *Skidmore v. Swift*, 323 U.S. 134 (1944).
13. FCC 17-46, rel. 4/21/17.
14. See 47 CFR § 73.3555.
15. For example, in late July 2017, Discovery Communications announced its acquisition of Scripps Networks Interactive (SNI) in a cash-and-stock deal valued at a total of \$14.6 billion (i.e., \$11.9 billion plus \$2.7 billion of assumed debt). The deal boosts the combined company's negotiating leverage with pay television operators at a time when more people watch video online. See <http://newsroom.scrippsnetworksinteractive.com/news/discovery-communications-to-acquire-scripps-networks-interactive-for-146-billion.htm>.
16. FCC DA 17-871, rel. 9/11/17.
17. FCC 16-153, rel. 10/27/16.
18. A copy of the federal government's Complaint can be found at <https://assets.documentcloud.org/documents/4254900/ATT-Antitrust-Complaint.pdf>.
19. For an informative overview of this topic, see FCC Public Notice DA 17-797 (rel. 8/24/17), which solicits public comments for the FCC's pending annual report to Congress on competition in the video delivery marketplace. Ad hoc coalitions are often organized to share the cost of preparing and submitting comments addressing common concerns in various regulatory rule-makings and other proceedings, akin to *amici* briefs filed in certain judicial actions. For more information, please contact the author, whose practice in part involves work before the Federal Communications Commission in Washington, D.C.
20. NPRM, FCC 17-13, rel. 2/24/17. Also see Report & Order and Further NPRM, FCC 17-158, rel. 11/20/17.
21. Automobiles are now mobile devices—not only the “connected cars” on the market today, but also the emerging “autonomous vehicles” coming soon (when rear seat facing video displays will be supplemented by front seat facing ones that pose no driver distraction dangers, and when cars will be part of the “Internet of Things” collecting, storing, and exchanging data with other cars, insurance companies, and with every mundane device or profound application conceivable).
22. See <http://deadline.com/2017/11/game-of-thrones-hack-us-officials-charge-iranian-national-hbo-attack-1202213060/>.
23. For more information about this worthwhile technology, see [www.nextradioapp.com](http://www.nextradioapp.com), which also has links to both the Apple Store and Google Play where the app may be downloaded. It enables end users to listen to free OTA FM radio on their mobile phones (including access to local radio stations that an online content aggregator, such as TuneIn, may not provide), as well as to receive enhanced services and bypass wireless carriers' gatekeeper role here (including during severe weather and other emergencies when wireless network service outages typically occur).
24. <https://www.wsj.com/articles/millennials-unearth-an-amazing-hack-to-get-free-tv-the-antenna-1501686958> (sub. req.).
25. This company and SNI were previously parts of the Scripps family's media holdings, which in 2008 were separated into two distinct publicly traded companies.
26. More details about that diginet deal are available at [www.tvnewscheck.com/article/106089/scripps-buys-katz-diginets-for-302-million](http://www.tvnewscheck.com/article/106089/scripps-buys-katz-diginets-for-302-million), and an illustrative list of American OTA television stations and their digital sub-channels can be found at [www.tvchannellists.com](http://www.tvchannellists.com) (scroll down to United States, and click on the free OTA TV Stations link to choose from several markets, including New York City). Of course, one can also see what is available in a geographic viewing area simply by temporarily disconnecting the cable on a DTV television set and scanning or tuning around to see what is available on OTA.
27. Each publicly traded sector behemoth initially bulked up hoping to scale, rather than to end up being saddled by the truly humongous debt that each company faces today. iHeart has managed to maintain its number one ranking in radio, while it continues to negotiate a financial restructuring with its major investors and lenders in hopes of avoiding bankruptcy. Meanwhile, Cumulus—current CEO, Mary Berner, joined the company in 2015 following her departure from the magazine industry—recently had its number two ranking taken away by rival Entercom and was delisted by the NASDAQ stock exchange for failure to maintain minimum stock pricing.
28. 825 F.3d 674 (D.C. Cir. 2016).
29. 600 F.3d 642 (D.C. Cir. 2010).
30. 740 F.3d 623 (D.C. Cir. 2014).
31. 30 FCC Rcd 5601.
32. See 47 U.S.C. §§ 201, 202.
33. 855 F.3d 381 (D.C. Cir. 2017).
34. *Id.*
35. FCC 17-60.

**Barry Skidelsky, a former radio broadcaster and Berklee-trained jazz pianist, is now an attorney and consultant with his own private practice based in Manhattan, providing legal representation, counsel and additional diverse services, primarily to individuals and entities directly or indirectly involved with TMT and entertainment, including other lawyers or law firms. Previously General Counsel for an ISP, a publicly traded digital media company, and VC-backed or privately held companies, Barry has also served as a bankruptcy trustee, FCC ownership divestiture trustee, broker, arbitrator and mediator. A frequent author and speaker, co-chair of EASL's Television and Radio Committee, and member of EASL's Executive Committee, Barry can be reached either at 212-832-4800 or [bskidelsky@mind-spring.com](mailto:bskidelsky@mind-spring.com).**

# SPORTS AND ENTERTAINMENT IMMIGRATION: A Brief Overview of Immigration Policy and Activities Under the Trump Administration from January 20, 2017 to Present Day

By Michael Cataliotti

## Introduction

Since President Trump decided to run for office, there has been a constant stream of people discussing what he would do, what he could do, and what he might do should he be elected President of the United States, in addition to whom he would nominate or appoint to run the various Federal agencies, and whom he would nominate to the bench in various districts and circuits. While that stream has showed no signs of slowing down, since President Trump became the President-elect on November 6, 2016<sup>1</sup> and President on January 20, 2017, there has been such a flurry of information that to keep track of it all has been overwhelming, confusing, frustrating, and a seemingly hopeless task.

To address this issue and provide some relief from the current presidency that feels like a never-ending saga of “whodunit,” in this installment of *Sports and Entertainment Immigration*, we will chronicle the most important immigration and immigration-related actions taken by the administration since January 20, 2017, with a focus on those that had, could have, might have or are likely to have an impact on the sports and entertainment industries.<sup>2</sup> We will look at each of those actions, provide synopses for each, and indicate what the outcome was or may be in the future. Where applicable, we will indicate some of the processing trends that we have seen as of September 2017.

## The Actions

### January 25, 2017

On January 25, 2017, President Trump signed multiple executive orders, with the first being the Executive Order to “Enhanc[e the] Public Safety in the Interior of the United States,”<sup>3</sup> The order effectively expanded the individuals who would receive priority for deportation or removal.

While most individuals and media outlets focus on the order’s impact on unauthorized individuals (effectively placing all of them at risk of deportation),<sup>4</sup> few, if any, looked at how this could affect other industries or individuals, for example, the athlete, artist, entertainer, and/or entrepreneur who sought and obtained a visa, and is presently within the U.S. The key areas are in Section 5 of the order, which directs the Secretary of Homeland

Security to prioritize for deportation, those “removable aliens<sup>5</sup> who:

- (a) Have been convicted of *any* criminal offense;
- (b) Have been *charged* with *any* criminal offense, where such charge has not been resolved;
- (c) Have *committed acts that constitute a chargeable criminal offense*;
- (d) Have engaged in fraud or *willful misrepresentation* in connection with any official matter or application before a governmental agency; [...] or
- (e) In the *judgment of an immigration officer*, otherwise pose a risk to public safety or national security.<sup>6</sup>

There are many individuals who have gone out after a win or a loss and had one-too-many, maybe resulting in a heated argument, a physical altercation or, quite simply, the inability to hold one’s bladder until getting home. Some of these individuals have been convicted of these charges, but had their sentences suspended or been subject to community service. There are others who have been stopped with some markers and spray cans on their person, resulting in their arrest for possession of graffiti paraphernalia and (possibly) criminal mischief. Others have chased a story and went onto property that was not theirs, causing damage, but were not arrested or charged. To police these ne’er-do-wells who have been up to no good, the Order directs the Secretary of Homeland Security to hire more Immigration and Customs Enforcement (ICE) agents.

At present, however, arrests of noncriminal immigrants have more than doubled when we compared January to July 2016 against 2017.<sup>7</sup> However, hiring the thousands of ICE agents as set forth in the Order has proven difficult, due in part to applicants failing the entrance exam or polygraph tests,<sup>8</sup> and as of August 30, 2017, ICE had hired 1,300 new employees with an anticipated 100 more by the end of the current fiscal year (i.e., September 30, 2017).<sup>9</sup>

Additionally, the Order directs the Department of Justice (DOJ) and the Department of Homeland Security (DHS) “to ensure that jurisdictions limiting their cooperation with DHS are not eligible to receive federal grants, except as deemed necessary for law-enforcement purposes.”<sup>10</sup> These are “sanctuary jurisdictions” or “sanctu-

ary cities,” and the withholding of funds—like Block Grants—from these jurisdictions could cause significant hardship for many artists or entertainers, not-for-profits, and the like.

However, with respect to the withholding of funds from these “sanctuary jurisdictions,” as reported in *The Atlantic*, “A federal judge in Illinois blocked the Justice Department from denying grant money to sanctuary cities on Friday [September 15, 2017] [...]”<sup>11</sup> If the DOJ appeals the judge’s decision, the matter will go to the Seventh Circuit of Appeals, and then potentially, one of the parties will seek certiorari, so be mindful of this matter—captioned *The City of Chicago v. Jefferson Beauregard Sessions III, Attorney General of the United States*, Civil Action No. 1:17-cv-5720 (U.S. N.D. Ill.)—<sup>12</sup>it could have great implications for many community organizations and individuals within the arts and entertainment industries.

In addition, on January 25, 2017, Mr. Trump signed the executive order titled, “Border Security and Immigration Enforcement Improvements.”<sup>13</sup> As the name indicates, this order was focused on securing our borders, a/k/a building a “big, fat, beautiful wall.”<sup>14</sup> Although The Wall has been described by many as something that will never happen, it would appear that the DHS has issued environmental waivers in order to expedite the construction process.<sup>15</sup> However, there is still one large issue looming—the funding for the project, which has been showing little-to-no sign of being resolved. Of course, while The Wall itself may not have much of an impact on the sports, arts, and entertainment industries, the funding for it could, depending upon whether that funding is secured and, if so, from where it is taken. If, for instance, it is taken from DOJ, the Department of State (DOS), or the Department of Housing and Urban Development (HUD) funds, then there could be a drop in the size and quantity of grants issued, thereby impacting those in the arts and entertainment industries (and possibly in sports, as well).

This order also provides additional resources to the Citizenship and Border Patrol (CBP), expands the use of expedited removal procedures, and authorizes state and local officials to enforce federal immigration laws.<sup>16</sup> While this may not appear to impact the entertainment world, it could very well have consequences for those working in studios. It could also have consequences for individuals who work at various racetracks, in the stables, at or as part of rodeos, in local gyms, and many other venues. This is important, because it appears that CBP has “increased its detention capacity by about 1,100 beds” and begun identifying locations for additional detention centers.<sup>17</sup>

### January 27, 2017

Moving on from January 25th—a meager five full days into the start of the administration—to January 27th, we migrate to the executive order titled “Protecting the Nation from Foreign Terrorist Entry into the United States.”<sup>18</sup> This is the seven-nation ban.

Now, we acknowledge that it may not seem like the travel ban could have an impact on the sports and entertainment industries, but this is not so. It could prevent or severely limit certain actors, performers, directors, physicians, researchers, scientists, engineers, musicians, and/or athletes who hold passports or have close ties to those seven nations from being able to enter or re-enter the U.S. For example, if a production company or studio is currently or anticipating filming overseas, then it could be a real issue for the production, its lead or supporting actors, and its integral personnel to leave the U.S. This is so because some of those individuals may not be able to re-enter the U.S. or might be subject to heightened scrutiny upon their return. Likewise, if a studio is filming in the U.S. and wants talent from overseas, it might not be able to bring (m)any of those individuals in, because of the travel ban.<sup>19</sup> Therefore, while this section is long, it can certainly have an impact on all of our clients, and as such, we go full-steam into the topic.

Although not fully implemented, we return to the much maligned, often mocked, thoroughly litigated, and vastly adjusted Executive Order that was signed on Friday, January 27, 2017, went into effect immediately thereafter, and ultimately caused mayhem at international airports throughout the United States. The order indicated that “immigrant and nonimmigrant entry into the United States of aliens from countries referred to in § 217(a)(12) of the INA, 8 U.S.C. 1187(a)(12), would be detrimental to the interests of the United States, and I hereby **suspend entry into the United States, as immigrants and nonimmigrants, of such persons for 90 days from the date of this order** [...]”<sup>20</sup>

The result of the sweeping language within the seven-nation ban, along with the other aspects of the order, was that individuals from or with ties to the seven nations—Iraq, Syria, Iran, Libya, Somalia, Sudan, and Yemen—who were already onboard flights set to land in the U.S. after the enactment of the Executive Order, were greeted by CBP upon landing and detained.<sup>21</sup> This sparked chaos in and around airports, caused a massive cry for help from immigrants-rights advocates and similar groups to help the detainees and their families, friends, and employers, and ultimately resulted in a flurry of lawsuits.<sup>22</sup> The decisions of the courts were generally consistent in finding that implementing the order “by sending travelers home could cause them ‘irreparable harm’.”<sup>23</sup>

After losing nearly all of the challenges in sum, and having the Ninth Circuit Court of Appeals decline to immediately reinstate the travel ban,<sup>24</sup> the Trump administration drafted a new Executive Order that was signed on March 6, 2017.<sup>25</sup> In this version, commonly referred to as “Travel Ban 2.0,” the country list was decreased from seven to six by omitting Iraq, exempted lawful permanent residents (i.e., green card holders) and holders of valid visas, and placed a 120-day freeze on the admission of refugees from Syria.<sup>26</sup>

Once signed, a range of challenges were brought against the revised travel ban in district courts across the country. Two of those district courts, in Hawaii and Maryland, “issued a nationwide temporary restraining order against the travel ban and a nationwide preliminary injunction prohibiting the enforcement of the 90-day ban against travelers from Iran, Libya, Somalia, Sudan, Syria and Yemen,” respectively.<sup>27</sup> The Administration appealed these decisions to the Ninth and Fourth Circuits, respectively, and on May 25, 2017, the Fourth Circuit issued its majority opinion finding that the injunction with respect to the President was improper;<sup>28</sup> however, it maintained that the district court’s nationwide preliminary injunction was appropriate and “shall otherwise remain fully intact.”<sup>29</sup> Similarly, on appeal to the Ninth Circuit, a panel of three judges wrote in its opinion, issued June 12, 2017, that “the President, in issuing the Executive Order, exceeded the scope of the authority delegated to him by Congress.”<sup>30</sup> Of course, the Administration appealed to the Supreme Court (SCOTUS), which has issued multiple opinions about very narrow aspects of the travel ban,<sup>31</sup> such as allowing the 90-day period to go into effect;<sup>32</sup> however, it has not yet issued an opinion about the merits of the revised travel ban.<sup>33</sup>

---

---

*“Though still vague, we at least knew to expect clarification in due time, and we received that as of March 23, 2017.”*

---

---

As the Supreme Court was scheduled to hear oral arguments regarding the revised travel ban in its Fall 2017 session,<sup>34</sup> it has released its orders regarding the Trump administration’s third iteration of the travel ban that was issued on September 24, 2017, which we discuss below. The Court needed to determine whether the third iteration has rendered moot all pending litigation. Spoiler Alert: “Supreme Court Allows Trump Travel Ban to Take Effect.”<sup>35</sup> Ultimately, the Justices’ orders do not address the merits of the travel bans, but rather indicate that the Trump administration “can fully enforce its new restrictions on travel from eight nations, six of them predominantly Muslim” while the litigation proceeds in the district and appeals courts.<sup>36</sup> Stay tuned, because there is likely to be more news about these matters through 2018.

### March 6, 2017

Moving on, the next action was the release of the “Memorandum for the Secretary of State, the Attorney General, [and] the Secretary of Homeland Security,” which required the secretaries of both the DOS and DHS to “Implement[] Immediate Heightened Screening and Vetting of Applications for Visas and Other Immigration Benefits.”<sup>37</sup> This has been generally referred to as the “extreme vetting” that candidate Trump touted on the campaign trail.<sup>38</sup> However, way back in August of 2016, when then-Candidate Trump made his pitch, stating: “In

the Cold War, we had an ideological screening test. The time is long overdue to develop a new screening test for the threats we face today. I call it extreme vetting. I call it extreme, extreme vetting,”<sup>39</sup> no one knew what “extreme vetting” would look like. Now we do.

In his memorandum, President Trump writes that the “Enhanced Vetting Protocols and Procedures for Visas and Other Immigration Benefits” [...] should focus on:

- (a) preventing the entry into the United States of foreign nationals who may aid, support, or commit violent, criminal, or terrorist acts; and
- (b) ensuring the proper collection of all information necessary to rigorously evaluate all grounds of inadmissibility or deportability, or grounds for the denial of other immigration benefits.<sup>40</sup>

Though still vague, we at least knew to expect clarification in due time, and we received that as of March 23, 2017. As reported by *The New York Times*, “Diplomatic cables sent last week from Secretary of State Rex W. Tillerson to all American embassies instructed consular officials to broadly increase scrutiny.”<sup>41</sup> In one of those diplomatic cables dated March 15, 2017,<sup>42</sup> Secretary Tillerson indicated that if a consular officer was reviewing an individual’s materials and background, conducting an interview, and believed that a Security Advisory Opinion should be made, the consular officer “must ask additional questions directly related to understanding the applicant’s answers on application forms, which may include subjects such as those listed below [...]:

- The applicant’s **travel history** over the **last 15 years**;
- The names of any siblings/children/former spouses not recorded in the DS-160/260 or NIV/IVO case notes;
- The applicant’s **addresses** during the **last 15 years**, if different from the applicant’s current address;
- Applicant’s prior passport numbers;
- Applicant’s **prior occupation(s) and employers (plus a brief description if applicable) looking back 15 years**;
- All phone numbers used by the applicant in the last five years;
- All **email addresses and social media handles** used by the applicant in the **last five years**.<sup>43</sup>

It goes without saying that this could have dire effects on everyone seeking a visa or permanent-residence card; however, it could be particularly offensive to members of the sports and entertainment industries. With the amount that artists, performers, producers, athletes, and support staff travel around the world, it would be impractical, if not impossible, to recall with total accuracy 15 years of travel, residence, and employment history. It would also

be obscene to believe that five years of e-mail addresses and social media accounts (with passwords)<sup>44</sup> could be reported with 100 percent accuracy. This is particularly true due to the frequency with which new platforms are created and how quickly they can rise in popularity.

---

---

*“An RFE can have a significant impact on timing, because in most cases, there will be a 90-day window to respond to the RFE, during which processing of the submitted petition is paused.”*

---

---

What will happen if someone forgets his other password or account ID, thereby providing an inaccurate password or account ID, or simply none at all? Will DHS or DOS demand that a new password or account ID is created? Will either organization treat the inaccurate password or account ID, or lack thereof, as a material misrepresentation? If we think back to the removal prioritization(s) from above, then we see how this could be fantastically problematic: §5(d) of the Executive Order: Enhancing Public Safety in the Interior of the United States prioritizes for removal anyone who “ha[s] engaged in fraud or willful misrepresentation in connection with any official matter or application before a governmental agency.”<sup>45</sup>

Were this not enough, though, it appears that the DHS and DOS may seek to expand their review of visa applicants even further to include inquiries regarding social and religious ideologies.<sup>46</sup> Those questions “would assess a visitor’s beliefs on issues such as the treatment of women in society, ethics in military conflict and the ‘sanctity of life’.”<sup>47</sup> These questions and their answers are subject solely to the discretion of the consular officer or border patrol agent, both of whom have little oversight or methods of review and/or appeal, meaning that there will be little to no recourse for a negative determination.

In addition to these measures, we know that USCIS will be widening the scope of green card applicants or beneficiaries who will be subject to in-person interviews.<sup>48</sup> According to the press release: “Effective Oct. 1, USCIS will begin to phase-in interviews for the following:

- Adjustment of status applications **based on employment** (Form I-485, Application to Register Permanent Residence or Adjust Status).” [Emphasis added].<sup>49</sup>

With all of these measures being propositions, the fundamental questions now are whether they have been implemented and if so, how?

To the former, yes, the inquiries regarding passwords and accounts have been requested by border patrol agents with greater frequency than done previously. We know this from reports<sup>50</sup> and the increased frequency with

which clients have recounted having their cell phones and computers searched, and being placed in secondary screening. Likewise, clients have reported being asked additional and more invasive questions at embassies and consulates with increased frequency.

What is more is that as of September, we have reports that the American Civil Liberties Union and the Electronic Frontier Foundation filed a complaint against the administration on behalf of U.S. citizens and green-card holders. As per *Bloomberg’s* report, “The Trump administration is increasingly allowing federal border agents to seize and search—sometimes violently—the mobile phones and laptops of thousands of U.S. citizens and lawful immigrants as they enter the country [...]”<sup>51</sup> This lawsuit could have a significant impact on the abilities of border agents to search, seize, and detain individuals at the U.S. border, which could impact anyone who crosses the border.

Curiously enough, though, it is unclear whether USCIS has instituted either these or its own extreme-vetting measures what we have seen is a steady use of “requests for evidence” (RFEs) from the USCIS immigration officers who review petitions for visas. The standard procedure to obtain an L, O, P, H or most other visas is such that the petition to have someone receive that visa is filed with USCIS. USCIS then reviews the submitted petition and either approves the submission or requests further evidence. An RFE can have a significant impact on timing, because in most cases, there will be a 90-day window to respond to the RFE, during which processing of the submitted petition is paused. Accordingly, it is important to anticipate and prepare for an RFE, because receiving one is not unusual in the current climate, and this can have drastic consequences for someone who must begin rehearsing, performing, recording, playing, coaching or the like.

#### April 18, 2017

Next, President Trump signed another Executive Order named the “Presidential Executive Order on Buy American and Hire American.”<sup>52</sup> Having discussed this order at length in our last installment of *Sports and Entertainment Immigration*, we will not spend much time on it here. However, it is important to note that then and now, “the Executive Order is neither terrible, nor good: it does not move to terminate the H-1B visa program, but it also does not move to make any real change to the program, which needs significant reforms for it to be useful.”<sup>53</sup> For example, the order directs “the heads of all agencies” to review their agencies’ practices with respect to purchasing American-made goods and hiring American workers, and then develop and submit policies that address any shortcomings of those policies.<sup>54</sup> Without providing much more than some exaggerated language, the order seems to have had little, if any, impact at all, and was more of an offering to die-hard supporters of the President.

## May 23, 2017

On May 23, 2017, the administration released its proposed budget for fiscal year 2018.<sup>55</sup> As it received such negative attention from all sides of the political spectrum, it is highly unlikely to be passed.<sup>56</sup> However, in the interest of totality and to ensure that we fully understand what the current administration is willing to do, I will list some of the key aspects that could impact the sports and entertainment industries. These figures are all based over a 10-year period:

- Elimination of Federal funding for the Corporation of Public Broadcasting;
- Elimination of the Corporation for National and Community Services;
- Elimination of the Institute of Museum and Library Services;
- Elimination of the African Development Foundation and the Inter-American Foundation;
- Elimination of the National Endowment for the Arts;
- Elimination of the National Endowment for the Humanities;
- Elimination of the Economic Development Administration;
- Elimination of the National Oceanic and Atmospheric Administration (NOAA);
- Elimination of the 21st Century Community Learning Centers program;
- Elimination of the Comprehensive Literacy Development Grants program;
- Elimination of the Advanced Research Projects Agency-Energy;
- Elimination of Housing and Urban Development's Community Development Block Grant program;
- Elimination of NASA's "five Earth Science Missions"; and
- Slashing funding for the Department of State and international aid by 29.1 percent, while increasing funding to the Department of Homeland Security by 6.8 percent.<sup>57</sup>

Worth noting, as well, is that the budget includes "\$300 million to recruit, hire, and train 1,500 new immigration agents," as well as "\$75 million to hire 75 new immigration judges and support staff," the latter of which would be a welcome enhancement to the currently sluggish and massively backlogged immigration court system.<sup>58</sup> As reported in *Mother Jones*, "Trump's immigration offers little assistance to immigrants who seek to enter the United States legally—many of whom have recently been

turned back at the border,"<sup>59</sup> which is a fact that we have seen impact musicians, artists, athletes, and an array of individuals from a wide range of industries.

Again, it is unlikely that this will be passed, and we have already seen Congress reject aspects of the budget. However, should any of the proposals referenced herein be enacted, we should be mindful of the impact on those within the U.S. already, their businesses, their performances and productions, and those outside who might seek to come in for those same reasons.

## June 21, 2017

Proceeding to June, with his signature of another Executive Order that "amended the previously issued Executive Order 13597 (Establishing Visa and Foreign Visitor Processing Goals and the Task Force on Travel and Competitiveness), which was signed into law by President Obama in January 2012," President Trump's order, aptly titled, "Amending Executive Order 13597," called for the "removal of language that mandates the Department of State 'ensure that 80 percent of nonimmigrant visa applicants are interviewed within three weeks of submitting a visa application.'"<sup>60</sup> This could readily have an impact on the wait times for many visa applicants around the world seeking to enter or re-enter the U.S. In response, the U.S. Travel Association and 19 other institutions wrote to the administration requesting modifications, by indicating, "with the State Department's focus on increased scrutiny of visa applicants, the Administration should consider lifting any hiring freeze policies at the Department of State[. . .] Trained personnel are necessary to review visa applications, and ensure that potential visitors do not pose a threat to national security."<sup>61</sup>

This could obviously have drastic consequences for touring artists, athletes who need to begin training, artists who have gallery openings, and countless other individuals who need to reach the U.S. for work or simple business/tourist purposes (such as negotiating a performance agreement without actively working under that agreement). Nonetheless, at present, we do not know exactly how this will look, because it will take some time to see the effects of the removal of such express prioritization.

However, we cannot discuss consular processing without referencing the current political discord between the U.S. and Russia. In response to the U.S.'s removal of Russian diplomats, Russia removed 755 DOS employees at the U.S. Embassy and consulates, as of September 1, 2017.<sup>62</sup> Though we are only beginning to see the ramifications of this decision, what is clear is that there is likely to be a noticeable slowdown in visa processing at the U.S. Embassy in Moscow. Therefore, if possible, individuals who would otherwise go to the Embassy or a Consulate in Russia would be best advised to apply for their visas, if possible, in other countries.

## August 2, 2017

We look now to the Reforming American Immigration for a Strong Economy Act, better known as the RAISE Act,<sup>63</sup> which was sponsored by Senators Tom Cotton and David Perdue, and supported by President Trump. The RAISE Act takes aim at permanent residency or green card applicants by winding down the diversity visa program, not allowing green card holders to sponsor their family members, decreases the number of refugees authorized to enter the U.S., and creates a point-based system that would score applicants based upon “predictors of immigrant success.”<sup>64</sup>

However, as reported in *WIRED*, according to Alex Nowrasteh of the Cato Institute: “I think it’s dead on arrival. A lot of Republican senators like legal immigration. They think it’s good for the economy. They think family unification is great. They’re just against illegal immigration.”<sup>65</sup> Therefore, and because it is highly unlikely to go anywhere, we need not waste any more time on the RAISE Act.

## September 18, 2017

Contrary to the RAISE Act’s future, DHS’s monitoring of individuals, their information, and their communications is something that is likely here to stay and progress over time. Despite this, it is important to note before proceeding that DHS, through USCIS, ICE, and the CBP, has been monitoring social media accounts and maintaining information about individuals seeking immigration benefits for some time. As a result, we should be discerning when we read or become aware of news that DHS is implementing “new” policies or “new” monitoring activities as they relate to individuals seeking immigration benefits.

However, with its publication of a notice that it “proposes to modify a current DHS system of records titled, ‘Department of Homeland Security /U.S. Citizenship and Immigration Services, U.S. Immigration and Customs Enforcement, U.S. Customs and Border Protection—001 Alien File, Index, and National File Tracking System of Records’<sup>66</sup> [the System]” in the Federal Register on September 18 (the Notice),<sup>67</sup> DHS is expanding the scope of individuals who will be monitored and is expressly indicating the materials that will be reviewed and retained in DHS’s file system, effective as of October 18, 2017. The System, as amended in 2013, specifies the “categories of individuals covered,” including, among others: “Preparers, attorneys, and representatives who assist individuals during benefit and enforcement proceedings under the INA,” but not civil surgeons, interpreters or law enforcement officers.

The Notice, however, breaks up and expands preparers, attorneys, representatives, and includes civil surgeons, interpreters, and law enforcement officers as individuals who will be subject to monitoring by indicating:

- **Civil surgeons** who are required to conduct and certify medical examinations for immigration benefits; and law enforcement officers who certify a benefit requestor’s cooperation in the investigation or prosecution of a criminal activity;
- **Preparers assisting an individual seeking an immigration benefit or agency action under the INA;**
- **Interpreters** assisting an individual seeking a benefit or agency action under the INA;
- **Attorneys or representatives recognized by USCIS or accredited by the BIA;** or
- **Law enforcement officers** who certify a benefit requestor’s cooperation in the investigation or prosecution of a criminal activity.<sup>68</sup>

This is worrisome, of course, and should give us all cause for concern: By including doctors, lawyers, accredited representatives, and any other person or entity that prepares a petition for submission to USCIS, DHS is confirming that it may conduct searches into those individuals and entities and maintain any such information that it finds in a file related to the beneficiary of that petition.

Similarly, while the System included “U.S. citizens when petitioning for benefits under the Immigration and Nationality Act (INA) on behalf of another individual” under its purview,<sup>69</sup> the Notice broadens the class of person from U.S. citizens to “Individuals,” which could include agents sponsoring one or more artists, and goes a step further to include:

- Individuals acting as legal guardians or designated representatives in immigration proceedings involving an individual who has a physical or developmental disability or mental impairment (as authorized under the INA).<sup>70</sup>

What is most unsavory about this is that the Notice appears to indicate that DHS will be monitoring everyone from natively born U.S. citizens and naturalized U.S. citizens—emphasis here on **U.S. citizens**—to permanent residents and temporary visitors or workers, including those who have been authorized to enter and remain within the U.S.

Knowing *who* is subject to the Notice, we now look at *which information* is subject to the Notice, and in doing so, we see that DHS expressly indicates that it will be looking at “social media handles and aliases, associated identifiable information, and **search results.**”<sup>71</sup> In an age when nearly everyone has a social media profile or account, whether it be on LinkedIn, Facebook, Instagram, Twitter, snapchat, or any other platform, there is an array of information that has been and continues to be made public.

Without further clarification or safeguard measures in place, the expansive nature of looking at and maintaining “search results” related to an individual or entity is

significant cause for concern: What if there are two people with the same name and the wrong party's information is saved in the file? Will USCIS's opinion of an attorney, representative, interpreter or civil surgeon bias its review of the petition that she or he has submitted? How do we ensure that the record is accurate with respect to the parties and their social media handles, aliases, and search results? Furthermore, if the record is not accurate, how do we correct it, so that there is no negative inference made with respect to future submissions or representations?

There are many articles that have been written expressing exasperation with the Notice. It is true that DHS has been looking into and reviewing many of our clients' social media accounts, as well as web-based searches related to each of them, that DHS is now overtly doing so indiscriminately and with respect to such a broad range of individuals and entities is bothersome on many levels and a significant cause for concern.

Due to the potential privacy issues associated with the Notice, it is likely that we will see multiple challenges to its validity. In the meantime, however, we must remain vigilant in protecting our and our clients', as well as our collaborators' and staffs', information. This could have very interesting implications for many of us.

### September 24, 2017

The newly revised travel ban, titled the "Presidential Proclamation Enhancing Vetting Capabilities and Processes for Detecting Attempted Entry Into the United States by Terrorists or Other Public-Safety Threats," signed by the President on September 24, 2017 and scheduled to go into effect as of October 18, 2017 (Proclamation),<sup>72</sup> can also have some interesting implications. As we discussed above, having faced an array of hurdles for his first two travel bans, this third iteration is in response to the array of opinions out of the circuit courts, SCOTUS's opinion regarding the preliminary injunction(s) and authorized admissions, and the impending expiration of the 90-day period.

Though the Proclamation maintains a tenor that is similar to the first two, it curiously lists Chad, North Korea, and Venezuela, in addition to Iran, Libya, Syria, and Yemen, as countries of concern due to their "'inadequate' identity-management protocols [and] information-sharing practices, and risk factors" related to national security and public safety of America and its people.<sup>73</sup> However, what it also does is modify the restrictions on a per-country basis, which CNN sets forth as follows:

- **North Korea and Syria:** Entry as immigrants and non-immigrants is suspended;
- **Chad, Yemen, and Libya:** Entry as immigrants and non-immigrants on some business and tourist visas is suspended;

- **Venezuela:** Entry of certain Venezuelan government officials and their immediate family members as non-immigrants on some business and tourist visas is suspended;
- **Somalia:** Entry as immigrants is suspended, and non-immigrants traveling to the United States will face enhanced screening and vetting requirements; and
- **Iran:** Entry as immigrants and non-immigrants is suspended, except under valid student and exchange visitor visas, with enhanced screening and vetting requirements.<sup>74</sup>

Several of these restrictions are odd: (1) Why is North Korea included in the Proclamation when it is illegal for its citizens to leave without pre-approval (which is not likely to be granted for purely travel purposes); (2) why is Chad included in the Proclamation when "[t]he government of Chad is an important and valuable counterterrorism partner of the United States, and the United States Government looks forward to expanding that cooperation, including in the areas of immigration and border management,"<sup>75</sup> and (3) why is the restriction on Venezuela so limited to impact only a select number of government officials and their families?

It could be argued that the inclusion of North Korea and Venezuela was to counter the argument that it is a ban on Muslim individuals, because, as we can see, "[t]he addition of North Korea and Venezuela now means not all nations on the list are majority-Muslim."<sup>76</sup> Therefore, with these new additions and the more narrowly tailored scope, the question before SCOTUS is whether the Proclamation has effectively rendered moot the pending litigation against Travel Bans 1 and 2. As referenced above, the Supreme Court has determined that no, the Proclamation has not rendered moot the pending litigation against Travel Bans 1 and 2.<sup>77</sup>

However, whatever the motives may be, though this Proclamation is not likely to have a drastic impact on individuals in the entertainment, arts, and sports industries, the reaction to potential Venezuelan petitions for O and P visas could lean negative as a result. As indicated above, we have seen an increase in RFEs for individuals from all countries, so if this is all part of "extreme vetting" or "enhanced screening" measures, then we will need to be mindful of the potential impact on timing and other options available to us: in Fiscal Year 2016, there were 1,528 O and P visas issued to Venezuelan nationals.

### October 8, 2017

This was a surprisingly busy day for the Administration: The President issued (i) a letter to the House and Senate leaders in which he set forth his "Immigration Principles and Policies" (the Letter),<sup>78</sup> and (ii) travel restrictions on Turkish nationals,<sup>79</sup> the latter of which is discussed below in the Additional Actions section. The

letter sets forth “reforms that must be included as part of any legislation addressing the status of Deferred Action for Childhood Arrivals (DACA) recipients,” and claims that they “are necessary to ensure prosperity, opportunity, and safety” for America.<sup>80</sup> Some of those reforms include:

- (a) building “the wall;”<sup>81</sup>
- (b) “blocking sanctuary cities from receiving certain grants or cooperative agreements administered or awarded by the Departments of Justice and Homeland Security;”<sup>82</sup>
- (c) forcing “State and local jurisdictions to provide **all information** requested by ICE relating to aliens in their custody and the circumstances surrounding their detention;”<sup>83</sup>
- (d) authorizing State and local governments to enforce immigration laws, rules, and regulations;<sup>84</sup>
- (e) making it a misdemeanor for and imposing harsh penalties on those individuals who overstay their visa status;<sup>85</sup>
- (f) increasing the number of ICE agents;<sup>86</sup>
- (g) expanding ICE’s ability to detain individuals;<sup>87</sup>
- (h) “[r]equir[ing] the use of the electronic status-verification system (‘E-Verify’) by U.S. employers;”<sup>88</sup> and
- (i) implementing “a new, points-based system for the awarding of Green Cards [...] based on factors that allow individuals to successfully assimilate and support themselves financially.”<sup>89</sup>

It is important to point out that, as with other aspects of the administration’s policies, none of the demands set forth in the letter are new to the conversation. Specifically, they are not new to the President, who has espoused them on numerous occasions.<sup>90</sup> However, as Tamara Keith writes for NPR, “what’s new is demanding that they be included in the legislative fix for the DACA program.”<sup>91</sup> What seems apparent, however, is that the letter confirms the Administration’s seriousness about pursuing and implementing these immigration policies and those that it has espoused since January 2017.

## December 1, 2017

In a previous article from Summer 2017, we touched briefly upon the International Entrepreneur Rule (the “Rule”), which would allow aspiring entrepreneurs the ability to apply for authorization to work and reside in the United States for a total of five years to build their businesses.

The Rule was slated to go into effect in July 2017, but this was not likely because the Administration froze the implementation of all new and/or pending regulations, which “is a fairly standard move for a new administra-

tion taking over from the other party. It effectively halts any lingering policies from the Obama administration before they can be finalized.”<sup>92</sup> However, what was not standard was that in July, rather than implementing the Rule, the Administration delayed its “implementation to March 2018, and said it was ‘highly likely’ to ultimately rescind the [R]ule.”<sup>93</sup> The Administration did this on July 11, 2017, six days before the Rule would have taken effect, by issuing a new Rule (the “Delay Rule”), without offering the public advance notice or an opportunity to comment.<sup>94</sup> On September 19, 2017, the National Venture Capital Association and other start-ups and entrepreneurs, represented by the American Immigration Council and Mayer Brown LLP, brought suit against the DHS arguing that “Because DHS did not solicit advance comment from the public on the delay, it violated clear requirements of the Administrative Procedure Act.”<sup>95</sup> The argument proceeded to indicate that “As a result of the suspension of the [Rule], immigrant entrepreneurs that intended to use the rule have been and will be harmed. The U.S. economy will miss new businesses and jobs that would have been created but that unfortunately will now be created overseas.”<sup>96</sup>

---

---

*“As strange as it may be, it is terribly unclear what will happen to the DACA program that was created by President Obama via executive action and carried out by the DHS through USCIS.”*

---

---

In his decision, Judge Boasberg agreed with the National Venture Capital Association and its cohorts, granted their Motion for Summary Judgment, vacated the Delay Rule and thereby placed DHS in a position to begin swiftly implementing the Rule.<sup>97</sup> As of this writing, it is unclear whether the Administration is going to appeal the decision, though given its past efforts, it would seem likely to do so. Stay tuned, because there are likely to be more developments in this murky space.

## Additional Actions

Though we have covered quite a few, it should be noted that there have been other actions that impact immigration, but are less overt with respect to the sports and entertainment industries.

## Possible Rescission of DACA

As strange as it may be, it is terribly unclear what will happen to the DACA program that was created by President Obama via executive action and carried out by the DHS through USCIS. Though Attorney General Sessions declared that it has been “rescinded,” what he more likely meant was that it will not be enforced any longer. Despite this assertion, President Trump has asked the question, “Does anybody really want to throw out good, educated

and accomplished young people who have jobs, some serving in the military?”<sup>98</sup> Nonetheless, the program is scheduled to be phased out by the end of March 2018, which, as can be seen from the list above, can be a lifetime under the present administration.

---

---

*“Clearly, as the Mar-a-Lago resort, among many others, and numerous racetracks around the U.S. use the H-2B program for seasonal employees, President Trump had an interest in this visa.”*

---

---

### **Authorization of Additional Work Visas (H-2B)**

In response to numerous pleas for help from seasonally-driven industries, the administration “allow[ed] 15,000 more visas for temporary seasonal workers.”<sup>99</sup> As described in the NBC report, “Congress gave DHS the power to authorize more [visas], after consulting with the Labor Department and determining that companies would be significantly harmed if they weren’t able to bring in foreign workers for the season.”<sup>100</sup>

Clearly, as the Mar-a-Lago resort, among many others, and numerous racetracks around the U.S. use the H-2B program for seasonal employees, President Trump had an interest in this visa. What that means for the future of other non-immigrant classifications, we will just have to wait and see.

### **Reciprocal Travel Restrictions on Turkish and American Nationals**

With respect to Turkey, as published in the *Washington Post*, “both governments abruptly announc[ing] they were canceling most visitor visas between the countries [...] illustrated how the critical alliance between Turkey and the United States, anchored in military, intelligence and commercial ties, has been battered in recent months by a series of deep disagreements over the war in Syria and the fate of Fethullah Gulen, a Turkish cleric who lives in exile in Pennsylvania and is wanted by the Turkish authorities.”<sup>101</sup> It is worth being aware of the relationship between the two countries, because, as with the restrictions on Venezuelan nationals, even though these restrictions are not likely to have much of an impact on those in the sports, arts, and/or entertainment industries, there are still a considerable number of work visas held by Turkish nationals.

### **Conclusion**

The current state of immigration is such that we are in a state of uncertainty and change, made all the more convoluted due to an administration that seems unable to provide any amount of clarity about its activities. As many of the immigration activities may have an impact on the sports and entertainment industries, it is important

to take a moment to review what has transpired thus far. We must be mindful of the new level of review being applied to visa applicants, the nationalistic attitude that has continued to be applied to immigration policy, and the potential for timing issues that could arise therefrom.

*Views expressed in this article are of the author only and are not to be attributed to this publication, its editors or the New York State Bar Association.*

### **Endnotes**

1. While the numbers and projections were seemingly dispositive in the evening, an argument could be made that until the final counts were in some time later, he would not have been the “President-elect.”
2. Worth noting here is that this means that we will not be reviewing every action, nor will we be reviewing every immigration or immigration-related action: Some are either too minor or too far removed from our purview for the space here.
3. <https://www.whitehouse.gov/the-press-office/2017/01/25/presidential-executive-order-enhancing-public-safety-interior-united>.
4. <https://www.americanimmigrationcouncil.org/immigration-interior-enforcement-executive-order>. The American Immigration Council (AIC) is referred to here and throughout because of the breadth of research that it undertakes with respect to immigration policy and impact. In the interest of full disclosure, this author has made donations to it in the past.
5. This itself is fantastically broad and worth remembering.
6. <https://www.whitehouse.gov/the-press-office/2017/01/25/presidential-executive-order-enhancing-public-safety-interior-united> [emphasis added].
7. <http://www.cnn.com/2017/08/11/politics/trump-administration-deportations/index.html>.
8. <http://www.latimes.com/local/lanow/la-me-border-patrol-lies-20170113-story.html>.
9. <https://www.ice.gov/news/releases/ice-launches-new-careers-web-content-twitter-feed-attract-applicants>.
10. <https://www.americanimmigrationcouncil.org/immigration-interior-enforcement-executive-order>.
11. <https://www.theatlantic.com/politics/archive/2017/09/federal-court-blocks-trump-crackdown-on-sanctuary-cities/540072/>.
12. <http://www.chicagotribune.com/news/ct-chicago-justice-department-lawsuit-20170807-htmlstory.html>. The full copy of the complaint filed by the City of Chicago has been reproduced online by the Chicago Tribune here.
13. <https://www.whitehouse.gov/the-press-office/2017/01/25/executive-order-border-security-and-immigration-enforcement-improvements>.
14. <http://www.latimes.com/politics/la-na-pol-trump-california-campaign-20160602-snap-story.html>. This was actually said on the campaign trail by then-Candidate Trump. Few, if any, may remember him saying this, so consider it just one more example of why this article may be useful to you in the future.
15. <http://gizmodo.com/donald-trumps-dhs-waives-environmental-regulations-for-1805640368>; <http://www.kvoa.com/story/36348146/waiver-issued-so-construction-of-border-wall-can-begin>; [https://www.upi.com/Top\\_News/US/2017/09/12/Homeland-Security-issues-waivers-to-ramp-up-improved-border-fencing/8291505237888/](https://www.upi.com/Top_News/US/2017/09/12/Homeland-Security-issues-waivers-to-ramp-up-improved-border-fencing/8291505237888/).

16. <https://www.americanimmigrationcouncil.org/research/border-security-and-immigration-enforcement-improvements-executive-order>.
17. <https://www.aclu.org/executive-order-border-security-and-immigration-enforcement-improvements>.
18. <https://www.whitehouse.gov/the-press-office/2017/01/27/executive-order-protecting-nation-foreign-terrorist-entry-united-states>.
19. <https://www.theguardian.com/culture/2017/feb/03/trump-travel-ban-hollywood-visa-crackdown-awards-season>; <http://variety.com/2017/biz/news/hollywoods-overseas-talent-trump-travel-ban-1201973849/>. It should also be noted that other industries have been impacted, such as the hospitality and tourism industries, the tech industry (<http://www.hollywoodreporter.com/news/trumps-travel-ban-may-an-opening-canadian-entertainment-industry-972393>), and many others.
20. <https://www.whitehouse.gov/the-press-office/2017/01/27/executive-order-protecting-nation-foreign-terrorist-entry-united-states> [emphasis added].
21. [http://www.slate.com/blogs/the\\_slatest/2017/01/28/confusion\\_and\\_fear\\_at\\_jfk\\_airport\\_on\\_day\\_one\\_of\\_the\\_muslim\\_ban.html](http://www.slate.com/blogs/the_slatest/2017/01/28/confusion_and_fear_at_jfk_airport_on_day_one_of_the_muslim_ban.html); <https://www.thesun.co.uk/news/2728876/donald-trump-muslim-ban-airport-chaos/>.
22. <http://www.businessinsider.com/trump-immigration-ban-travel-ban-2017-1>; <https://mic.com/articles/166965/refugees-unlawfully-detained-in-airports-after-trumps-immigration-executive-order-lawsuits-filed#K0yUTE9cK>.
23. <https://www.nytimes.com/2017/01/28/us/refugees-detained-at-us-airports-prompting-legal-challenges-to-trumps-immigration-order.html?mcubz=3>.
24. <https://www.nytimes.com/2017/02/04/us/politics/visa-ban-trump-judge-james-robart.html>.
25. <https://www.whitehouse.gov/the-press-office/2017/03/06/executive-order-protecting-nation-foreign-terrorist-entry-united-states>.
26. <https://www.nytimes.com/2017/03/06/us/politics/travel-ban-muslim-trump.html?mcubz=3>.
27. <http://www.npr.org/sections/thetwo-way/2017/03/15/520171478/trump-travel-ban-faces-court-hearings-by-challengers-today>.
28. <http://coop.ca4.uscourts.gov/171351.P.pdf> page 78 (quoting *Franklin v. Massachusetts*, the Court writes, “We recognize that ‘in general,’ this court has no jurisdiction of a bill to enjoin the President in the performance of his official duties.” *Franklin v. Massachusetts*, 505 U.S. 788, 802-03 (1992) opinion of O’Connor, J.) (quoting *Johnson*, 71 U.S. at 501), and that a ‘grant of injunctive relief against the President himself is extraordinary, and should ... raise[] judicial eyebrows.’” *Id.* at 802.).
29. <http://coop.ca4.uscourts.gov/171351.P.pdf>; <http://www.npr.org/sections/thetwo-way/2017/05/25/530051807/4th-circuit-court-ruling-keeps-trumps-travel-ban-on-hold>; <https://www.nytimes.com/2017/05/25/us/politics/trump-travel-ban-blocked.html?mcubz=3>.
30. <http://www.cnn.com/2017/06/12/politics/9th-circuit-ruling-travel-ban/index.html> ; <http://www.cnn.com/2017/06/12/politics/9th-circuit-travel-ban/index.html>.
31. For example, the Supreme Court upheld the admission of individuals who have “bona fide relationships” to persons in the U.S., including grandparents, <http://www.npr.org/sections/thetwo-way/2017/07/19/538115295/supreme-court-upholds-grandparent-exemption-to-trump-travel-ban>; and then delayed the implementation of this broadened definition of individuals who may be exempted from the travel ban, <http://www.npr.org/sections/thetwo-way/2017/09/11/550239945/supreme-court-backs-broad-enforcement-of-travel-ban-for-now>.
32. [https://www.supremecourt.gov/opinions/16pdf/16-1436\\_16hc.pdf](https://www.supremecourt.gov/opinions/16pdf/16-1436_16hc.pdf). In an unsigned opinion issued on June 26, 2017, SCOTUS determined that “when it comes to refugees who lack any such connection to the United States, for the reasons we have set out, the balance tips in favor of the Government’s compelling need to provide for the Nation’s security,” therefore upholding the travel ban against the seven nations for a 90-day period (and 120-days for refugees from Syria) (p. 13, C).
33. <http://www.cnn.com/2017/09/15/politics/will-supreme-court-hear-travel-ban/index.html>.
34. *Id.*
35. <https://www.nytimes.com/2017/12/04/us/politics/trump-travel-ban-supreme-court.html>.
36. *Id.*
37. <https://www.whitehouse.gov/the-press-office/2017/03/06/memorandum-secretary-state-attorney-general-secretary-homeland-security>.
38. <http://www.cnn.com/2016/08/16/politics/how-us-vets-immigrants-donald-trump-extreme-vetting/index.html>.
39. *Id.* (Quoting Donald J. Trump’s campaign speech made on August 15, 2016 in Ohio).
40. <https://www.whitehouse.gov/the-press-office/2017/03/06/memorandum-secretary-state-attorney-general-secretary-homeland-security>.
41. <https://www.nytimes.com/2017/03/23/us/politics/visa-extreme-vetting-rex-tillerson.html?mcubz=3>.
42. <https://www.nytimes.com/interactive/2017/03/23/us/politics/document-Rex-Tillerson-Extreme-Vetting-Cables.html>.
43. [http://live.reuters.com/Event/Live\\_US\\_Politics/791246151](http://live.reuters.com/Event/Live_US_Politics/791246151) [emphasis added]. The other applicable cables are available here: <http://www.reuters.com/article/us-usa-immigration-visas-exclusive/exclusive-u-s-embassies-ordered-to-identify-population-groups-for-tougher-visa-screening-idUSKB16U12X>.
44. It has been reported by reliable authorities that the administration is not interested in simply viewing someone’s social media account, but rather that it wants to be able to access those accounts, <http://abcnews.go.com/Politics/trump-administration-takes-step-extreme-vetting-rule-targeting/story?id=47208177>.
45. <https://www.whitehouse.gov/the-press-office/2017/01/25/presidential-executive-order-enhancing-public-safety-interior-united>.
46. [https://www.washingtonpost.com/opinions/the-trump-administration-might-put-the-extreme-in-extreme-vetting/2017/04/17/8e81f7ca-1ecb-11e7-be2a-3a1fb24d4671\\_story.html?utm\\_term=.72fbd931516a](https://www.washingtonpost.com/opinions/the-trump-administration-might-put-the-extreme-in-extreme-vetting/2017/04/17/8e81f7ca-1ecb-11e7-be2a-3a1fb24d4671_story.html?utm_term=.72fbd931516a); <https://www.wsj.com/articles/trump-administration-considers-far-reaching-steps-for-extreme-vetting-1491303602>.
47. [https://www.washingtonpost.com/opinions/the-trump-administration-might-put-the-extreme-in-extreme-vetting/2017/04/17/8e81f7ca-1ecb-11e7-be2a-3a1fb24d4671\\_story.html?utm\\_term=.f9fb98fa8d33](https://www.washingtonpost.com/opinions/the-trump-administration-might-put-the-extreme-in-extreme-vetting/2017/04/17/8e81f7ca-1ecb-11e7-be2a-3a1fb24d4671_story.html?utm_term=.f9fb98fa8d33).
48. <https://www.uscis.gov/news/news-releases/uscis-to-expand-in-person-interview-requirements-for-certain-permanent-residency-applicants>; <http://thehill.com/homenews/administration/348092-trump-rolls-out-extreme-vetting-for-some-green-cards-report>.
49. *Id.*; see also <https://www.uscis.gov/news/news-releases/uscis-to-expand-in-person-interview-requirements-for-certain-permanent-residency-applicants>.
50. <https://www.bloomberg.com/news/articles/2017-09-13/trump-administration-sued-over-phone-searches-at-u-s-border>.
51. <https://www.bloomberg.com/news/articles/2017-09-13/trump-administration-sued-over-phone-searches-at-u-s-border>.

52. <https://www.whitehouse.gov/the-press-office/2017/04/18/presidential-executive-order-buy-american-and-hire-american>.
53. EASL Summer 2017 article.
54. <https://www.whitehouse.gov/the-press-office/2017/04/18/presidential-executive-order-buy-american-and-hire-american>, Section 3, (b)(i)-(iii).
55. <https://www.whitehouse.gov/sites/whitehouse.gov/files/omb/budget/fy2018/budget.pdf>.
56. Take for instance the Senate budget committee rejecting the proposed cut to HHS. <http://www.modernhealthcare.com/article/20170906/NEWS/170909939>.
57. <http://www.cnn.com/2017/05/23/politics/trump-budget-cuts-programs/index.html>.
58. <http://www.motherjones.com/politics/2017/05/trump-budget-border-wall-immigration-enforcement/>.
59. *Id.*
60. <http://www.travelpulse.com/news/impacting-travel/trade-groups-urge-trump-to-maintain-timely-visa-processing.html>; <https://www.federalregister.gov/documents/2017/06/26/2017-13458/amending-executive-order-13597>.
61. <http://www.travelpulse.com/news/impacting-travel/trade-groups-urge-trump-to-maintain-timely-visa-processing.html>.
62. <https://www.nytimes.com/2017/07/28/world/europe/us-russia-sanctions.html?mcubz=3>.
63. [https://www.cotton.senate.gov/files/documents/170802\\_New\\_RAISE\\_Act\\_Bill\\_Text.pdf](https://www.cotton.senate.gov/files/documents/170802_New_RAISE_Act_Bill_Text.pdf).
64. *Id.*; see also <http://www.migrationpolicy.org/news/raise-act-dramatic-change-family-immigration-less-so-employment-based-system>.
65. *Id.*
66. FR Doc. 2013-27895 Filed 11-20-13 <https://www.gpo.gov/fdsys/pkg/FR-2013-11-21/pdf/2013-27895.pdf>.
67. 82 FR 43556, available at <https://www.federalregister.gov/documents/2017/09/18/2017-19365/privacy-act-of-1974-system-of-records>.
68. *Id.* at 43559 [emphasis added]. To be clear, the language regarding “law enforcement officers” is entered twice, presumably in error, in the original.
69. <https://www.gpo.gov/fdsys/pkg/FR-2013-11-21/pdf/2013-27895.pdf> 69866.
70. <https://www.federalregister.gov/documents/2017/09/18/2017-19365/privacy-act-of-1974-system-of-records> 43559.
71. <https://www.federalregister.gov/documents/2017/09/18/2017-19365/privacy-act-of-1974-system-of-records> at 43560 [emphasis added].
72. <https://www.whitehouse.gov/the-press-office/2017/09/24/enhancing-vetting-capabilities-and-processes-detecting-attempted-entry>.
73. *Id.*
74. <http://www.cnn.com/2017/09/24/politics/trump-travel-restrictions/index.html>.
75. Proclamation, section (2)(a) <https://www.whitehouse.gov/the-press-office/2017/09/24/enhancing-vetting-capabilities-and-processes-detecting-attempted-entry> (EN lxx).
76. <http://www.bbc.com/news/world-us-canada-41382585>.
77. See *supra* note 35.
78. <https://www.whitehouse.gov/the-press-office/2017/10/08/president-donald-j-trumps-letter-house-and-senate-leaders-immigration>.
79. [https://www.washingtonpost.com/world/us-halts-some-visa-services-in-turkey-citing-security-concerns/2017/10/08/02bdc01a-ac52-11e7-9b93-b97043e57a22\\_story.html?utm\\_term=.57e7de0f440e](https://www.washingtonpost.com/world/us-halts-some-visa-services-in-turkey-citing-security-concerns/2017/10/08/02bdc01a-ac52-11e7-9b93-b97043e57a22_story.html?utm_term=.57e7de0f440e).
80. *Id.*
81. <https://www.whitehouse.gov/the-press-office/2017/10/08/president-donald-j-trumps-letter-house-and-senate-leaders-immigration>, 1.A. Border Security, Border Wall.
82. *Id.* at 2.A. Interior Enforcement, Sanctuary Cities. It is unclear whether the administration was aware of the array of grants that are made by the Departments of Health and Human Services, and Housing and Urban Development.
83. *Id.* at 2.A.iv. [emphasis added].
84. *Id.* at 2.B.
85. *Id.* at 2.C.
86. *Id.* at 2.D.
87. *Id.* at 2.E.
88. *Id.* at 2.F [emphasis added].
89. *Id.* at 3.A.
90. <http://www.npr.org/2017/10/08/556564184/trump-sends-immigration-principles-to-congress-including-border-wall-demand>.
91. *Id.*
92. <http://www.cnn.com/2017/01/20/politics/reince-priebus-regulations-memo/?iid=EL>.
93. <https://www.reuters.com/article/us-usa-immigration-entrepreneurs/u-s-judge-rejects-delay-of-foreign-entrepreneur-immigration-rule-idUSKBN1DW02E>.
94. [https://ecf.dcd.uscourts.gov/cgi-bin/show\\_public\\_doc?2017cv1912-29](https://ecf.dcd.uscourts.gov/cgi-bin/show_public_doc?2017cv1912-29).
95. <https://nvca.org/pressreleases/nvca-entrepreneurs-startups-file-lawsuit-challenging-delay-international-entrepreneur-rule/>.
96. *Id.*
97. See *supra* note 91.
98. <https://www.cnn.com/2017/09/14/trump-denies-dreamer-deal-was-made-tweets-in-defense-of-illegal-immigrants.html>.
99. <https://www.nbcnews.com/news/us-news/trump-administration-allows-15-000-temporary-worker-visas-n783706>.
100. *Id.*
101. [https://www.washingtonpost.com/world/us-halts-some-visa-services-in-turkey-citing-security-concerns/2017/10/08/02bdc01a-ac52-11e7-9b93-b97043e57a22\\_story.html?utm\\_term=.57e7de0f440e](https://www.washingtonpost.com/world/us-halts-some-visa-services-in-turkey-citing-security-concerns/2017/10/08/02bdc01a-ac52-11e7-9b93-b97043e57a22_story.html?utm_term=.57e7de0f440e).

**Michael Cataliotti is the Principal of Cataliotti Law P.C., a law firm concentrating on business immigration, and corporate and entertainment transactions for individuals and entities from such industries as sports, music, fashion, film, television, art, and theatre. He is a faculty member at Lawline CLE, a frequent speaker on the topics of sports and entertainment immigration, entrepreneurship, and start-up transactions, an active member of the American Immigration Lawyers Association’s (AILA’s) New York Chapter, and an active supporter of immigration reform.**

## RESOLUTION ALLEY

# Arbitration of Art and Cultural Heritage Disputes

By Theodore K. Cheng

*Resolution Alley is a column about the use of alternative dispute resolution in the entertainment, arts, sports, and other related industries.*

The growth in art transactions around the world has led to a corresponding increase in the growth of art law as a field of expertise and a rise in art and cultural heritage disputes. For example, in 2015, *The New York Times* reported that Dmitry E. Rybolovlev, a Russian billionaire and owner of one of the world's most valuable art collections, was involved in "what has become perhaps the largest feud in the art world today" with Yves Bouvier, a Swiss businessman, who acted as a sort of broker to assist Rybolovlev in acquiring various pieces of art over the years.<sup>1</sup> Apparently, the two have been battling in courtrooms all around the world—in Paris, Monaco, Singapore, and Hong Kong—over accusations that Bouvier overcharged as much as \$1 billion for multiple pieces of art. It began when Rybolovlev discovered that he had paid \$118 million for a Modigliani painting, brokered through Bouvier, that the seller had sold for only \$93.5 million—a difference of nearly \$25 million.<sup>2</sup>

---

---

*"Like a judge in a court proceeding, the arbitrator (or tribunal) is tasked with determining the merits of the dispute, in a final and binding manner, according to rules and procedures that are agreed-upon by the parties."*

---

---

Practitioners in art law will readily attest that the interdisciplinary nature of that field means that disputes over art and cultural heritage can involve a host of different subject areas. Such areas include the application of copyright law principles, ownership issues, the operation of contractual obligations, accusations of potential theft and misappropriation, discovery of forgeries, respect for cultural expression, and adherence to cultural property norms. In turn, these issues lead to a greater likelihood that art and cultural heritage disputes will involve complex legal issues. At their core, they can also involve other sensitive commercial, financial, cultural, ethnic, religious, spiritual, historical, and ethical issues. Moreover, art and cultural heritage disputes are diverse by their very nature and are nearly guaranteed to involve a variety of parties with multiple interests, such as artists and their families, auction houses, art collectors, art dealers, art brokers, archives, galleries, museums, libraries, universities, indigenous communities, anthropologists, banks, and even sovereign states.

Thus, resolving art and cultural heritage disputes is exceedingly challenging, especially with the global expansion of art transactions, in which the parties to the disputes hail from different countries, with markedly disparate jurisdictions and cultural backgrounds. As Rybolovlev and Bouvier are likely finding out, the choice of a particular country's court system in which to resolve the dispute is a daunting matter, publicly airing the dispute in an open forum presided over by an adjudicator who is unlikely to have any legal or other knowledge about art law, art and cultural heritage disputes, or perhaps even art and cultural heritage in general. These proceedings will likely also be costly, take an inordinate amount of time to conclude, require enormous investment of emotional capital, and, ultimately, take control away from the parties over how the ultimate resolution will be achieved.

One way to minimize or eliminate the drawbacks of relying upon traditional court litigation to address art and cultural heritage disputes is to consider arbitration as a mechanism to resolve them. Arbitration is well suited to addressing art and cultural heritage disputes where the parties anticipate requiring that the decision maker have specific subject matter and/or industry expertise.<sup>3</sup> The selection of an appropriate arbitrator (or tribunal) is critical to achieving a just result, because the parties typically want an arbitrator who can appreciate the legal issues and the technical, cultural, and other issues pertaining to art transactions, valuation issues, and other relevant norms. Like a judge in a court proceeding, the arbitrator (or tribunal) is tasked with determining the merits of the dispute, in a final and binding manner, according to rules and procedures that are agreed upon by the parties. Unlike in a court proceeding, however, the parties to an arbitration proceeding can choose the arbitrator (or tribunal) based upon relevant criteria, such as copyright expertise or prior art transaction experience. Moreover, if properly managed by the arbitrator (or tribunal), the parties, and their counsel, arbitration can result in a dispute resolution process that is fair, expeditious, and cost-effective. Through all of this inherent flexibility, the parties can better exercise control over how the resolution of their dispute will be achieved.

Arbitration is also generally a confidential process.<sup>4</sup> This tenet of confidentiality may be important in art and cultural heritage disputes as a way to preserve the parties' professional and personal reputations. (For Rybolovlev, however, because he views what Bouvier did as "a personal act of betrayal," for tactical reasons, out of

principle, or just plain spite, eschewing confidentiality in favor of a public trial may be exactly what he desires.) Confidentiality of the proceedings can also, in some cases, help protect the value of the art works themselves, which can suffer a decline as a result of being associated with a public dispute.

Additionally, the ability to secure a preliminary injunction or other interim relief in an arbitration setting is a valuable attribute for selecting this method of dispute resolution. All of the major international arbitration providers—the London Court of International Arbitration, the International Chamber of Commerce, the International Centre for Dispute Resolution, the CPR Institute, and JAMS—have emergency arbitrator provisions in their default rules. If the availability of preliminary remedies is a consideration in how to address an immediate concern—such as preventing works of art from being transferred overseas, attaching the pieces of art in question, stopping the sale of art over which ownership is being contested, or freezing the proceeds of art transactions—arbitration might be a viable option in some cases.

---

---

*“In view of the advantages that arbitration affords, parties should be encouraged to consider this option more seriously lest their disputes overtake them and become the latest public ‘feud in the art world.’”*

---

---

When it comes to providers, another one to consider specifically for art and cultural heritage disputes is the World Intellectual Property Organization (WIPO), a self-funded agency of the United Nations that provides neutral, international, and non-profit alternative dispute resolution options. The WIPO Arbitration and Mediation Center (WIPO Center), which is based out of Geneva, Switzerland and has an outpost in Singapore, was established in 1994 to offer various such options, including arbitration, for the resolution of international commercial disputes between private parties.<sup>5</sup> The WIPO Center is widely recognized as particularly appropriate for technology, entertainment, and other disputes involving intellectual property, such as art and cultural heritage disputes.<sup>6</sup> Aside from administering art and cultural heritage disputes, the WIPO Center also maintains an extensive roster of highly qualified, independent, and specialized arbitrators who have demonstrated expertise in such disputes. Moreover, it stands ready to assist parties and their counsel in designing an arbitration process that is tailored to meet their needs and concerns, affording them guidance and training both before and after a dispute arises.

Perhaps of most significance to art and cultural heritage disputes is the advantage, in international arbitra-

tion proceedings, to resolve cross-border disputes and have the arbitration award recognized and enforced in most countries in the world through the operation of the Convention on the Recognition and Enforcement of Foreign Arbitral Awards, which is also known as the New York Convention.<sup>7</sup> This international treaty was adopted on June 10, 1958 by the United Nations Commission on International Trade Law (UNCITRAL) and entered into force on June 7, 1959. The United States ratified the treaty on September 30, 1970. As of March 2017, 157 state parties had become signatories to the New York Convention, including 154 of the 193 United Nations members. The treaty requires courts of contracting states to give effect to private agreements to arbitrate and to recognize and enforce—subject to certain, limited defenses—arbitration awards made in other contracting states. It is without question one of the driving forces behind the growth and stability of international arbitration as a means of resolving global and cross-border disputes.

One reason that the New York Convention has been so important in promoting international arbitration is that the United States is not a signatory to any convention or treaty that requires recognition or enforcement of foreign court judgments. Moreover, there is no federal law governing the recognition or enforcement of foreign court judgments; nor will foreign court judgments be recognized through the use of a letter rogatory or letter of request.<sup>8</sup> Instead, recognition of foreign judgments is provided by the laws of the individual states or by common law.<sup>9</sup>

Of course, all of this depends on whether the parties to the art and cultural heritage dispute have previously contracted to use arbitration to resolve their disputes or can now prospectively agree, in the face of the pending dispute, to arbitrate their matter. While the empirical evidence is elusive, there appears to be closer attention being paid, if not renewed emphasis, on arbitration clauses being included in international contracts pertaining to works of art, particularly in connection with loans (art works as collateral), sales and other transactions directly relating to pieces of art, and insurance of art works. In view of the advantages that arbitration affords, parties should be encouraged to consider this option more seriously lest their disputes overtake them and become the latest public “feud in the art world.”

## Endnotes

1. Doreen Carvajal and Graham Bowley, *The Billionaire, the Picassos and a \$30 Million Gift to Shame a Middleman*, N.Y. TIMES (Sept. 23, 2015), available at <https://www.nytimes.com/2015/09/24/arts/design/the-billionaire-the-picassos-and-a-30-million-gift-to-shame-a-middleman.html>.
2. The article goes on to report that, in a ploy aimed at shaming Bouvier, Rybolovlev intended on returning two Picasso portraits, valued at \$30 million, to the artist’s stepdaughter, who had claimed that they had been stolen from her. Rybolovlev had also purchased the works from Bouvier, and, by returning them,

Rybolovlev was attempting to draw further attention to his dispute with Bouvier.

3. According to a study conducted by the Rand Institute for Civil Justice, the majority of the respondents found that arbitrators are more likely to understand the subject matter of the arbitration than judges because they can be selected by the parties. See Rand Institute for Civil Justice, *Business-to-Business Arbitration in the United States: Perceptions of Corporate Counsel*, (2011) at 1-2, 32, available at [www.rand.org/content/dam/rand/pubs/technical\\_reports/2011/RAND\\_TR781.pdf](http://www.rand.org/content/dam/rand/pubs/technical_reports/2011/RAND_TR781.pdf).
4. See generally Theodore K. Cheng, *Maintaining Confidentiality in Arbitration*, N.Y. STATE BAR ASSOC. ENTMTNT, ARTS AND SPORTS L. J., Vol. 28, No. 2, at 25 (Summer 2017).
5. See WIPO Arbitration and Mediation Center, available at <http://www.wipo.int/amc/en/center/background.html>.
6. See WIPO Alternative Dispute Resolution (ADR) for Art and Cultural Heritage, available at <http://www.wipo.int/amc/en/center/specific-sectors/art/>.
7. See UNCITRAL Convention on the Recognition and Enforcement of Foreign Arbitral Awards, available at [www.uncitral.org/uncitral/en/uncitral\\_texts/arbitration/NYConvention.html](http://www.uncitral.org/uncitral/en/uncitral_texts/arbitration/NYConvention.html); New York Arbitration Convention, available at [www.newyorkconvention.org](http://www.newyorkconvention.org).
8. Each of these devices is a formal request from one court to a court in a foreign country requesting judicial assistance. For example, U.S. litigators often use them to effectuate service of process or the taking of evidence in other countries.
9. To address the concern that U.S. and foreign courts were not regularly recognizing each other's judgments, in 1962, the Uniform Law Commissioners promulgated the Uniform Foreign Money-Judgments Recognition Act (the 1962 Model Act). The 1962 Model Act generally codified the principles of comity (and, specifically, the recognition and enforcement of foreign judgments) previously set forth in *Hilton v. Guyot*, 159 U.S. 113 (1895) and has been adopted by 31 states (including New York), the District of Columbia, and the U.S. Virgin Islands. See Uniform Law Commission Legislative Fact Sheet—Foreign Money Judgments Recognition Act, available at <http://www.uniformlaws.org/LegislativeFactSheet.aspx?title=Foreign%20Money%20Judgments%20Recognition%20Act>. The Uniform Law Commissioners updated the 1962 Model Act in 2005 by promulgating the Uniform Foreign-Country Money Judgments Recognition Act, which has been adopted by 23 states and the District of Columbia, but not New York. See Uniform Law Commission Legislative Fact Sheet—Foreign-Country Money Judgments Recognition Act, available at <http://www.uniformlaws.org/LegislativeFactSheet.aspx?title=Foreign-Country%20Money%20Judgments%20Recognition%20Act>.

**Theodore K. Cheng is an arbitrator and mediator with the American Arbitration Association, the CPR Institute, Resolute Systems, and several federal and state courts, principally focusing on intellectual property, entertainment, technology, and labor/employment disputes. He is also an intellectual property and commercial litigation partner at the international law firm of Fox Horan & Camerini LLP in New York City. More information is available at [www.linkedin.com/in/theo-cheng](http://www.linkedin.com/in/theo-cheng), and he can be reached at [tcheng@foxlex.com](mailto:tcheng@foxlex.com).**

## NEW YORK STATE BAR ASSOCIATION

# CONNECT WITH NYSBA

Visit us on the Web:  
[www.nysba.org](http://www.nysba.org)

Follow us on Twitter:  
[www.twitter.com/nysba](http://www.twitter.com/nysba)

Like us on Facebook:  
[www.facebook.com/nysba](http://www.facebook.com/nysba)

Join the NYSBA  
LinkedIn group:  
[www.nysba.org/LinkedIn](http://www.nysba.org/LinkedIn)



# Making the Perfect Pitch

By Neville L. Johnson and Douglas L. Johnson

## Introduction

Theft of idea and copyright litigation keep lawyers very busy, as dishonesty involving literary property is very real. Hollywood's currency is good and valuable ideas. A creative executive who has no ideas can find him or herself without a job. Protectable intellectual property can be as simple as an expression of an idea or as complex as a completed screenplay or book. The starting point in idea theft is whether the idea is protectable. The fundamental belief is that ideas, on their own, are not legally protected.

Some ideas are so commonplace and ordinary that they are excluded from copyright law protection under the *scènes a faire* doctrine. The most common example of this doctrine is the plot from Shakespeare's *Romeo and Juliet*, the story of two young people from warring families who fall in love with tragic results. A Wikipedia page currently lists 88 film and television adaptations of *Romeo and Juliet*.

The most important method of selling ideas in the film and television industry is the pitch. How, then, does the intellectual property exchanged in a pitch meeting secure legal protection? Ordinarily before the pitch, there is no written contract between the two parties to buy and sell the idea. What is to stop the recipient from appropriating every good idea that comes his or her way? One legal protection for ideas is known as the "implied-in-fact" contract. California courts have held that an implied contractual right to compensation may arise when a creative submits material to a producer with the understanding that the creator will be paid if the producer uses that idea.

Given the possibility of an implied-in-fact contract, the recurring question asked by clients on both sides of the pitch is how to avoid claims of idea theft. How can the writers submitting intellectual property protect their rights in their submissions? Conversely, how can recipients of submitted scripts protect themselves from accusations of idea theft?

## Development of the Implied-in-Fact Contract in California

California's courts began wrestling with these questions in the 1950s in the seminal case *Desny v. Wilder*.<sup>1</sup> In that case, Victor Desny called director Billy Wilder at Paramount Pictures with a "great idea" for a movie. The central idea of the movie was the life story of Floyd Col-



lins, a boy who became trapped in a cave 80 feet deep. Desny could not get past Wilder's secretary, who told him that the 65-page treatment was too long for Wilder to read.

Three days later, Desny called back with a three-page outline. Wilder's secretary asked Desny to read the outline over the phone so that she could take it down in shorthand, and he did. The secretary told Desny that she liked the story, would talk it over with Wilder, and "let him know" what happened. Desny told the secretary that Paramount and Wilder could only use the story if they paid him. To Desny's surprise, Wilder and Paramount made a movie concerning the life and death of Floyd Collins, *Ace in the Hole*, which closely paralleled Desny's synopsis, as well as the historical material on Floyd Collins. The film also included fictional material unique to Desny's synopsis. Desny sued, claiming that Wilder and Paramount breached an implied contract.

The California Supreme Court agreed with Desny, recognizing that even when an unsolicited idea submission is made, the circumstances of the disclosure may support the finding of an implied-in fact-contract:

Usually the parties will expressly contract for the performance of and payment for such services, but, in the absence of an express contract, when the service is requested and rendered the law does not hesitate to infer or imply a promise to compensate for it. In other words the recovery may be based on contract either express or implied. The person who can and does convey a valuable idea to a producer who commercially solicits the service or who voluntarily accepts it knowing that it is tendered for a price should likewise be entitled to recover.<sup>2</sup>

A plaintiff suing for breach of implied-in-fact contract relating to an idea submission must prove that (1) he or she conditioned his or her offer to disclose the idea to the defendant on the defendant's express promise to pay for the idea if the defendant used it, (2) the defendant, knowing the condition before the idea was disclosed to him or her, voluntarily accepted its disclosure, and (3) the defendant found the idea valuable and used it.<sup>3</sup>

For an implied-in-fact contract to form, the recipient must understand the conditions under which the idea is

being disclosed. If, for example, the creator blurts out the idea to a Hollywood producer who he or she just met at a bar, then there is no contract.<sup>4</sup> The recipient must be given the opportunity to reject the submission before it is conveyed. Unsolicited pitches rarely have legal protection. Therefore, the eager creative should not tell anyone and everyone in town about an idea, because the likelihood is that it will be stolen unless the disclosure is made under circumstances where the recipient either requested the idea, or it was understood from the circumstances that there is an expectation of payment, e.g., a pitch meeting at a studio.

---

---

*“Where a producer has previously earned executive producer fees and backend participation in the past, damages will likely be greater.”*

---

---

Two elements are required to raise the inference of use: the defendant had access to the plaintiff’s idea and copied it.<sup>5</sup> Copying can be demonstrated by showing that the defendant’s work is substantially similar to the plaintiff’s idea.

Where a writer or producer conveys an idea to a potential purchaser, and the defendant produces a product similar to that idea, an inference arises that recipient used the idea.<sup>6</sup> Moreover, less similarity is required when the evidence of access is stronger, but the similarity must be to a material element or qualitatively important part, and could range from a mere basic theme up to an extensively elaborated idea.<sup>7</sup>

Access to the idea is proven if one is able to show the person creating the movie had an opportunity to view or copy the plaintiff’s work.<sup>8</sup> Access can also be established if the recipient of the idea was an individual in a position to provide suggestions or comment to a supervisory employee, or an employee within the unit from which the defendant’s work was developed.<sup>9</sup> However, a court recently dismissed a case where a project had been submitted to a major agency and another agent there could have had access to it, on the basis that this was too speculative.<sup>10</sup>

The substantial similarity requirement in a *Desny* claim is much lower than in a copyright case. Substantial similarity in Ninth Circuit copyright cases is subject to a much more rigorous test involving both extrinsic and intrinsic similarity:

Proof of the substantial similarity is satisfied by a two-part test of extrinsic similarity and intrinsic similarity. Initially, the extrinsic test requires that the plaintiff identify concrete elements based on objective criteria. The extrinsic test often requires analytical dissection of

a work and expert testimony. Once the extrinsic test is satisfied, the factfinder applies the intrinsic test. The intrinsic test is subjective and asks “whether the ordinary, reasonable person would find the total concept and feel of the works to be substantially similar.”<sup>11</sup>

Likewise, in the Second Circuit, substantial similarity is complex, requiring that the copying be both qualitatively and quantitatively sufficient to conclude that actionable copying has occurred.<sup>12</sup> The qualitative component concerns the copying of expression, rather than ideas, a distinction that often turns on the level of abstraction at which the works are compared. The quantitative component generally concerns the amount of the copyrighted work that is copied.<sup>13</sup>

New York also recognizes *Desny*-type claims.<sup>14</sup> New York law adds an extra element: an idea must be novel to the buyer for an implied-in-fact contract to exist.<sup>15</sup>

## **Advantages and Disadvantages of *Desny* Claims versus Copyright Claims**

A *Desny* claim and a copyright claim may be brought together in the same lawsuit. Both types of claims will revolve around the timing of the idea theft. The same evidence will be used to establish the case, including emails, computer hard drive searches, and witness depositions. While a *Desny* claim and a copyright claim may be brought simultaneously, both have advantages and disadvantages.

### **Damages**

The winner of a copyright infringement case is entitled to his or her actual damages, as well as all profits the infringer made from the project.<sup>16</sup> A prevailing plaintiff in a *Desny* claim, however, must prove the reasonable value of the ideas used by the defendant. Where a submitter has no proven track record of having his or her work produced, the defendant will assert that damages are limited by the writer’s stature. Where a producer has previously earned executive producer fees and backend participation in the past, damages will likely be greater.

However, some courts have held that damages should be based on the value of the idea to the defendant.<sup>17</sup> Damages are problematic for rookie writers and producers in *Desny* claims, and a case may not be worth pursuing for this reason.

### **State Court Advantage**

The *Desny* claim can be filed in state court, while copyright claims are limited to federal court. In California state court, a plaintiff may prevail if he or she convinces nine out of the 12 jurors. In New York state court, a verdict may be rendered by five out of the six jurors. Federal

courts require a unanimous jury verdict for a plaintiff to prevail.

### Attorney Fees

The prevailing party in a copyright case may be able to recover his or her attorney fees and costs incurred in the litigation. This could be in the hundreds of thousands of dollars. However, this award cuts both ways—an unsuccessful plaintiff could find him or herself bankrupted by these fees and costs. Attorney fees are not automatically given to the winning party, but are subject to the court's discretion. The court must give substantial weight to the objective reasonableness of the losing party's position before making such an award.<sup>18</sup>

For example, in two recent trials involving songs by Marvin Gaye and Led Zeppelin, the courts used discretion in denying the attorney fees award, finding that the case presented novel issues and the outcome of those issues was far from clear during the litigation.<sup>19</sup> Due to this issue, a plaintiff may be better filing only a *Desny* claim in State court.

---

---

*"The submission agreement may also include a provision for mandatory mediation or binding arbitration in the event of a dispute, and a provision giving attorney fees to the prevailing party."*

---

---

### Copyright Claims Require Registration

A copyright claim is predicated on registration of the idea with the U.S. Copyright Office. An owner of intellectual property cannot recover statutory damages (minimum damages) or attorney fees unless the idea was registered with the copyright office three months before the disclosure or publication of the work.<sup>20</sup> Copyright registration opens the door to these damages, which can be a big stick in obtaining a settlement.

### Independent Creation Defense to *Desny* Claim

The independent creation defense is the primary defense against a *Desny* claim. This defense allows the defendant to overcome a claim by affirmatively proving that any similarity is purely coincidental, and that no use of the plaintiff's idea occurred because the defendant's project was independently created.<sup>21</sup>

### Making Submissions—Best Practices

The easiest way to protect ideas when making a pitch is to create a clear paper trail long before that meeting with the producer. Creating a paper trail begins with registering the idea. It is advisable that all treatments and scripts be registered with the U.S. Copyright Office immediately upon creation. The Writers Guild of America

provides a registration service for use by the general public, as well as its members. The purpose of this registration is to establish the completion dates of material written for film and television. The registration provides a dated record of the idea, a date that will be the crux of any infringement or breach of contract action.

A "leave behind," the written pitch, is and should usually be left with the person(s) being pitched. In addition, the paper trail should continue after the pitch, such as sending a follow-up email to the recipient of the idea thanking the person who took the pitch. Again, this will help prove the timing of the submission.

Protection of the idea with this paper trail implicates more than payment for the idea. It also protects a potential writing credit. The importance of receiving a writing credit goes far beyond immediate monetary compensation. In the film and television world, the writing credit is particularly valuable and can be career defining, as it performs a marketing function, and helps set the "quote"; assists in negotiating for a higher rate of compensation once a job opportunity has been offered; and can assist in obtaining additional compensation based on a substantial contribution to a project as reflected by the credit received.<sup>22</sup> Credits are of "extreme and vital importance," and are "the lifeblood in this industry."<sup>23</sup>

### Receiving Submission—Best Practices

The recipient of ideas should also be concerned about possible claims of idea theft and should take steps to avoid such claims. The obvious first step is to refuse to accept unsolicited submissions of ideas. The second line of defense is use of a submission agreement, which should be fully executed before the contents of the submitted work are disclosed. These agreements will commonly include a provision stating that the person submitting the idea understands that the recipient may have a similar idea in progress. The submission agreement may also include a provision for mandatory mediation or binding arbitration in the event of a dispute, and a provision giving attorney fees to the prevailing party.

The downside of demanding mandatory arbitration is the cost. Another downside with commonly used arbitrators like JAMS is the issue of institutional bias.<sup>24</sup> The submission agreement is often not required when the writer is established and represented by a reputable agent or attorney.

### Conclusion

Theft of ideas is commonplace, as well as meritless lawsuits. It is advisable for one to be aware and do the best to protect one's client. Courtrooms are not the theatre for ideas to be played out.

## Endnotes

1. 46 Cal.2d 715, 731 (1956).
2. *Id.* at 733-34.
3. *Id.* at 738-39.
4. *See id.* at 739.
5. *Sutton v. Walt Disney Productions*, 118 Cal.App.2d 598, 603 (1953).
6. *Hollywood Screentest of America, Inc. v. NBC Universal, Inc.*, 151 Cal. App.4th 631, 646 (2007).
7. *Golding v. R.K.O. Pictures*, 35 Cal.2d 690, 695 (1950); *Fink v. Goodson-Todman Enterprises, Ltd.*, 9 Cal.App.3d. 966, 1007-08, fns. 14, 15 (1970).
8. *Meta-Film Assocs., Inc. v. MCA, Inc.*, 586 F. Supp. 1346, 1355 (C.D. Cal. 1984).
9. *Id.* at 1357.
10. *Counts, et al. v. Meriwether, et al.*, U.S. District Court for the Central District of California, Case No. 14-cv-000396.
11. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000) (citations omitted).
12. *Castle Rock Entertainment, Inc. v. Carol Pub. Group, Inc.*, 150 F.3d 132, 138 (2d Cir. 1998).
13. *Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997).
14. *Downey v. General Foods Corp.*, 31 N.Y.2d 56 (1972); *Nadel v. Play-By-Play Toys & Novelties, Inc.*, 208 F.3d 368, 376 (2d Cir. 2000).
15. *See e.g., Am. Bus. Training v. Am. Mgmt. Ass'n*, 50 A.D.3d 219 (1st Dept. 2008).
16. 17 U.S.C. § 504(b).
17. *See Donahue v. United Artists Corp.*, 2 Cal. App.3d 794, 804 (1969).
18. *Kirtsaeng v. John Wiley & Sons, Inc.*, 136 S. Ct. 1979 (2016).
19. *Williams, et al. v. Gaye, et al.*, U.S. District Court for the Central District of California, Case No. 13-cv-06004; *Skidmore v. Led Zeppelin, et al.*, U.S. District Court for the Central District of California, Case No. 15-cv-03462.
20. 17 U.S.C. § 412.
21. *Hollywood Screentest of Am., Inc. v. NBC Universal, Inc.*, 151 Cal. App.4th 631, 646-47 (2007); *Mann v. Columbia Pictures, Inc.*, 128 Cal. App.3d 628, 650-51 (1982).
22. Selz, et al., ENTERTAINMENT LAW (Thomson Reuters, 3d Ed. 2016) § 22:15; see § 22:23 (“The fact that the recipient’s billing is well-known due to past successes can justify more money than would be paid for the same rights, money or services from someone not as famous”).
23. *Id.* at § 22:15.
24. *See Johnson & Johnson, Hollywood Docket: One Sided World*, 27 New York State Bar Assn, Entertainment, Art and Sports Law Journal, 23 (2016). This article points out that the major studios love mandatory arbitration, and there is a perceived bias by arbitrators who it is believed will be more lenient on them so as to garner repeat business.

**Neville Johnson and Douglas Johnson are partners at Johnson & Johnson LLP, in Beverly Hills, CA, which focuses on entertainment litigation and transactions. Associate Ron Funnell assisted in writing the article.**

## NEW YORK STATE BAR ASSOCIATION

If you have written an article you would like considered for publication, or have an idea for one, please contact the Editor-in-Chief:

**Elissa D. Hecker**  
**Law Office of Elissa D. Hecker**  
**64 Butterwood Lane East**  
**Irvington, NY 10533**  
**eheckeresq@eheckeresq.com**

*Articles should be submitted in electronic document format (pdfs are NOT acceptable), along with biographical information.*

# REQUEST FOR ARTICLES



# All's Fair (Use) in Love and Trademarks

By Cheryl Davis

In the world of intellectual property law, our legal headlines have long been full of cases about what constitutes “fair use” in the copyright area. Yet what about trademarks? Has the fair use frenzy spread to that area of the law as well?

## The Letter of the Law

Like the copyright statute, the trademark statute expressly addresses the issue of when one may use a registered trademark (even without permission):<sup>1</sup>

[When] the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.<sup>2</sup>

Furthermore, just like fair use in the copyright context, fair use of a trademark is only a defense to a claim of infringement, not a get-out-of-litigation-free-card. Courts will look at how and why the trademark is being used in determining if an infringement has taken place.

## “Classic” Claims

There are several ways in which the fair use defense can be asserted in the trademark context. One is when the trademark term is used not as a designator of a good or service, but for its ordinary, descriptive meaning (*i.e.* “descriptive of and used fairly and in good faith only to describe the goods or services”). This is considered to be statutory, or classic fair use, and is expressly addressed by the terms of the Lanham Act as set forth above. Even the likelihood of confusion caused by two parties' use of the same (or similar) term for their products cannot eliminate this defense, as the U.S. Supreme Court held in *KP Permanent Makeup, Inc. v. Lasting Impressions 1, Inc.*<sup>3</sup> In that case, both parties used the term “micro color” to describe their products, although only Lasting Impression had registered that term as a trademark. The Court recognized the existence of the statutory fair use defense, but granted certiorari to determine whether the likelihood of consumer confusion could defeat it. The Court found that:

Since the burden of proving likelihood of confusion rests with the plaintiff and the fair use defendant has no freestanding need to show confusion unlikely, it follows...that some possibility of consumer

confusion must be compatible with fair use, and so it is. The common law's tolerance of a certain degree of confusion on the part of consumers followed from the very fact that in cases like this one an originally descriptive term was selected to be used as a mark, not to mention the undesirability of allowing anyone to obtain a complete monopoly on use of a descriptive term simply by grabbing it first.<sup>4</sup>

## The Name Game

Another way in which the fair use defense can be used is when A uses B's trademark to identify or describe B's own services; this is often referred to as nominative fair use. In *New Kids on the Block v. News America Publishing Inc.*,<sup>5</sup> two newspapers conducted polls about the “New Kids on the Block” (NKOTB), in which they asked such hard-hitting questions as: “Who's the best on the block?” and “Now which kid is the sexiest?” NKOTB sued for the unauthorized use of its trademarks, and the newspapers cited a First Amendment defense, saying that the polls were “part and parcel of their ‘news-gathering activities.’”<sup>6</sup> The Ninth Circuit held that:

Indeed, we may generalize a class of cases where the use of the trademark does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one. Such *nominative use* of a mark—where the only word reasonably available to describe a particular thing is pressed into service—lies outside the strictures of trademark law.<sup>7</sup> Because it does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition; **such use is fair** because it does not imply sponsorship or endorsement by the trademark holder.<sup>8</sup>

The court went on to state the following test:

[W]here the defendant uses a trademark to describe the plaintiff's product, rather than its own, we hold that a commercial user is entitled to a nominative fair use defense provided he meets the following three requirements:

- First, the product or service in question must be one not readily identifiable without use of the trademark;

- Second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service;
- And third, the user must do nothing that would suggest sponsorship or endorsement by the trademark holder.<sup>9</sup>

Lest one thinks that the matter was clearly resolved at that point, the Second Circuit threw its hat in the ring in *International Information Systems Security Certification Consortium v. Security University, LLC*,<sup>10</sup> when it held that “nominative fair use is not an affirmative defense to a claim of infringement under the Lanham Act.” However, that court went on to say that:

[I]n cases involving nominative use, in addition to considering the *Polaroid* factors, the courts are to consider (1) whether the use of the plaintiff’s mark is necessary to describe both the plaintiff’s product or service and the defendant’s product or service, that is, *whether the product or service is not readily identifiable without use of the mark*; (2) *whether the defendant uses only so much of the plaintiff’s mark as is necessary to identify the product or service*; and (3) *whether the defendant did anything that would, in conjunction with the mark, suggest sponsorship or endorsement by the plaintiff holder...*<sup>11</sup>

While apparently still applying the Ninth Circuit’s three-factor nominative fair use test, the Second Circuit explained the reason behind its stated distinction: “[T]he nominative fair use test replaces the multi-factor test that the Ninth Circuit typically employs to determine consumer confusion, i.e., it replaces the Ninth Circuit’s analogue to the *Polaroid* test.”<sup>12</sup> Under the *International Information Systems’* court’s reading of the Lanham Act, only “descriptive fair use” is statutorily barred, and while “nominative fair use” may not be a statutory affirmative defense, “the nominative fair use factors will be helpful to a district court’s analysis.”<sup>13</sup>

While courts may disagree on terminology, the “nominative fair use” argument still seems to hold sway, at least in the Second Circuit. The Southern District recently applied the *International Information Systems* factors in *Nespresso USA, Inc. v. Africa America Coffee Trading Co.*<sup>14</sup>

### Parodic Fair Use—Choose Your Battles (and Your Bag)

It may be a strange thing to think of a trademark as being the subject of a parody, but a number of trademark owners have learned otherwise, apparently to their extreme annoyance.<sup>15</sup> Louis Vuitton has been the subject of several parodies, and continues to steadfastly litigate against such comic efforts.<sup>16</sup> In one of Louis Vuitton’s

most recent cases, the Second Circuit found that defendant My Other Bag had successfully parodied the famous bag designer’s famous trademarks.<sup>17</sup>



As the image shows, My Other Bag featured a drawing of a Louis Vuitton bag on one side of a tote bag (albeit with the usual intertwined “LV” logo replaced with “MOB”), and the statement “My Other Bag” on the other side.



The Second Circuit stated:

At the same time that they mimic LV's designs and handbags in a way that is recognizable, they do so as a drawing on a product that is such a conscious departure from LV's image of luxury—in combination with the slogan "My other bag"—as to convey that MOB's tote bags are not LV handbags. The fact that the joke is on LV's luxury image is gentle, and possibly even complimentary to LV, does not preclude it from being a parody.<sup>18</sup>

In *My Other Bag*, Louis Vuitton asserted a claim of copyright infringement as well. This claim was also defeated by a claim of fair—i.e. the increasingly popular "transformative"—use. "MOB's parodic use of LV's designs produces a "new expression [and] message] that constitutes transformative use."<sup>19</sup>

### Some Questions for Clients

It seems clear that there is a fair use defense to claims of trademark infringement. However, it is wise to go through an assessment process when using another party's trademark, just as when using another party's copyrighted material:

- (1) Why do you need to use it? In the trademark area, the answer may be as simple as "because I need to accurately describe his, her, its, or my product."
- (2) How much do you need to use of it? ("As little as possible" is usually the recommended approach in crafting a fair use defense.)

When dealing with trademarks:

- (3) Are you creating a false impression of sponsorship or endorsement?

While getting the "right" answers to these questions does not guarantee a favorable result in the event of litigation, it might make it more likely. Furthermore, if the answers lead a client down the non-fair use path, an attorney is in a better position to advise the client accordingly.

### Endnotes

1. Section 107 of the Copyright Act (17 U.S.C. §§ 101, *et seq.*) sets out the statutory test for fair use in the copyright context.
2. 15 U.S.C. § 1115(b)(4).
3. 543 U.S. § 111 (2004).
4. 543 U.S. §§ 121-22. The Second Circuit used a similar rationale in *Cosmetically Sealed Industries, Inc. v. Chesebrough Ponds USA Co.*, 125 F.3d 28, 30 (2d Cir. 1997) ("If any confusion results, that is a risk the plaintiff accepted when it decided to identify its product with a

mark that uses a well known descriptive phrase.") and *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 269 (2d Cir. 1995) ("This principle is of great importance because it protects the right of society at large to use words or images in their primary descriptive sense, as against the claims of a trademark owner to exclusivity.").

5. 971 F.2d 302 (9th Cir. 1992). NKOTB was a popular boy band of the late 1980s and early 1990s. If you do not trust me, trust the Second Circuit's opinion, which referred to it as "reputedly one of today's hottest musical acts." *Id.* at 304.
6. *Id.* at 305.
7. (Emphasis in original) This may be a tacit recognition that, as set out in the U. S. Constitution, the intellectual property monopoly is intended to be a limited one: "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective writings and discoveries." U.S. CONST., ART. I. § 8 (emphasis added).
8. *New Kids on the Block*, 971 F.2d at 307-08 (emphasis added).
9. *Id.*
10. 823 F.3d 153, 156 (2d Cir. 2016).
11. *Id.* (emphasis added).
12. *Id.* at 166. In *Polaroid Corp. v. Polaroid Electronics Corp.*, 287 F.2d 492 (2d Cir. 1961), the Second Circuit set out its eight-factor balancing test for finding if there was a likelihood of consumer confusion: "the strength of [the] mark, the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers." *Id.* at 495.
13. *International Information Systems Security Certification Consortium*, 823 F.3d at 168.
14. 2016 WL 3162118 at \*12 (S.D.N.Y. 2016). ("In such a scenario, the Court must consider the nominative fair use factors enumerated by the Second Circuit.").
15. *E.g. Starbucks Corp v. Wolfe's Borough Coffee, Inc.*, 736 F.3d 198 (2d Cir. 2013), *CCA and B, LLC v. F + W Media, Inc.* 819 F. Supp. 2d 1310 (N.D. Ga. 2011) ("Elf on the Shelf" trademark), *Smith v. Wal-Mart Stores*, 475 F. Supp. 2d 446 (S.D.N.Y. 2008).
16. *Louis Vuitton Malletier, S.A. v. Hyundai Motor America*, 2012 WL 1022247 (S.D.N.Y. 2012); *Louis Vuitton Malletier, S.A. v. Warner Brothers Entertainment*, 868 F. Supp. 2d 172 (S.D.N.Y. 2012); *Louis Vuitton Malletier v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).
17. *Louis Vuitton Malletier, S.A. v. My Other Bag, Inc.*, 674 Fed. Appx. 16 (2d Cir. 2016).
18. *Id.* at 18.
19. *Id.* at 19.

**Cheryl L. Davis is a partner at the firm of Menaker & Herrmann LLP, where her practice focuses on intellectual property (particularly copyright and trademark cases), as well as employment matters. She has counseled clients in a variety of industries on how to protect their intellectual property and has also represented theater clients in connection with a variety of contract and corporate issues. In her copious spare time, she is also an award-winning playwright and TV writer.**



NEW YORK STATE BAR ASSOCIATION

# Online Publications

In Partnership with Fastcase



## Already a NYSBA member with free access to Fastcase legal research?



Upgrade now to also access NYSBA Online Publications Library on the Fastcase database. Visit [www.nysba.org/fastcase](http://www.nysba.org/fastcase)

With a subscription to the NYSBA Online Publications Library, you can browse or search NYSBA legal publications, such as the complete award-winning *Practical Skills Series*, and quickly link to the cases and statutes cited through Fastcase. In addition to traditional legal research, attorneys will enjoy online access to over 60 practice-oriented professional publications covering many different areas of practice. The NYSBA Online Publications Library is not available on any other online platform.

Get the complete NYSBA Online Publications Library and enjoy exclusive members-only savings that will more than cover your membership dues. And, your annual subscription includes all updates during the subscription period to existing titles as well as new titles – at no extra cost! Subscriptions to individual titles are also available.

A member subscription is a fraction of the cost of the complete hardbound library. For more information visit [www.nysba.org/fastcase](http://www.nysba.org/fastcase).

## Not yet a NYSBA member?



Join now at [www.nysba.org/whynysba](http://www.nysba.org/whynysba)

# By Inviting Canadian and Mexican Schools, the NCAA May Be Forfeiting on Amateurism

By Jason Chung

In April 2017, the National Collegiate Athletic Association (NCAA) permanently adopted and expanded a pilot program that allowed Simon Fraser University of British Columbia to participate in Division 2 (D2) athletics and permitted each of its divisions to invite Canadian or Mexican institutions.<sup>1</sup> However, visions of Canadian or Mexican teams in a major Division 1 (D1) bowl game or basketball tournament are likely premature, as big money U.S. college tournaments promise local legal challenges relating to the NCAA's particular brand of "amateurism," especially as they relate to revenue-generating or "head count" sports.

From a Canadian context, the introduction of big-money D1 tournaments into college athletics would likely bring higher levels of scrutiny from courts, particularly with regard to the question of whether student-athletes are employees. Currently, Canada's equivalent of the NCAA, U Sports, offers stipends to athletes much like their American counterparts. Athletic scholarships, referred to as Athletic Financial Awards (AFA), are awarded and distributed subject to meeting academic requirements, and the values are capped to tuition and compulsory fees.<sup>2</sup> This is actually less generous than the NCAA, which can also cover books, room and board.<sup>3</sup>

However, amateurism in U Sports is likely tolerated by Canadian courts due to the relatively small-time nature of Canadian collegiate athletics. There is a general acknowledgement by all parties in Canada that U Sports does not enjoy sufficient revenues to merit greater payments to student-athletes. As noted by University of Saskatchewan football player John Trumpy in 2015, "Receiving payments in addition to an athletic scholarship has never really crossed my mind. I don't feel that [U Sports] generates enough revenue..."<sup>4</sup>

This attitude will likely change if the Canada enters the NCAA, particularly with regard to the most lucrative head count sports, like men's basketball, football and hockey. Amateurism rules restricting payments to student-athletes have already been under siege in the NCAA with cases such as *O'Bannon v. NCAA*, and it is likely that Canadian courts, and student-athletes, would wade in with greater stakes at play. A key question would likely be whether head count sports, and the revenues they bring, trigger an employer-employee relationship between universities and student-athletes. The NCAA may not like the answer to that question, particularly as it relates to student-athlete amateurism.

## Student-Athlete Amateurism in the United States

The NCAA considers amateur competition to be "a bedrock principle of college athletics and the NCAA." On the surface, this appears to be logical. The idea that student-athletes should be able to pursue their academic and athletic careers shielded from crass commercialism is understandable, if paternalistic.

More importantly, the NCAA's conception of amateurism has been robustly supported by American courts. In *Agnew v. NCAA*, the holding cited *NCAA v. Board of Regents*, in which NCAA bylaws related to maintaining the "revered tradition of amateurism in college sports" or the "preservation of the student-athlete in higher education" were assumed to be procompetitive because the NCAA must be given "ample latitude to play that role."<sup>5</sup> The NCAA's "strong educational mission" likely gives it legitimacy when arguing before the courts that amateurism is central to the student-athlete experience. This helps the organization survive legal challenges to its amateurism defense.<sup>6</sup> As such, *Agnew* reaffirmed that *Board of Regents* remains good law, and that courts should show deference to amateurism as it remains integral to the college sports. This deference to amateurism is so ingrained into American courts' consciousness that deference to the NCAA and its interpretation of amateurism has persisted even through major, material changes to how scholarships are awarded and questions of fairness have perpetuated.

## The Situation of Student-Athletes in the NCAA

In the 1970s, the NCAA adopted a series of policies affecting athletic scholarships that negatively impacted student-athletes. Some of these unilateral policy changes increasingly attracted attention for their allegedly anti-competitive nature and as possible violations of Section I of the Sherman Act.<sup>7</sup> Though the merits of these antitrust claims are beyond the scope of this article, these allegations speak to the growing frustration with NCAA policies that exploit the legal concept of amateurism to deny student-athletes a fair share of the real financial profits they bring to their schools.

Three policies in particular are detrimental to student-athletes: (1) the limitation on the number of scholarships, (2) the (recently reversed) elimination of the four-year scholarship and (3) the elimination of the stipend.

*continued on page 47*

NEW YORK STATE BAR ASSOCIATION



**We Are Your  
Professional Home.**

Renew today for 2018 | [www.nysba.org/renew](http://www.nysba.org/renew)



# EASL's 2017 Music Business



# Business and Law Conference



I am a Section member — please consider me for appointment to committees marked.

Name \_\_\_\_\_

Address \_\_\_\_\_

City \_\_\_\_\_ State \_\_\_\_\_ Zip \_\_\_\_\_

The above address is my  Home  Office  Both

Please supply us with an additional address.

Name \_\_\_\_\_

Address \_\_\_\_\_

City \_\_\_\_\_ State \_\_\_\_\_ Zip \_\_\_\_\_

Office phone (\_\_\_\_\_) \_\_\_\_\_

Home phone (\_\_\_\_\_) \_\_\_\_\_

Fax number (\_\_\_\_\_) \_\_\_\_\_

E-mail address \_\_\_\_\_

Date of birth \_\_\_\_\_ / \_\_\_\_\_ / \_\_\_\_\_

Law school \_\_\_\_\_

Graduation date \_\_\_\_\_

States and dates of admission to Bar: \_\_\_\_\_

*Please return this application to:*

**MEMBER RESOURCE CENTER,**

New York State Bar Association, One Elk Street, Albany NY 12207

Phone 800.582.2452/518.463.3200 • FAX 518.463.5993

E-mail [mrc@nysba.org](mailto:mrc@nysba.org) • [www.nysba.org](http://www.nysba.org)

## JOIN A COMMITTEE

### Knowledge Enhancement via Committee Involvement

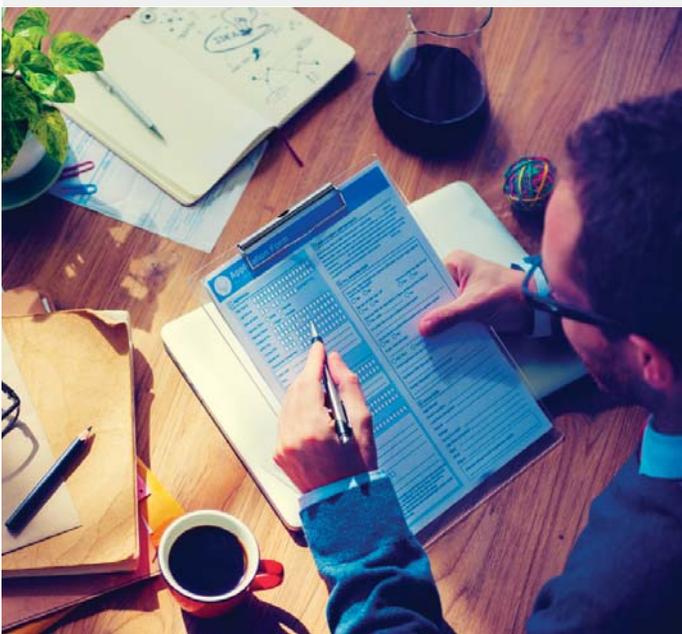
The **EASL Section's** committees address unique issues facing attorneys, the profession and the public. Committees allow you to network with other attorneys who practice in the entertainment, arts, and sports areas of the law. Committee membership gives you the opportunity to research issues and influence the laws that can affect your practice. Committees are also an outstanding way for you to achieve professional recognition and development.

The Section offers opportunities to serve on many committees.

### Entertainment, Arts & Sports Law Section Committees

Please designate the committees in which you are interested. You are assured of at least one committee appointment, however, all appointments are made as space permits.

- Alternative Dispute Resolution (EASL3100)
- Copyright and Trademark (EASL1300)
- Digital Media (EASL3300)
- Diversity (EASL3800)
- Ethics (EASL3600)
- Fashion Law (EASL3200)
- Fine Arts (EASL1400)
- International (EASL3900)
- Law Student Liaisons (EASL4200)
- Legislation (EASL1030)
- Literary Works and Related Rights (EASL1500)
- Litigation (EASL2500)
- Motion Pictures (EASL1600)
- Music and Recording Industry (EASL1700)
- Not-for-Profit (EASL4100)
- Phil Cowan Memorial Scholarship (EASL3500)
- Pro Bono Steering (EASL3000)
- Publications (EASL2000)
- Publicity, Privacy and the Media (EASL1200)
- Sports (EASL1800)
- Television and Radio (EASL1100)
- Theatre and Performing Arts (EASL2200)
- Website (EASL4000)
- Young Entertainment Lawyers (EASL2300)



## Limits on the Number of Scholarships

Since the 1970s, the NCAA aggressively coordinated the limiting of athletic scholarships.<sup>8</sup> This was done because “the NCAA was concerned that major football programs were hoarding players by giving them financial aid.”<sup>9</sup> In order to promote equity in the game, the NCAA first imposed a universal limit of 105 scholarships for football programs in 1973, and this number was reduced further to 95 (of which only 25 new scholarships could be offered per year) in 1975. In 1990, that number was reduced even further to 85.<sup>10</sup> Since then, the NCAA has institutionalized limits on scholarships across different sports among member schools in order to prevent an arms race to remain competitive.<sup>11</sup> The end result is that the number of scholarships in revenue sports, namely football and men’s basketball, declined, even as the revenue generated from them has increased exponentially.

The NCAA counters that scholarship limits are required to better reallocate money between men’s and women’s sports in compliance with the former Department of Health, Education and Welfare’s (HEW) interpretation of Title IX of the 1972 Education Amendments—legislation that addressed “equal access in all school activities, including sports.”<sup>12</sup> This interpretation is supported by HEW’s successor agency, the Department of Education (DOE).<sup>13</sup> However, there are problems with this argument from both intent and policy perspectives.<sup>14</sup>

From an intent perspective, scholarship limits were not imposed on student-athletes by the NCAA because of Title IX. Instead, as mentioned above, limitations on athletic scholarships predate Title IX and were only institutionalized in order to limit the input costs of attracting talented players in football, a highly profitable sport.<sup>15</sup> In fact, all NCAA scholarship rules are geared primarily towards generating money. As admitted by NCAA spokesman Cameron Schuh:

For men’s sports in Division I, the NCAA membership determined in 1974 to separate football and basketball financial aid from other sports. This move was predicated on the ability of those sports at that time to generate revenue for the institutions as compared to the other sports the institutions fielded.<sup>16</sup>

As such, the blanket limitation on athletic scholarships is meant to benefit collegiate programs’ bottom lines and not student-athletes. Therefore, it is merely a coincidence that NCAA scholarship limits came into effect around the same time as Title IX.<sup>17</sup>

From a policy perspective, it is the NCAA’s clumsy implementation of scholarship limits per sport and not Title IX, that hurts student-athletes in non-revenue

producing sports.<sup>18</sup> Due to NCAA scholarship limits per sport, member schools are unable to determine for themselves how to allocate resources across different sports programs. For instance, in men’s non-revenue sports, the NCAA chooses to use scholarship limits to “protect and promote revenue sports” by allowing “individual schools to fund specific men’s sports only to the degree that those sports make money nationally.”<sup>19</sup> This has a knock-on effect on women’s scholarship limits, because scholarships in equivalent sports are made approximately equal between men and women’s sports. Briefly speaking, this means that a lion’s share of athletics scholarships is allocated to football and men’s basketball, which limits the amount of scholarships made available to sports such as [men’s] baseball. “And because the NCAA arbitrarily assigned scholarship limits for each sport, in an attempt to make the numbers for women approximately equal to those for men, [schools] can’t offer extra scholarships to [female] softball players, either.”<sup>20</sup> Byzantine NCAA scholarship rules do not reflect the fact that Title IX does not dictate how the NCAA must reallocate its scholarships. All Title IX requires is that institutions provide “reasonable opportunities for [athletic scholarships] to members of each sex in proportion to the participation rate of each sex in intercollegiate athletics” or to demonstrate continual improvement in that regard however they see fit.<sup>21</sup>

The NCAA’s limitation on scholarship numbers is not motivated by the student-athlete’s best interest or obligations under Title IX. Rather, for revenue generating sports, they are intended and used to keep input costs down in head-count sports by limiting spending on student-athletes. With regard to equivalency sports, these limitations are so artlessly applied that they also serve to depress scholarship opportunities among schools who may want to allocate more scholarships in these sports. The NCAA’s policies are designed and implemented to benefit the bottom line of member institutions even if it hurts the interests of individual sports and student-athletes.

## The Elimination (and Controversial Reinstatement) of the Four-Year Scholarship

The elimination of the four-year scholarship also occurred in the 1970s and negatively impacted student-athletes until it was reintroduced in 2011. Prior to 1973, collegiate programs, depending on their conference affiliation, were able to offer athletic scholarships from one to four years in duration to prospective student-athletes with a four-year “no-cut” scholarship as the most competitive package. Caps to the total athletic scholarship amounts, both per team and per year, rested not with the NCAA, but with member conferences, which could have extremely liberal rules.<sup>22</sup> However, in 1973, the NCAA eliminated four-year athletic scholarships entirely and only offered them on a one-year, renewable basis.<sup>23</sup> Schools could elect not to renew for any reason.<sup>24</sup> The sole justification

offered for this move was that some athletes had accepted athletic scholarships and then refused to compete.<sup>25</sup>

The elimination of the four-year scholarship was negative for student-athletes because the students became dependent on the goodwill of their coaches in order to obtain renewals of their athletic scholarships. When scholarships were limited to one-year periods, anecdotal evidence suggested that student-athletes were run off by some athletic departments<sup>26</sup> for myriad reasons, such as the simple fact that they did not fit the style of a new coach.<sup>27</sup> In fact, Boise State publicly stated that it was against four-year scholarships because, "There is never a guarantee that the incoming student-athlete will be a good fit for the program and the institution."<sup>28</sup> The implication was that Boise State felt that it was proper to dismiss a student-athlete simply for "fit" issues, rather than any wrongdoing,<sup>29</sup> and there was no mention of the fact that student-athletes on a four-year scholarship could still freely choose to transfer to other institutions of their own volition.

In recent years, the cumulative negative effect of this policy on student-athletes brought allegations and scrutiny upon the NCAA for possible exploitative anti-competitive behavior. In 2010, the Department of Justice's antitrust division wished to discuss "the purpose and effect of those rules"<sup>30</sup> because, as Gary R. Roberts, Dean of the Indiana University School of Law at Indianapolis, noted, these "could be seen as overly restrictive and possibly in violation of antitrust law."<sup>31</sup> Additionally, the non-renewal of athletic scholarships brought legal action against the NCAA in the forms of *Agnew* in 2010<sup>32</sup> and *Rock v. NCAA* in 2012.<sup>33</sup> Though these cases were ultimately dismissed on antitrust grounds due to errors in identifying the relevant product market,<sup>34</sup> the increase in legal action may have concerned the NCAA.

In the wake of these incidents, colleges once again had the option to offer up to a four-year athletic scholarship. However, though this measure passed in October 2011 after intense lobbying by NCAA President Mark Emmert,<sup>35</sup> the policy was extremely controversial and barely survived an override vote in February 2012.<sup>36</sup> In fact, 205 of 330 schools casting ballots were against the four-year scholarship, but they failed to obtain the necessary supermajority to override the legislation by 0.4 percent.<sup>37</sup>

Difficulties passing the four-year scholarship option, which is not even an obligation, show to what extent the traditional notion that student-athletes were enjoying a "full ride" or a "free ride" was erroneous. Student-athletes' stability and funding were threatened for nearly four decades in favor of reducing the competitiveness between schools for elite student-athletes. Even the NCAA recently admitted that the change was needed "to protect athletes from the possible loss of scholarships because of injury, poor performance or coaching changes."<sup>38</sup> Yet, the fact that the four-year scholarship option was banned for so long, and that reintroduction was

delayed and nearly failed, clearly speaks to the NCAA's historical record of promoting the welfare of their institutions, even if it sometimes means harming the interests of student-athletes.

## The Resistance to Stipends to Cover the True Cost of Attendance

Problems with the duration of scholarships are compounded by their failure to cover the true cost of education, with even minor efforts at further remunerating student-athletes being resisted by NCAA member institutions. Even if an athlete is fortunate enough to obtain a full scholarship in a head-count sport, the amount offered to these student-athletes is inadequate to cover the true cost of a college education, and does not equate to a "free ride." This is due to the fact that while full scholarship athletes are entitled to receive full subsidization of their tuition and course-related fees, room, board and required course-related books,<sup>39</sup> athletic scholarships do not cover ancillary costs, such as parking fees, equipment necessary for classes (such as calculators and computer equipment), or entertainment.<sup>40</sup> Therefore, while the NCAA estimates full scholarships to be worth, on average, \$15,000 at an in-state public school, \$25,000 for an out-of-state public school and \$35,000 for a private school,<sup>41</sup> there is growing evidence that such amounts are grossly inadequate in covering the true cost of a college education.

The actual full cost of attendance has been shown by studies to be \$3,000 higher per player than the scholarship allotment.<sup>42</sup> This gap can have a significant impact on student-athletes from lower-income families and provide them with desperate circumstances. As noted by Ohio State University associate athletic director Doug Archie: "For those who have families who aren't able to help them fill that gap, it's a huge issue. They're down to the bone in terms of their budgets and money."<sup>43</sup> Though income sources such as Pell Grants may help alleviate the gap, many student-athletes are simply unaware that their scholarships will be inadequate. As noted by Ramogi Huma, former UCLA linebacker and executive director of the National College Players Association: "I, like virtually every player in the nation, didn't realize there was a shortfall."<sup>44</sup> Ultimately, Huma graduated owing \$6,000 in credit card debt in 1998.<sup>45</sup>

In 2006, the College Athletes Coalition, led by Huma, organized a group of 20,000 current and former NCAA D 1-A football and basketball players from major conferences and filed a class-action lawsuit against the NCAA seeking to increase the benefits of the athletic scholarship to cover the true cost of attendance.<sup>46</sup> This case, *White v. NCAA*, was ultimately settled in 2008, with \$218 million being made available by the NCAA to its member institutions, with the money to be used for the "benefit of student-athletes" for the academic years of 2007 to 2008 through 2012 to 2013. Additionally, \$10 million was made available for distribution on a claim-made basis to

qualifying former student-athletes.<sup>47</sup> However, because this case was settled, there was no precedent set for future student-athletes because there was no “presumption, concession, or admission” by the NCAA of any “violation of law, breach of duty, liability, default or wrongdoing as to any facts or claims alleged or asserted in the action.”<sup>48</sup> As such, the gap between athletic scholarships and the true cost of education persists today.

This gap continues to hurt student-athletes and engender bitterness. Many student-athletes from lower-income backgrounds resent having to go into debt and being unable to work part-time jobs to supplement their situations while they generate revenue for their schools. For instance, former University of Michigan “Fab Five” member Jalen Rose notes: “Despite the fact very few student athletes ever have the opportunity to turn professional, the overwhelming time commitment of practice, film sessions and team obligations make it impossible to maintain a part-time job.”<sup>49</sup>

Additionally, cash flow problems plague collegiate student-athletes due to the disbursement schedule of these inadequate scholarships. For instance, while college football players begin practicing on campus in late July/August, they receive no scholarship money during that time because they are not enrolled in summer classes as students—their rigorous practice schedule does not allow it.<sup>50</sup>

To the NCAA leadership’s credit, it has acknowledged the above problems. Previous NCAA President Myles Brand and current President Mark Emmert publicly supported a proposal to use men’s basketball tournament funds in order to give athletes additional funds.<sup>51</sup> In 2011, as part of a broader set of reforms, the NCAA Board of Directors reintroduced a stipend that was phased out in 1972. This stipend was to be worth \$2,000 for a full scholarship (and adjusted downwards proportionally if the student-athlete was on a partial scholarship),<sup>52</sup> and was an admission that so-called full athletic scholarships did not cover the cost of a college education.<sup>53</sup> However, individual universities overturned the NCAA Board of Directors’ decision.<sup>54</sup> Though the proposal only allowed, but did not require, universities to give the additional stipend, universities claimed fears of eroding amateurism and Title IX compliance issues.<sup>55</sup>

Thus, even elite athletes in head-count sports, the most likely student-athletes to obtain a full scholarship, must find additional sources to cover the additional cost of education not covered by athletic scholarship money. Additionally, though recent reforms have been attempted by the NCAA, these reforms do not cover the full gap and have been overturned due to institutional fears on the parts of individual universities. Given that such a stipend system would be implemented on an opt-in basis, it remains to be seen if it will be widely implemented even if it is eventually approved.

## How Might Canadian Courts React to U.S. Amateurism Rules?

Given the above, Canadian courts may decide that the heavy-handed and institution-friendly amateurism regime underpinning the NCAA may not be compatible with Canadian laws and values. This is especially a possibility, given the fact that the amateur status of a traditional bastion of Canadian amateur sports—namely, major junior hockey—is already under litigation.

Major junior hockey in the form of the Canadian Hockey League (CHL) currently underpins hockey development for players aged 16 to 20 in Canada. Players are drafted by teams owned by corporations in provincial leagues and play for them for an allowance of approximately \$50/week, training, equipment, registration fees, travel expenses, educational programs, medical insurance, housing at a host family, and food allowances.<sup>56</sup> This system has traditionally been hugely popular in Canada, as it provides smaller communities with local hockey teams and players with a proven pathway to the NHL. However, in recent years, former players complained of exploitation by a system that does not pay minimum wage and offers substandard supervision off the ice.<sup>57</sup>

On April 27, 2017, in *Berg v. Canadian Hockey League*, Justice Perell of the Superior Court of Ontario certified class action proceedings that allow claims for breach of employment law statutes and unjust enrichment to proceed.<sup>58</sup> This means that the “amateur” argument of whether major hockey constitutes a commercial enterprise with employees will finally be litigated—with a real possibility that the CHL will lose.

Of course, a key distinguishing factor between major junior and college sports is that CHL players provide services to for-profit businesses whereas NCAA student-athletes represent their schools. However, in *Berg*, Justice Perell’s *obiter dicta* notes the issues posed by the interplay of Ontario’s Employee Standards Act, which has a highly inclusive definition of employee, and Ontario Regulation 285/01, which appears to be an exhaustive list of occupations exempt from the Act, but one which does not list student-athletes.<sup>59</sup> Justice Perell questions whether amateur athletes have a unique classification and whether “members of a university football or basketball team or track team that sells tickets to its games or events, or that sells broadcast rights, [are] employees of the university.”<sup>60</sup>

Justice Perell’s comments shine a light on the unsettled nature of this question in Canada and why, in light of the Ninth Circuit Court of Appeals recognizing in *O’Bannon v. NCAA* that limiting student-athlete compensation to grant-in-aid violates antitrust laws,<sup>61</sup> Canadian courts may be more expansive in their view of student-athlete rights to include the right to wages as employees. While the Ninth Circuit was forced to interpret *O’Bannon* in light of previous American judgements, which, as summarized by the Seventh Circuit *Agnew v. NCAA* in 2012,

notes the “revered tradition of amateurism in college sports” necessitating the “preservation of the student-athlete in higher education,”<sup>62</sup> Canadian courts share much less reverence for collegiate amateurism.

Therefore, Canadian courts may choose to disregard the Ninth Circuit’s concerns in *O’Bannon* that “offering [student-athletes] cash sums untethered to educational expenses”<sup>63</sup> would violate amateurism, as Canadian courts are not bound by U.S. precedent. Given the revenues of NCAA athletics programs and the relationship between student-athletes and their athletics programs, Canadian courts may very well afford NCAA student-athletes rights as workers to bargain, organize and negotiate as any other group of employees.

With expansion into foreign countries, the NCAA may be looking to emulate professional leagues in gaining new members and fresh broadcast markets. That makes commercial sense. Yet in gaining one commercial advantage, it may be opening itself up to a world of litigation regarding amateurism in courts that do not recognize the NCAA’s history or its privileged position in the sporting and cultural landscape of America.

## Endnotes

1. Marc Tracy, *Looking to Cross the Border From Mexico, Into the N.C.A.A.*, N.Y. TIMES, (May 1, 2017), available at <https://www.nytimes.com/2017/05/01/sports/mexico-cetys-ncaa-border.html>.
2. Ontario University Athletics Student Financial Awards, Ontario University Athletics (May 2, 2017), available at [http://www.oua.ca/student\\_athletes/student\\_financial\\_awards](http://www.oua.ca/student_athletes/student_financial_awards).
3. NCAA Cost of attendance Q&A, NCAA.com (Sept. 3, 2015) available at <http://www.ncaa.com/news/ncaa/article/2015-09-03/cost-attendance-qa>.
4. Zach Tennent, *Earn pay, no way: Student athletes and how they’re rewarded*, The Sheaf, (Sept. 15, 2015), available at <http://thesheaf.com/2015/09/18/earn-pay-no-way-student-athletes-and-how-theyre-rewarded>.
5. *Agnew v. National Collegiate Athletic Association*, 683 F.3d 328, 335 (7th Cir. 2012).
6. *Supra* note 170 at 573.
7. Neil Gibson, *NCAA Scholarship Restrictions as Anticompetitive Measures the One-Year Rule and Scholarship Caps as Avenues for Antitrust Society*, 3 WM. & MARY BUS. L. REV. 203, 205 (2012).
8. *Id.* at 220.
9. Peter Keating, *The silent enemy of men’s sports*, ESPNW, (May 23, 2012), <http://espn.go.com/espnw/title-ix/7959799/the-silent-enemy-men-sports>.
10. *Supra* note 35.
11. *Supra* note 7 at Article 15.5.3.1. This article places limits on the number of scholarships available by sport.
12. Amy Farmer & Paul Pecorino, *Title IX and the Allocation of Resources to Women’s and Men’s Sports*, AM. LAW ECON. REV. 141, 143 (Spring 2012).
13. *Biediger v. Quinnipiac University*, 691 F.3d 85, 92-93 (2d Cir. 2012).
14. Further discussion on Title IX takes place later in this article when discussing reformer arguments for pay-for-play.
15. *Supra* note 74 at 219.
16. *Supra* note 76.
17. *Id.*
18. *Id.*
19. *Id.*
20. *Id.*
21. U.S. Department of Education, *Requirements Under Title IX of the Education Amendments of 1972*, U.S. Department of Education Office for Civil Rights, (Mar. 14, 2005), available at <http://www2.ed.gov/about/offices/list/ocr/docs/interath.html>.
22. *Supra* note 7 at 220.
23. *Id.*
24. Andy Staples, *Schools, not NCAA, standing in the way of positive scholarship change*, SI.com, (Dec. 20, 2011), available at [http://sportsillustrated.cnn.com/2011/writers/andy\\_staples/12/20/ncaa-student-athletes/index.html](http://sportsillustrated.cnn.com/2011/writers/andy_staples/12/20/ncaa-student-athletes/index.html).
25. Murray Sperber, *College Sports, Inc.: The Athletic Department vs. the University* 207 (1990).
26. Kirk Bohls, *NCAA scholarship shift could alter recruiting practices*, statesman.com, (Mar. 29, 2012), available at <http://www.statesman.com/news/sports/college/ncaa-scholarship-shift-could-alter-recruiting-pr-1/nRmYP/>.
27. Doug Lesmerises, *Big Ten offering recruits security of four-year guaranteed scholarship*, The Plain Dealer (Jan. 31, 2012), available at [http://www.cleveland.com/osu/index.ssf/2012/01/big\\_ten\\_offering\\_recruits\\_secu.html](http://www.cleveland.com/osu/index.ssf/2012/01/big_ten_offering_recruits_secu.html).
28. Dennis Dodd, *Emmert contacts DI CEOs on scholarship issue*, CBSSports.com (Feb. 6, 2012), available at <http://dennis-dodd.blogs.cbssports.com/mcc/blogs/entry/6270202/34723947>.
29. *Id.* In the current four-year option scheme, multi-year scholarships that are given can only be revoked for cause—namely academic or off-field issues.
30. Libby Sander, *Justice Department Examines NCAA Scholarship Rules*, The Chronicle of Higher Education, (May 6, 2010), available at <http://chronicle.com/article/Justice-Department-Examines/65430/>.
31. *Id.*
32. Katie Thomas, *N.C.A.A. Sued Over One-Year Scholarships*, N.Y. TIMES, (Oct. 25, 2010), available at [http://www.nytimes.com/2010/10/26/sports/ncaafotball/26ncaa.html?\\_r=4&](http://www.nytimes.com/2010/10/26/sports/ncaafotball/26ncaa.html?_r=4&).
33. Associated Press, *Recent Court Cases Filed vs. NCAA*, Associated Press (Jan. 15, 2013), available at <http://bigstory.ap.org/article/recent-court-cases-filed-vs-ncaa>.
34. Robert G. Kidwell & Tyrone P. Thomas, *NCAA Obtains a Vital Win on Antitrust Challenge of Athletic Aid Rules*, Mintz Levin (Mar. 26, 2013), available at <http://www.mintz.com/newsletter/2013/Advisories/2849-0313-NAT-ARF/index.html>.
35. *Supra* note 26.
36. Josh Levin, *The Most Evil Thing About College Sports*, Slate, (May 17, 2012), available at [http://www.slate.com/articles/sports/sports\\_nut/2012/05/ncaa\\_scholarship\\_rules\\_it\\_s\\_morally\\_indefensible\\_that\\_athletic\\_scholarships\\_can\\_be\\_yanked\\_after\\_one\\_year\\_for\\_any\\_reason\\_.html](http://www.slate.com/articles/sports/sports_nut/2012/05/ncaa_scholarship_rules_it_s_morally_indefensible_that_athletic_scholarships_can_be_yanked_after_one_year_for_any_reason_.html).
37. *Id.*
38. Bob Bensch & Eben Novy-Williams, *NCAA Delays Decision on \$2,000 Stipend for Scholarship Athletes*, Bloomberg (Jan. 14, 2012), available at <http://www.bloomberg.com/news/2012-01-14/ncaa-delays-decision-on-2-000-stipend-for-scholarship-athletics.html>.
39. National Collegiate Athletic Association, *Behind the Blue Disk: Athletics Scholarships*, National Collegiate Athletic Association, (June 21, 2011), available at <http://www.ncaa.org/wps/wcm/connect/public/NCAA/Resources/Behind+the+Blue+Disk/How+Do+Athletic+Scholarships+Work>.

40. Associated Press, *Study: 'Free ride' still costs athletes*, ESPN.com, (Oct. 26, 2010), available at <http://sports.espn.go.com/ncaa/news/story?id=5728653> (Accessed March 21, 2013).
41. *Id.*
42. Brian Bennett, *Big Ten looks at more pay for athletes*, ESPN.com (May 18, 2011), available at [http://espn.go.com/blog/bigten/post/\\_/id/26811/big-ten-looks-at-more-pay-for-athletes](http://espn.go.com/blog/bigten/post/_/id/26811/big-ten-looks-at-more-pay-for-athletes) (accessed March 28, 2013).
43. Bill Rabinowitz, *'Full ride' isn't*, THE COLUMBUS DISPATCH (Jan. 2, 2011), available at <http://www.dispatch.com/content/stories/sports/2011/01/02/fullrideisnt.html>.
44. *Id.*
45. *Id.*
46. Thomas A. Baker III, Joel G. Maxcy & Cyntrice Thomas, *White v. NCAA: A Chink in the Antitrust Armor*, 21 J. LEGAL ASPECTS OF SPORT 75 (Winter 2011).
47. *Id.* at 77.
48. *Id.*
49. Jalen Rose, *Paid College Athletes: A Reasonable Compromise*, Huffington Post (Mar. 16, 2011), available at [http://www.huffingtonpost.com/jalen-rose/paid-college-athletes-a-r\\_b\\_836449.html](http://www.huffingtonpost.com/jalen-rose/paid-college-athletes-a-r_b_836449.html).
50. Dana O'Neil, *The view from the inside*, ESPN.com (July 13, 2011), available at [http://espn.go.com/college-sports/story/\\_/id/6762550/inside-look-full-scholarship-athlete-versus-typical-student](http://espn.go.com/college-sports/story/_/id/6762550/inside-look-full-scholarship-athlete-versus-typical-student).
51. *Supra* note 43.
52. Jon Solomon, *NCAA considers scholarship stipend for athletes based on financial need*, AL.com (May 14, 2012), available at [http://www.al.com/sports/index.ssf/2012/05/ncaa\\_considers\\_more\\_scholarshi.html](http://www.al.com/sports/index.ssf/2012/05/ncaa_considers_more_scholarshi.html).
53. Associated Press, *NCAA panel approves major changes*, ESPN.com (Oct. 27, 2011), available at [http://espn.go.com/college-sports/story/\\_/id/7156548/ncaa-panel-approves-major-scholarship-rules-changes](http://espn.go.com/college-sports/story/_/id/7156548/ncaa-panel-approves-major-scholarship-rules-changes).
54. Associated Press, *NCAA shelves \$2,000 athlete stipend*, ESPN.com, (Dec. 16, 2011), available at [http://espn.go.com/college-sports/story/\\_/id/7357868/ncaa-puts-2000-stipend-athletes-hold](http://espn.go.com/college-sports/story/_/id/7357868/ncaa-puts-2000-stipend-athletes-hold).
55. *Id.*
56. *Berg v. Canadian Hockey League*, 2017 ONSC 2608 (CanLII) ¶¶ 69-70, available at <http://canlii.ca/t/h3f4c>, retrieved on May 2, 2017.
57. Josh Elliott, *Why are junior hockey players getting in trouble off the ice?* CTV News (Mar. 12, 2015), available at <http://www.ctvnews.ca/sports/why-are-junior-hockey-players-getting-into-trouble-off-the-ice-1.2276174>.
58. *Supra* note 6, at 247.
59. *Id.* at 193.
60. *Id.* at 194.
61. *O'Bannon v. National Collegiate Athletic Association*, 802 F.3d 1049 (9th Cir. 2015).
62. *Agnew*, 683 F.3d at 328.
63. *Supra* note 10.

**Jason Chung is the senior researcher and attorney at NYU School of Professional Studies Sports and Society, an interdisciplinary think tank dedicated to the study of social issues through sports.**



## **GIVE THE GIFT OF ACCESS TO LEGAL SERVICES**

The Foundation has provided millions of dollars in grants to hundreds of non-profit organizations across New York State, providing legal services to those desperately in need.

If you care about these issues, help us make a difference.

- Human Trafficking
- Domestic Violence
- Veterans Access to Services
- Immigration
- Homelessness

**[www.tnybf.org/donation](http://www.tnybf.org/donation)  
[www.tnybf.org/giftplans.org/](http://www.tnybf.org/giftplans.org/)**



TNYBF 1 Elk Street, Albany, NY 12207  
[www.tnybf.org](http://www.tnybf.org)

# LAWYER ASSISTANCE PROGRAM



Your **First Choice**

**Call us** when you see the early warning signs... missed deadlines, neglected email, not returning phone calls, drinking too much, feeling sad and hopeless.

or

Your **Last Resort**

**Call us** when you see the consequences of ignoring the early warning signs... work problems, relationship difficulties, an arrest, fired from your job, notice from grievance.

## Call 1.800.255.0569

NEW YORK STATE BAR ASSOCIATION  
LAWYER ASSISTANCE PROGRAM

[www.nysba.org/lap](http://www.nysba.org/lap)  
[nysbalap@hushmail.com](mailto:nysbalap@hushmail.com)



# Tax Trick: Why the New York Rangers Will Be the Away Team for the 2018 Winter Classic at Citi Field

By Daniel S. Greene

## I. Introduction: There's no place like home?

New Year's Day 2018 will mark the tenth rendition of the National Hockey League's (NHL) Winter Classic, a nostalgic hockey spectacle that pits two NHL teams against each other in an outdoor stadium. The game returns to the Empire State for the first time since the inaugural Winter Classic that took place in snowy Orchard Park, where the Buffalo Sabres hosted the Pittsburgh Penguins in front of a crowd of more than 71,000 fans.<sup>1</sup> Citi Field, home of Major League Baseball's (MLB) New York Mets, will welcome hockey fans for an all-New York matchup between the Sabres and the Manhattan-based New York Rangers.

---

---

*"Since New York City is the only city in New York State with a population of one million or more, the law in practice states that an arena located in New York City that is home to both NHL and National Basketball Association (NBA) teams is exempt from property taxation if both teams play all of their home games at the facility."*

---

---

While this will be the Sabres' second outdoor game experience, the 2018 Winter Classic will be the Rangers' fourth in the past seven years.<sup>2</sup> Along with the announcement for the outdoor game, NHL Commissioner Gary Bettman announced that the Sabres, which is based almost 400 miles from Citi Field, which is located in Queens, will be the designated "home team," despite the Rangers being the logical geographic choice.<sup>3</sup> This was a surprising revelation until it was reported that the Rangers were also the "away team" for the 2014 Stadium Series games at Yankee Stadium against the New York Islanders and New Jersey Devils.<sup>4</sup> Perhaps some thought that the NHL was just being nice to the less popular Islanders and Devils, but in fact the NHL was doing itself and the owners of the Rangers a favor.

## II. The Tax Trick

The "mystery" behind the Rangers not being the 2018 Winter Classic home team can be traced back to 1982 when Article 4, §429 of the New York Real Property Tax Law was enacted. This statute states:

Real property within a city having a population of one million or more, used

by both a professional major league hockey team which is a member of the National Hockey League and a professional major league basketball team which is a member of the National Basketball Association to play their home games *shall be exempt from taxation* to the extent said taxes are the obligation by lease or otherwise of the owners of franchises for such teams, provided that such owners enter into a written agreement with the chief executive officer of the municipality in which such property is located *to play their home games within such municipality for a period of at least ten consecutive years.* The tax exemption provided herein shall be granted to real property being used, in whole or in part, for the aforesaid purposes on the date such agreement is executed and shall apply to taxes which become due and payable after the aforesaid agreement is executed and shall continue with respect to such property *as long as both of said teams play their home games therein and no longer.* Such exemption shall not apply with respect to any improvement to such property made after the date such agreement is executed which improvement is not used for the provision of facilities or services related to sports, entertainment, expositions, conventions or trade shows. *If one or both of said teams shall cease to play their home games in said property at any time, the tax exemption provided herein shall cease immediately and such property shall immediately be restored to the tax rolls and thereupon become subject to taxation and shall be taxed pro rata for the unexpired portion of the taxable year.*<sup>5</sup>

Since New York City is the only city in New York State with a population of one million or more, the law in practice states that an arena located in New York City that is home to both NHL and National Basketball Association (NBA) teams is exempt from property taxation if both teams play all of their home games at the facility. If either the NHL or NBA team plays even one home game elsewhere, the tax exemption will cease and the arena owners will be subject to taxation and taxed pro rata for that taxable year. Further, the owners must have entered into a

written agreement with the city to play their home games for a period of at least 10 consecutive years. Madison Square Garden (MSG or the Garden), where the Rangers play alongside the NBA's New York Knicks, clearly fits these requirements. In fact, MSG is the only current indisputable fit<sup>6</sup> since the law was specifically created for the arena.

---

---

*"The bill was drafted during a perfect storm for MSG with a disadvantageous economic climate for the city, the newly built Byrne Meadowlands Arena across the river in New Jersey seeking an NHL team, and desperation to keep the Rangers and Knicks in the city."*

---

---

### III. Legislative History: Koch's Botch

Back in the early 1980s, New York City was still regrouping after the fiscal crisis of the mid-1970s and the Rangers and Knicks owners, Gulf and Western Industries, Inc. (who then owned The Madison Square Garden Corporation (MSG Co.)), were threatening to move the Knicks to Long Island and the Rangers to New Jersey due to high taxes and the cost of unionized labor.<sup>7</sup> State lawmakers took this as a serious threat, stating at the time "that unless action is taken, including real property tax relief and the provision of economical power and energy, the loss of the teams is likely."<sup>8</sup> Thus, the tax break was an incentive for the local teams to stay put and bring economic growth to the city.<sup>9</sup> It was reported that the law was intended to give the MSG owners a \$5 million annual tax break per for 10 years.<sup>10</sup> The agreement seemed like a good deal for both parties, as the city's monetary loss on the tax abatement would cost much less than having the Garden abandoned with the city responsible for operating it.<sup>11</sup>

However, the lawyers creating this section of the New York Real Property Tax Law drafted the legislation without a "sunset provision."<sup>12</sup> Without a "sunset date" inserted to provide an end date for the tax exemption, the abatement is read as lasting forever.<sup>13</sup> On the one hand, former New York City Mayor Edward I. Koch said that the law was only intended to apply for 10 years.<sup>14</sup> On the other hand, Hadley W. Gold, New York City's First Assistant Corporation Counsel at the time, helped draft the law and later stated that the exemption was not written to last only 10 years.<sup>15</sup> Either way, the exemption endured for 35 years, and New York State lost approximately \$450 to \$500 million in property taxes over this period. When the Rangers played at Yankee Stadium in 2014 the exemption was worth \$17.3 million, and this year it is valued at approximately \$42 million.<sup>16</sup>

### IV. Dropping the Gloves: Lawmakers Attempt to Repeal the Law

The fact that a multi-billion dollar corporate entity, MSG Co., which owns the Rangers, Knicks, MSG, and Radio City Music Hall, among other things, receives such a large tax exemption has upset many local politicians, leading to efforts in the New York State legislature to repeal the law.<sup>17</sup> Current New York City Mayor Bill de Blasio supports repealing the exemption, stating, "[W]e can't ask the taxpayers to look the other way while a very well-endowed corporation, a profitable corporation, receives a tax cut for a piece of land that is among the most valuable on earth."<sup>18</sup>

However, despite a committee in the state Assembly favorably reporting a bill to revoke the law in 2014,<sup>19</sup> New York State Governor Andrew Cuomo appears to have no interest in doing so.<sup>20</sup> This may be due to Cuomo's ties with Cablevision,<sup>21</sup> whose CEO before its sale in June 2016 was James Dolan, the Executive Chairman of MSG Co. who also oversees the Knicks' and Rangers' daily operations. There is also the argument that elimination of the tax exemption would be unfair, since the new homes of the Mets (Citi Field), Yankees (Yankee Stadium), and Nets (Barclays Center) received large subsidies.<sup>22</sup>

The NHL is also saving itself some money by having the Sabres as the home team. As part of the Winter Classic, the NHL promises to reimburse the "host team" for the lost date at its home arena.<sup>23</sup> While the Rangers and Sabres each draw approximately 18,000 fans per game,<sup>24</sup> the Sabres charge much less for tickets and thus require a significantly reduced reimbursement compared with what the Rangers would command.<sup>25</sup>

### V. Conclusion: Will the Sun Ever Set?

Obviously there are conflicting opinions as to whether the law was intended to last this long. The bill was drafted during a perfect storm for MSG with a disadvantageous economic climate for the city, the newly built Byrne Meadowlands Arena across the river in New Jersey seeking an NHL team, and desperation to keep the Rangers and Knicks in the city. The deadline imposed on the Rangers to inform the Meadowlands if they planned on moving to New Jersey no doubt put pressure on both sides to reach an acceptable agreement quickly.<sup>26</sup> Clearly some of today's key public officials, including the Mayor of New York, wish that a sunset provision had been included in the enacted legislation. If such a provision had been incorporated, the matter would now be moot or, at the very least, the legislature would have had to reauthorize the tax benefit for a specified number of years each time it "sunsetting" and could choose not to reauthorize the law at its discretion.

The tax benefit seemingly accomplished its objectives for both sides as the Rangers and Knicks stayed in New York, and MSG Co. saved millions of dollars. Whether

the teams would have vacated the arena and city by now without the perpetual tax benefit is unknown. However, there is an argument to be made that the law ran its course and should be repealed. As of 2017, the Rangers are the most valuable team in the NHL at \$1.25 billion,<sup>27</sup> and the Knicks are the most valuable team in the NBA at \$3.3 billion,<sup>28</sup> demonstrating that MSG Co. may not need such tax benefits. Further, it is highly doubtful that either team would move out of the refurbished arena and to another city, since the league-leading value of each franchise would likely drop if it was not located in Manhattan.<sup>29</sup> Still, while it is a fair argument that the city could use this extra money for “more important” fiscal purposes, the economic benefit that MSG Co. and its tenants bring to the city’s economy is significant.<sup>30</sup> Policymakers must weigh the value of those benefits and whether the property tax law plays a key role in keeping those benefits accruing to the city, against other potential uses for those funds.

While it does not appear that the tax exemption will be lifted anytime soon, do not expect the fight to end.

## Endnotes

1. See Matt Higgins, *Winter Wonderland for Crosby and N.H.L.*, N.Y. TIMES, Jan. 2, 2008, available at <http://www.nytimes.com/2008/01/02/sports/hockey/02hockey.html?mcubz=1>.
2. The Rangers played the 2012 Winter Classic against the Philadelphia Flyers at Citizens Bank Park, home of MLB’s Philadelphia Phillies, and played the New York Islanders and New Jersey Devils in two separate games during the 2014 Stadium Series at Yankee Stadium, home of the New York Yankees. See Arthur Staple, *2018 NHL Winter Classic likely to be held at Citi Field with Rangers vs. Sabres, sources say*, NEWSDAY, Mar. 15, 2017, available at <http://www.newsday.com/sports/hockey/rangers/2018-nhl-winter-classic-likely-to-be-held-at-citi-field-with-rangers-vs-sabres-sources-say-1.13268887>.
3. The NHL said that the Sabres were named the home team for “a variety of factors.” See Jon Campbell, *Tax break for MSG means Buffalo Sabres will be Winter Classic home team*, DEMOCRAT & CHRONICLE, May 10, 2017, available at <http://www.democratandchronicle.com/story/news/politics/albany/2017/05/10/winter-classic-tax-breaks-madison-square-garden-new-york-rangers-buffalo-sabres/101509324/>.
4. See Jeff Z. Klein, *Rangers on Road in the Bronx? Money May Be Why*, N.Y. TIMES, Jan. 24, 2014, available at <https://www.nytimes.com/2014/01/25/sports/hockey/rangers-on-road-in-the-bronx-money-may-be-why.html>.
5. RPTL § 429 (emphasis added).
6. It is unclear as to whether this law would apply to the Barclays Center, home to the NHL’s New York Islanders and the NBA’s Brooklyn Nets. Specifically, it is unclear as to whether there is an agreement between the arena owners and the city to play in the city for at least 10 years. The Islanders signed a 25-year deal with the Barclays Center, but there is a clause that allows either party to opt out of the agreement by January 1, 2018. Thus, the Islanders’ tenure in Brooklyn could be less than 10 years. See Jim Baumbach and Robert Brodsky, *Barclays Center starts process toward possible opt-out of Islanders, sources say*, NEWSDAY, May 8, 2017, available at <http://www.newsday.com/sports/hockey/islanders/barclays-center-starts-process-toward-possible-opt-out-of-islanders-sources-say-1.13583598>. While the Brooklyn-based arena is one of the top tax exempt properties in the United States, it does not appear that the exemption is due to RPTL § 429. See Roxana Poenar, *NYC Takes 15 Spots in the Top 20 Exempt Properties in the US*, PROPERTY SHARK (Sept. 13, 2017), available at <https://www.propertyshark.com/Real-Estate-Reports/2017/09/13/nyc-tax-exempt-properties-us/>. Further complicating the issue is the fact that Mikhail Prokhorov owns the Nets and Barclays Center, and the Islanders is separately owned by Jon Ledecky and Scott Malkin, while the Rangers, Knicks, and MSG are all owned by The Madison Square Garden Company. See Jim Baumbach, Paul LaRocco and Michael Gormley, *Islanders, Mets owners in talks with MSG-backed group to build at Belmont, sources say*, NEWSDAY, Feb. 24, 2015, available at <http://www.newsday.com/sports/hockey/islanders/islanders-mets-owners-in-talks-with-msg-backed-group-to-build-at-belmont-sources-say-1.13174962>; see also Josh Kosman, *Islanders owners looking to sell 15% stake, can’t find any takers*, N.Y. POST, June 19, 2017, available at <http://nypost.com/2017/06/19/islanders-owners-looking-to-sell-15-stake-cant-find-any-takers/>.
7. Allen G. Schwartz, who represented New York City Mayor Edward I. Koch during the negotiations, stated: “It didn’t matter if the teams played in Madison Square Garden or across the river or in Nassau. When all was said and done, the consensus was, we had to keep them in the Garden.” See Joyce Purnick, *Metro Matters; No Taxes, No Foul at the Garden*, N.Y. TIMES, Nov. 21, 2002, available at <http://www.nytimes.com/2002/11/21/nyregion/metro-matters-no-taxes-no-foul-at-the-garden.html?mcubz=1>; see also Gerald Eskenazi, *2 N.H.L. Owners Say Rangers May Move to New Jersey in ‘82*, N.Y. TIMES, Nov. 7, 1981, available at <http://www.nytimes.com/1981/11/07/sports/2-nhl-owners-say-rangers-may-move-to-new-jersey-in-82.html>. The NHL’s Colorado Rockies eventually moved to the Byrne Meadowlands Arena in New Jersey in 1982 and was renamed the New Jersey Devils. See Gerald Eskenazi, *Sports of the Times; Devils Move in at Meadowlands*, N.Y. TIMES, July 31, 1982, available at <http://www.nytimes.com/1982/07/31/sports/sports-of-the-times-devils-move-in-at-meadowlands.html?mcubz=1>.
8. See New York City Independent Budget Office, *Budget Options for New York City* (March 2017), available at [http://www.ibo.nyc.ny.us/iboreports/budget\\_options\\_march\\_2017.pdf](http://www.ibo.nyc.ny.us/iboreports/budget_options_march_2017.pdf), at p. 57. Further, at the time, MSG officials believed that the Rangers could move and still generate a large income due to the growing importance of cable revenue. See Eskenazi, *2 N.H.L. Owners Say, supra* note 7. This was especially important, since Gulf and Western reportedly lost \$5 million on the two teams in 1981. See George Vecsey, *Sports of the Times; The Mayor and the Ghost*, N.Y. TIMES, Feb. 17, 1982, available at <http://www.nytimes.com/1982/02/17/sports/sports-of-the-times-the-mayor-and-the-ghost.html>.
9. New York City officials wanted Madison Square Garden to remain in the city for two basic reasons: “Fear of the psychological impact in losing two more major-league teams [after baseball’s Giants and Dodgers, and football’s Giants left the state] and concern over the loss of business in hotels, garages, restaurants and other services that the arena generates.” See Maurice Carroll, *Deal Emerging to Keep Garden From Closing*, N.Y. TIMES, Apr. 3, 1982, available at <http://www.nytimes.com/1982/04/03/nyregion/deal-emerging-to-keep-garden-from-closing.html?mcubz=1>.
10. See E.J. Dionne Jr., *Madison Square Garden Given State Tax Breaks*, N.Y. TIMES, July 3, 1982, available at <http://www.nytimes.com/1982/07/03/nyregion/madison-square-garden-given-state-tax-breaks.html?mcubz=1>.
11. See Randall V. Berlage, *Knicks, Rangers to stay at Garden with City tax break*, UNITED PRESS INTERNATIONAL, Apr. 23, 1982, available at <http://www.upi.com/Archives/1982/04/23/Knicks-Rangers-to-stay-at-Garden-with-City-tax-break/3353388386000/>.
12. “Sunset Provision” is defined as a “provision or condition in law that designates a point in time when that law will no longer be in effect.” See BLACK’S LAW DICTIONARY FREE ONLINE LEGAL DICTIONARY (2d ed.), available at <http://thelawdictionary.org/sunset-provision/>.

13. Interestingly enough, George Vecsey, the legendary long-time sports columnist for the *New York Times*, suggested at the time that a hypothetical agreement between Gulf and Western and the city should have a guarantee that the Knicks and Rangers would not leave New York City for about 99 years. See Vecsey, *supra* note 8.
14. Koch, who was mayor from 1978 to 1989, later stated, “[i]t was not only my intent—I went to bed at night believing it was a 10-year abatement.” See Purnick, *supra* note 7. While Koch claims that “something happened on the way to the forum that [he] was unaware of,” he has taken responsibility for the agreement since it occurred during his tenure as mayor. *Id.*
15. Not only did Gold believe that agreement accurately reflected the city’s intent, but Richard H. Zahnd, who was then general counsel to Madison Square Garden, also understood the law to be applied for as long as both teams played in the city. *Id.*
16. The value of the exemption grew due to the recent renovations to the arena. See Campbell, *supra* note 3.
17. See Christian Red, *Madison Square Garden still exempt from property tax*, N.Y. DAILY NEWS, May 11, 2016, available at <http://www.nydailynews.com/sports/basketball/knicks/madison-square-garden-exempt-property-tax-article-1.2634080>; see also Weprin: *End Madison Square Garden \$17M Tax Exemption*, QUEENS GAZETTE, Oct. 2, 2013, [http://www.qgazette.com/news/2013-10-02/Features/Weprin\\_End\\_Madison\\_Square\\_Garden\\_17M\\_Tax\\_Exemption.html](http://www.qgazette.com/news/2013-10-02/Features/Weprin_End_Madison_Square_Garden_17M_Tax_Exemption.html); see also N.Y. S. B. S7362 (N.Y. 2010), available at <https://www.nysenate.gov/legislation/bills/2009/S7362>; see also N.Y. H.R. B. A3081 (N.Y. 2016), available at [http://assembly.state.ny.us/leg/?default\\_fld=&bn=A3081&term=2017&Memo=Y](http://assembly.state.ny.us/leg/?default_fld=&bn=A3081&term=2017&Memo=Y).
18. See Mitch Abramson, *Analysis: Bill passes to revoke lucrative tax breaks for Madison Square Garden Company*, N.Y. DAILY NEWS, May 29, 2014, available at <http://www.nydailynews.com/sports/basketball/analysis-bill-passes-revoke-lucrative-tax-breaks-madison-square-garden-company-article-1.1810750>.
19. *Id.*
20. *Id.*; see also Nathaniel Vinton and Christian Red, *Tax break saves MSG chairman Dolan \$48.5M this fiscal year*, N.Y. DAILY NEWS, available at <http://www.nydailynews.com/sports/basketball/knicks/tax-exemption-saves-msg-chairman-dolan-48-5m-fiscal-yr-article-1.2589753>.
21. As of 2013, Cuomo was the top individual recipient of Cablevision donations, receiving \$359,150 as governor and \$50,100 as attorney general. See Ken Lovett, *Gov. Cuomo Opposes Revoking Madison Square Garden Property Tax Credit*, N.Y. DAILY NEWS, Apr. 16, 2013, available at <http://www.nydailynews.com/blogs/dailypolitics/gov-cuomo-opposes-revoking-madison-square-garden-property-tax-credit-blog-entry-1.1694293>. Further, State Assemblyman David Weprin alleged that MSG “paid more lobbyists than taxes” to bolster its interests in this issue. See Vinton and Red, *supra* note 20.
22. See Vinton and Red, *supra* note 20; see also Jim Dwyer, *32-Year Streak at the Garden: No Taxes Paid*, N.Y. TIMES, May 20, 2014, available at <https://www.nytimes.com/2014/05/21/nyregion/32-year-streak-at-the-garden-no-taxes-paid.html>.
23. See Campbell, *supra* note 3.
24. *Id.*
25. In 2013, the average price for a Rangers ticket was \$232.93, while the average price for a Sabres ticket was \$139.53. See *Most Expensive NHL Teams in 2013*, FORBES, available at <https://www.forbes.com/pictures/fjlg45mhf/14-buffalo-sabres-avg-price-139-53/#4cb719325c69>. In 2014, it was estimated that the NHL saved more than \$1 million by having the Rangers be the away team in both Stadium Series games at Yankee Stadium against the Devils and Islanders. See Klein, *supra* note 4.
26. The Rangers had to commit to playing at the Meadowlands by April 22, 1982. See *City Tax Breaks for Rangers Expected*, N.Y. TIMES, Feb. 25, 1982, available at <http://www.nytimes.com/1982/02/25/sports/city-tax-breaks-for-rangers-expected.html?mcubz=1>.
27. See Bernie Augustine, *Rangers top Forbes’ list of most valuable NHL franchises*, N.Y. DAILY NEWS, Nov. 30, 2016, available at <http://www.nydailynews.com/sports/hockey/rangers/rangers-top-forbes-list-valuable-nhl-franchises-article-1.2892930>.
28. See Kurt Badenhausen, *The Knicks and Lakers Top the NBA’s Most Valuable Teams 2017*, FORBES, Feb. 15, 2017, available at <https://www.forbes.com/sites/kurtbadenhausen/2017/02/15/the-knicks-and-lakers-head-the-nbas-most-valuable-teams-2017/#228c80857966>.
29. While the New York City Council told MSG Co. that it needs to vacate the arena by 2023 so the redevelopment of Pennsylvania Station, which sits underneath the arena, can begin, MSG should be able to find a new home within the city if need be. See Charles V. Bagli, *Madison Square Garden Is Told to Move*, N.Y. TIMES, July 24, 2013, available at <http://www.nytimes.com/2013/07/25/nyregion/madison-square-garden-is-told-to-move.html?mcubz=1>. While the Dolans do not appear to be taking this deadline seriously, some of have suggested that the arena can be moved to the other side of Eighth Avenue and into the James A. Farley Post Office Building. See Michael Kimmelman, *How to Transform Penn Station: Move the Garden*, N.Y. TIMES, Jan. 12, 2016, available at <https://www.nytimes.com/2016/01/13/arts/design/how-to-transform-penn-station-move-the-garden.html?mcubz=1>; see also Michael Kimmelman, *Penn Station Reborn*, N.Y. TIMES, Sept. 30, 2016, available at <https://www.nytimes.com/interactive/2016/09/30/opinion/penn-station-reborn.html?mcubz=1>. Further, New York City is arguably the biggest hub and most profitable location for professional sports in North America, having the most valuable collection of sports franchises of any city in the United States, thus making it foolish for the Rangers and/or Knicks to move away. See Cork Gaines, *New York beats out LA and Chicago with the most valuable collection of pro sports teams*, BUSINESS INSIDER, May 25, 2017, available at <http://www.businessinsider.com/new-york-sports-value-2017-5>.
30. See Marc Beja, *Rangers, Knicks playoff games mean millions for city businesses*, NEWSDAY, Apr. 22, 2012, available at <http://www.newsday.com/news/new-york/rangers-knicks-playoff-games-mean-millions-for-city-businesses-1.3675979?view=print>.

**Daniel S. Greene is a practicing attorney based in Syracuse and provides commentary on ice hockey and its intersection with the law on his legal blog, The Hockey Blawg ([www.thehockeyblawg.com](http://www.thehockeyblawg.com)). He graduated from the Syracuse University College of Law in May 2016, where he served as an Associate Notes Editor for the *Syracuse Law Review* and President of the Entertainment and Sports Law Society. During law school, Daniel had his article titled “From the Ice to the Courtroom: Analyzing the Relationship Between Professional Ice Hockey and Tort Liability,” published in the Spring 2016 issue of *The Sports Lawyers Journal*, and was a finalist at the 2015 Hockey Arbitration Competition of Canada. Before law school, he served as the Coordinator of Hockey Operations for Union College’s Division I men’s ice hockey program.**



# Automated Installment Plan (AIP) Enrollment Form

## Save Time with AIP

Now New York State Bar Association (NYSBA) members can save time with direct dues payment. An alternative to writing checks and mailing your membership dues, with AIP you can authorize NYSBA to withdraw payments electronically from your credit card account. Go to [www.nysba.org/AIP](http://www.nysba.org/AIP) for more information. You can conveniently sign up for AIP on the enrollment form below. It's safe, easy and convenient!

**AUTOMATED INSTALLMENT PLAN (AIP) ENROLLMENT AUTHORIZATION** I hereby authorize NYSBA to instruct my financial institution to deduct directly from my account the amount necessary for my annual membership, per the payment schedule selected below: 1, 2, 3 or 4 payments on or about the 25th of the relative month(s). **All installment payments must be completed by April 30, 2018.** Those opting into the installment payment program in Dec, Jan, Feb or March of the current dues billing year may have their payments consolidated and accelerated to meet this requirement. By selecting the AIP method **I understand this agreement will remain in effect for future membership years, unless I request cancellation in writing to:** NYSBA, Dues Processing, One Elk Street, Albany, NY 12207.

Total to be debited: \$

Signature: \_\_\_\_\_ Date: \_\_\_\_\_

6/17

## Member Information

Name: \_\_\_\_\_ NYSBA Membership ID #: \_\_\_\_\_

Address: \_\_\_\_\_

Address: \_\_\_\_\_

City, State, Zip: \_\_\_\_\_

Phone Number: \_\_\_\_\_ E-mail: \_\_\_\_\_

## Payment Schedule

1 Full Payment     2 Payments     3 Payments     4 Payments

**AIP — Credit/Debit Card Authorization**

Credit Card     AMEX     DISC     MC     VISA

Credit Card Number:

Exp. Date:  /

Authorized Signature: \_\_\_\_\_

**Please return this form to: NYSBA, Member Resource Center, One Elk Street, Albany, NY 12207  
Phone 800.582.2452/518.463.3200 FAX 518.463.5993  
E-mail [mrc@nysba.org](mailto:mrc@nysba.org)**

**IMPORTANT NOTICE:** Membership dues to the New York State Bar Association are not tax deductible as charitable contributions for income tax purposes. However, they may be tax deductible as ordinary and necessary business expenses subject to restrictions imposed as a result of association lobbying activities. The NYSBA estimates that the non-deductible portion of your 2018 dues which is allocated to lobbying is approximately 2.0%. Portions of your dues payment are allocated toward the annual publication subscriptions for the following: *NYSBA Journal*, \$14.75; *New York State Law Digest* \$6.25; *State Bar News* \$7.25.

# Appropriation at Augusta: An Illustration of the Battle Over the Publicity Right and the First Amendment

By Ryan Hersh

## I. Introduction

Each of the core intellectual-property rights—patent, copyright, and trademark—enjoys a well-understood, undisputed justification. Patent supports innovation in the sciences,<sup>1</sup> copyright encourages creation in the arts,<sup>2</sup> and trademark promotes fairness in the open markets.<sup>3</sup> These justifications play a vital role in maintaining a healthy body of intellectual property law, serving as guideposts for lawmakers as they draft relevant legislation, and aiding appellate courts as they develop interpretive doctrine.

It might come as a surprise, then, that the lesser-known but still frequently litigated publicity right, which provides a person with exclusive control over the commercial use of “the person’s name, likeness, or other indicia of identity[.]” enjoys no such justification: More than 60 years after the Second Circuit first recognized it<sup>4</sup>—and 40 years after the Supreme Court affirmed its constitutionality<sup>5</sup>—“no one seems able to explain exactly why individuals should have th[e] right.”<sup>6</sup> Its proponents, nonetheless, continue their attempts to justify it through some of the more commonly asserted justifications for the other intellectual property rights,<sup>7</sup> *e.g.*, labor, moral rights, allocative efficiency, and competition-based theories. None are persuasive.

Perhaps more than ever before, this failure to put forth a compelling justification is problematic. For one thing, state and federal trial courts each year provide the forum for countless publicity rights plaintiffs who seek monetary or equitable relief, while state and federal appellate courts issue numerous opinions defining the scope of those plaintiffs’ rights as a matter of law. In doing so, however, courts “simply assume an unassailable [publicity] right” without “even considering whether the right as they have defined it promotes any legitimate policy goal.”<sup>8</sup> For another, these opinions vary widely in their definition of the right—both between court levels and across geographic jurisdictions. Such wide variation only leads to unpersuasive opinions, and ultimately, perpetuates uncertainty among publicity rights plaintiffs and defendants.

This reality is most notable in publicity rights cases that implicate the First Amendment, which shares a longstanding, complex, and tense relationship with the publicity right. On the one hand, the First Amendment guarantees to a person the rights of free expression and free speech; on the other hand, the publicity right guarantees to a person the right to control his or her “name, likeness, or other indicia of identity.”<sup>9</sup> Of course, extensive case law outlining the scope of each right teaches that neither is absolute.

However, just where one right gives way to the other is a bit of a mystery—at least among appellate courts. Attempting, nonetheless, to find the answer, appellate courts over time developed various multifactor tests, each seeking to balance the countervailing rights. At the federal level, for example, the Tenth Circuit engages in a sort-of “ad-hoc” balancing of the competing rights.<sup>10</sup> The Ninth Circuit, perhaps more practically focused, considers the “transformative nature” of an allegedly infringing work.<sup>11</sup> State appellate courts apply still more balancing tests.<sup>12</sup>

To remedy this situation, commentators regularly urge the Supreme Court to grant certiorari on the issue, endorse one test over the others, and create uniformity across the country. The fact remains, however, that the Supreme Court has only once granted certiorari on the issue, and its opinion was not helpful. In the 40 years since, the celebrity of professional athletes has expanded, increasing the number of publicity rights cases filed annually as well as the number of disputes between the publicity right and the First Amendment.<sup>13</sup> These disputes rage on without appellate guidance.

The Sixth Circuit’s opinion in the high profile case involving well-known artist Rick Rush’s painting of Tiger Woods’ record-breaking, 1997 Masters victory at Augusta National not only illustrates a typical publicity rights case in this area of the law, but also highlights the problems with the existing approaches to the issue.<sup>14</sup> In the case, Woods’ licensing agent brought various federal and state claims against Rush’s publisher,<sup>15</sup> and Rush raised the so-called First Amendment defense, arguing that the First Amendment shielded him from liability.<sup>16</sup> The Sixth Circuit agreed: “Rush’s work [was] entitled to the full protection of the First Amendment....”<sup>17</sup> Its exact holding, however, was unclear and its reasoning even less so. The opinion failed to navigate the law surrounding the various claims, left all to discern for themselves the precedential value of the opinion going forward, and perpetuated the above-outlined issues with the tests that seek to balance the publicity right and First Amendment.

This need not be the case, and the solution is simple: The publicity right should be available to an athlete only in cases where a reasonable person would mistakenly believe that the athlete endorsed a product or service. This far more limited view of the right—one akin to trademark’s false endorsement theory—would end the need for uncertain, unpredictable, and sometimes even unworkable balancing tests in this area of the law.

This article provides background on the publicity right and the First Amendment. It uses the Tiger Woods’

case to explain the flaws in current federal appellate case law regarding the proper way to balance the two rights, and considers and refutes some of the commonly raised arguments in support of a strong and expansive publicity right. It also urges courts to rein in the right, and provides a starting point for doing so.

## Background

Today, the publicity right secures to a person the exclusive commercial value of the person's identity, including the person's name, likeness, or other indicia of identity. While it is most often asserted by celebrities, it is, in most jurisdictions at least, available to any person—celebrity or not. This, however, was not always the case.

### A. Early Views

Before the late 19th century, a person could rarely recover damages from or prevent the unauthorized commercial use of his or her name or likeness. Only two causes of action—libel and trademark infringement—provided such a person with possible legal recourse. Yet these causes of action demanded that a plaintiff allege in his or her complaint—and ultimately prove at trial—far more than today. Libel required proof that someone published a false statement and intended to do so.<sup>18</sup> Trademark infringement required proof that someone used a virtually identical mark on a virtually directly competing good or service.<sup>19</sup>

Beginning in the 20th century, however, plaintiffs began looking to other areas of the law to state their claims. Drawing on theories espoused in an instrumental law journal article,<sup>20</sup> plaintiffs enjoyed modest success by recasting their claims as so-called “right-of-privacy” violations. To be fair, the authors’ vision for the article likely grew out of what they perceived as an overreaching press,<sup>21</sup> but the proposed cause of action—the privacy violation—focused more broadly on restoring “the privacy of private life.”<sup>22</sup>

The earliest right of privacy cases involved unauthorized uses of private people's names or photographs in connection with product advertising.<sup>23</sup> These cases, however, involved only the unauthorized use of an ordinary, private person's name or photograph. They did not involve public figures, such as athletes.<sup>24</sup> For them, courts found, the privacy-based case was readily distinguishable: In contrast to the ordinary person, athletes “had actively sought out their fame and could not be offended by” the “publication of their photographs or images....”<sup>25</sup> To be sure, this rationale assumes the truth of two things—that the athlete does in fact seek out his or her fame, and that, in any event, doing so necessarily means that he or she will never take offense to its use. Courts, nevertheless, seemed not to question these assumptions, never accepted the rationale, and precluded athletes from alleging such privacy-based claims.

A World War II-era Fifth Circuit case is illustrative of early courts' views. In that case, Pabst Brewing used in its

annual football calendar a picture of All-American Texas Christian University quarterback Davey O'Brien alongside a glass of Pabst Blue Ribbon beer. O'Brien claimed violation of his right of privacy, and Pabst Brewing moved the district court to dismiss O'Brien's claim.<sup>26</sup> It did, and the Fifth Circuit quickly affirmed: “[T]he publicity [O'Brien] got was only that which he had been *constantly seeking and receiving*[.]”<sup>27</sup>

Judge Holmes dissented, recognizing that “[t]he majority le[ft] the appellant without remedy for any non-libelous use made of his picture by advertisers of beer, wine, whiskey, patent medicines, or other non-contraband goods, wares, and merchandise.”<sup>28</sup> As Holmes recognized, the majority “place[d] every other...athletic star in the same situation,” unable to recover for the unauthorized use of his or her name, image, or likeness.<sup>29</sup> “The result was that such celebrity athletes as Red Grange, Joe DiMaggio, Joe Louis, Bill Tilden, and most illustrious of all, Babe Ruth, never enjoyed a right of publicity during their careers.”<sup>30</sup>

This all changed in 1953, with a case that began as a garden-variety contract dispute: Two chewing-gum manufacturers' each claimed the exclusive right to a ballplayer's image.<sup>31</sup> Haelan contracted with the ballplayer first; two years later, Topps did the same thing.<sup>32</sup> Haelan claimed that Topps induced the ballplayer to breach his contract with Haelan; Topps countered that both sets of contracts amounted to “no more than a release by the ball-player to plaintiff of the liability which, absent the release, plaintiff would have incurred in using the ball-player's photograph” under then-New York law.<sup>33</sup> This right was “personal, not assignable” and, Topps argued, could not be the subject of a contract.<sup>34</sup> As such, Topps concluded, there was no “property right or other legal interest which [it]s conduct invaded.”<sup>35</sup> The district court agreed but the Second Circuit did not:

[I]n addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be ‘in gross,’ i.e., without an accompany transfer of a business or of anything else.<sup>36</sup>

With that simple line, the Second Circuit solidified into law an early version of the modern-day athlete's publicity right. However, with little reasoning in support of the right, courts had no real guidance in applying the newly established law to the novel facts of a given case. Commentators attempted to justify the new right through other, already accepted theories traditionally used to justify other intellectual property rights. Most famously, Professor Nimmer offered a labor theory justification, arguing “that every person is entitled to the fruits of his

labor unless there are important countervailing public policy considerations.”<sup>37</sup>

Most courts seemed not to care about purported justifications for the right. Courts instead simply embraced it through an attitude of “if value, then right.”<sup>38</sup> That attitude, at least in part, led to the realities of today, where the most famous athletes derive a substantial portion of their income not from their team contracts, but from assigning, licensing, or otherwise contracting away their publicity rights. It also led to the creation of new industries, such as the Major League Baseball Players Association, which collectively handles Major League Baseball players’ publicity rights, and by the beginning of the 21st century, had realized over \$75 million a year from sales of their publicity rights.<sup>39</sup> Tiger Woods, even before winning his first major professional golfing tournament, brought in \$70 million a year from endorsement contracts.<sup>40</sup>

This expanding view of the publicity right also led to a more adversarial advertising world in which advertising giants fought over the exclusive rights to an athlete’s celebrity. At first, these battles typically involved companies competing for exclusive rights to use an athlete’s celebrity. Gatorade and Coca-Cola famously battled over the right to use Michael Jordan in their advertising campaigns.<sup>41</sup> Gatorade offered Jordan a 10-year, \$13.5 million deal, promised him that he would be the beverage’s only endorser, and prevailed.<sup>42</sup> Shortly afterwards, it of course crafted one of the most memorable and effective campaigns in the history of sports marketing.<sup>43</sup>

Over time, however, the focus of these battles shifted. To reduce cost, companies began to use an athlete’s name, image, and likeness without first contracting for the athlete’s rights, and in the process, pushed the practical limits and tested the legal limits of the athlete’s publicity right. This shifted the focus of publicity rights litigation from companies against companies to companies against athletes, increased litigation, and forced companies to assert novel defense theories.

### B. The First Amendment Defense

One such theory involved the First Amendment, which generally safeguards individuals’ rights to freedom of speech and expression. In society, and in the entertainment industry more specifically, these two freedoms play a vital role, helping to foster creativity and disseminate ideas into and within a free market. In legal battles, too, these two freedoms play a critical role in limiting the scope and preventing the overreach of various property rights. In practice, however, whether a First Amendment-based defense will succeed depends on a variety of factors sometimes out of the reach of the party asserting it.

In the publicity rights context, the interplay between the First Amendment and the publicity right is perhaps even less clear. The framework for analyzing a defendant’s allegedly infringing use of a person’s celebrity is not well established, and the success of the defense,

in large part, ultimately turns on whether the presiding trial court classifies the use as commercial or expressive speech. Both enjoy First Amendment protection, but not to the same degree.<sup>44</sup>

“[S]peech that does ‘no more than propose a commercial transaction’” does not enjoy strong protection.<sup>45</sup> Thus, for example, the Third Circuit held that the use of a 13-second audio of narrator John Facenda in a half-hour “Making of Madden NFL ‘06” video was commercial speech because its sole purpose was to promote EA’s Madden NFL video game.<sup>46</sup> On the other hand, First Amendment protection is significantly greater for political or entertaining speech.<sup>47</sup> “The fact that expressive materials are sold does not diminish the degree of protection to which they are entitled under the First Amendment.”<sup>48</sup> Therefore, there is tension.

Recognizing this, courts developed a variety of tests; each attempts to balance the concerns and arrive at a mutually desirable result. None does, and the courts themselves recognize this: While “the distinction between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence.”<sup>49</sup> Nonetheless, these tests make up the current state of the law on the issue.

### C. The Current State of the Law

Forty years ago, the Supreme Court heard its first and only publicity rights case. There, the Court determined whether an Ohio local television news broadcasting station’s First Amendment protections immunized it from liability after it broadcast Hugo Zacchini’s “human cannonball” act in its entirety and without his permission.<sup>50</sup> Recognizing a state-law publicity right independent from existing state law privacy right,<sup>51</sup> the Court reversed the Ohio Supreme Court’s judgment for the broadcasting station.<sup>52</sup> Beyond that, however, it did little else. Its holding was far from a model for clarity: “Wherever the line in particular situations is to be drawn between media reports that are protected and those that are not, we are quite sure that the First and Fourteenth Amendments do not immunize the media when they broadcast a performer’s entire act without his consent.”<sup>53</sup>

It is worth noting that a year later, on remand, the Ohio Supreme Court itself “remanded [the case] for trial to determine whether [the broadcasting station] engaged in an actionable infringement of appellee’s rights and so that damages, if any, may be assessed.”<sup>54</sup> Justice Celebrezze seemed worried that the trial court on remand might simply enter judgment for Zacchini without much analysis. Therefore, he advocated in concurrence for “the [trial] court [to] determine whether any *salient, essential and nuclear portions of a performer’s entire act* have been appropriated.”<sup>55</sup> Whether it did is unclear, however, as no further record exists.

What is clear is that the Court in *Zacchini* failed to seize the opportunity before it to establish a bright-line

rule, or at the very least, a workable standard for lower courts to use in future cases.<sup>56</sup> In any event, the various post-*Zacchini* tests developed by courts, each attempting to balance a plaintiff's publicity right with a defendant's First Amendment rights, demonstrate this reality.

## 1. The Fair-Use Test

Drawing on the copyright law's fair-use defense to infringement, some commentators argue that wholesale importation of the defense would be a "solid development in publicity law" for balancing the publicity right and First Amendment in such cases.<sup>57</sup> First, the defense, much like in copyright, would direct a court to examine (1) the "purpose and character" of the defendant's use of the plaintiff's publicity right; (2) the "nature" of the publicity right; (3) the "amount and substantiality" of the defendant's use; and (4) the effect of the defendant's use on the plaintiff's market for or value of the publicity right.<sup>58</sup> If the court does not find fair use, then it establishes a rebuttable presumption that the publicity right trumps the defendant's First Amendment rights.<sup>59</sup> To rebut the presumption, the defendant must present evidence to prove that his or her use of the publicity right was necessary to achieve the dissemination, public-debate, or self-realization objectives underlying the First Amendment.<sup>60</sup>

No courts agree.<sup>61</sup> This is not surprising, given the many issues surrounding the use of the copyright defense in publicity rights cases. First, it is unclear whether copyright is sufficiently analogous to the publicity right for wholesale or even partial adaptation of the fair use defense. Second, even if it is sufficiently analogous, it is unclear whether each of the four factors is relevant to the defendant's First Amendment rights. To be sure, the "purpose and character" and "amount and substantiality" of the defendant's use most likely are relevant because they bear on, at least in part, whether the use is commercial, educational, newsworthy, and the like. On the other hand, though, it is less clear whether the "nature" of the publicity right is relevant to First Amendment considerations. It is perhaps even less clear how a court would categorize the nature of such a right.

In this sense, the differences between copyright and the publicity right become apparent. As applied to copyright, a court can readily classify the "nature" of a plaintiff's copyrighted work: The court considers, among other things, whether the work is published, whether the work is expressive, and whether the work is stand-alone original work.<sup>62</sup> The relevance of these inquiries, of course, depends on the truth of inferences that a published work, a highly expressive work, and a standalone, original work all deserve stronger protection from infringing uses—even those that might be fair.

When applied to the publicity right, by contrast, characterizing the strength of the right becomes difficult, if not impossible. Perhaps the court could consider the social status of the plaintiff asserting the publicity right. If the plaintiff were a famous, world-class athlete, then his or

her publicity right would be strong. If the plaintiff were a layperson, then perhaps it would not be. Of course, the publicity right does not seem to discriminate against plaintiffs based on their public perception or social status.

## 2. The Transformative Use Test

Perhaps recognizing these issues with copyright's fair use test as applied to publicity right cases, the California Supreme Court applied a modified version of the fair use defense—the so-called "transformative elements" test—in a case involving the use of *The Three Stooges* on t-shirts.<sup>63</sup> Relying almost exclusively on the first fair use factor—the "purpose and character" of the defendant's use—the test asks whether the "work contains significant transformative elements" or whether it merely "takes the form of a literal depiction or imitation of a celebrity for commercial gain..."<sup>64</sup> If the former, then the work is protected; if the latter, then it is not.<sup>65</sup>

Although some courts agree that this test strikes an appropriate balance between the publicity right and First Amendment rights, commentators do not. Preeminent First Amendment scholar Eugene Volokh criticized the *Comedy III* court for its six, arguably distinct definitions of works that would qualify as transformative, all of which borrowed from copyright's fair use law—despite, ironically, the court expressing its desire to distance itself from the fair use model.<sup>66</sup> According to the California Supreme Court, a work could be transformative if it:

- (1) "adds something new" and "alter[s] the [celebrity's likeness] with new expression";
- (2) "adds significant expression beyond" the "literal depiction" of the celebrity's likeness;
- (3) uses the celebrity's likeness as "one of the 'raw materials' from which an original work is synthesized";
- (4) transforms a celebrity's likeness so as to "become primarily the defendant's own expression";
- (5) involves "the creative elements predominat[ing] in the [defendant's] work"; or
- (6) involves a contribution amounting to more than a "merely trivial variation" of the celebrity's likeness.

At first blush, perhaps an exhaustive list of works that qualify as transformative provides some clarity. Upon closer examination, however, the irony with these proposed definitions becomes quite clear. To begin, the first and fourth variations will almost invariably be easier to satisfy—and thus come within First Amendment protection—than the second, third, and sixth. To be sure, case law would likely provide a more concrete answer to whether this proposition is in fact true; regardless, though, the fact remains that defendants in California—or any jurisdiction that follows it—remain uncertain about whether a particular work qualifies as transformative. By focusing almost entirely on that, this uncertainty has the potential to seriously chill artistic endeavor.

### 3. The Predominant Use Test

The Missouri Supreme Court advocates a test that focuses on different facts: It asks whether the “product... sold...predominantly exploits the commercial value of an individual’s identity...even if there is some ‘expressive’ content in it that might qualify as ‘speech’ in other circumstances.”<sup>67</sup> If it does, then the defendant is not entitled to First Amendment protection.<sup>68</sup>

This test calls to attention countless practical and normative issues. First, it offers no methods to distinguish a work that is predominantly commercial from one that is expressive. Second, even if such methods existed, it assumes that the two are separable. In many cases, however, “the two go hand in hand[.]”<sup>69</sup> Third, and perhaps most problematic, the test relies almost exclusively on the commercial value of an individual. In many situations, this reliance might yield a result that makes little sense.

For example, assume first that Artist, *A*, makes a painting of well-known basketball player, *B*. Assume second that *A* makes a painting of lesser-known basketball player, *C*. Assume finally that, in general, the public purchases a painting of a well-known basketball player more than that of a lesser-known basketball player. In this case, then, because *B* is more famous than *C*, the public will purchase *A*’s painting of *B* more than his painting of *C*. Under the predominant use test, *A* will never enjoy First Amendment protection as against *B*, but might against *C*—merely because the public purchased his painting of *B* more than that of *C*. This test therefore incorrectly equates First Amendment protection levels with commercial success, and has the potential to chill artistic endeavor.

### 4. The Restatement Test

The Restatement (Third) of Unfair Competition offers yet another approach: It too draws on copyright’s fair use doctrine, but analyzes only the purpose and character of the defendant’s use, as well as the substantiality and market effect of the defendant’s use.<sup>70</sup> Compared with the above outlined transformative use and predominant use tests, the Restatement’s test seems far more balanced. In other words, it appears to compare directly the First Amendment-protection rationale, creative expression, against the publicity right rationale, commercial control over the use of name, image, and likeness. However, this approach, like the predominant use test, fails to consider that many uses of a person’s identity are both expressive and commercial.<sup>71</sup>

### 5. Beyond the Publicity Right: Alternative Legal Theories

In addition to the publicity right, a plaintiff has at his or her disposal several alternative, seemingly cognizable legal theories. If the plaintiff owns a registered trademark in his or her name, image, or likeness, then a federal or state trademark-infringement claim is a first alternative. Traditional trademark infringement cases require that a

plaintiff prove validity of a mark, ownership of the mark, and unauthorized use of either the mark or a similar mark in a manner likely to cause consumer confusion.<sup>72</sup> In publicity rights type cases, a defendant ordinarily argues fair use to a trademark infringement claim. To prevail on the defense, the defendant must show that it used the mark in a descriptive sense and in good faith.<sup>73</sup>

Even without a registered trademark, federal law provides a second alternative—a trademark infringement claim for an unregistered mark. This too requires that a plaintiff proves ownership of a valid mark.<sup>74</sup> Yet it also requires that the plaintiff proves that a defendant used the mark in a “deceptive and misleading” manner.<sup>75</sup> Most courts address whether the trademark infringement claim for unregistered marks is available in publicity rights cases by holding, quite simply, that a person’s name, image, or likeness cannot function as a trademark, and summarily dismiss them.<sup>76</sup>

A false endorsement claim is a third alternative. This claim requires that a plaintiff proves that a celebrity’s identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity’s sponsorship or approval of the product or service.<sup>77</sup> In the Tiger Woods litigation, expounded upon below, the plaintiff, ETW Corporation (ETW), alleged all of these legal theories (and more). In the process, it put into issue the above outlined balancing tests relating to its publicity rights claims, as well as other tests relating to trademark infringement and false endorsement claims.

## II. The Tiger Woods Litigation

Twenty years ago, on an overcast April weekend at Augusta National, a 21-year-old, 155-pound Eldrick “Tiger” Woods delivered perhaps “the greatest performance ever seen in a golf major.”<sup>78</sup> Over the course of four days, Woods tore through Augusta National’s storied 18-hole course, posted a record 270 four round total, and won the 1997 Masters Tournament by a commanding 12 strokes.<sup>79</sup> In so doing, Woods garnered the attention of the world, not only because of his command over the infuriatingly simple game of golf, but also because of who he was: A Los Angeles native from a mixed race middle class family who was raised by his African American father, who trained on municipal golf courses, and who grew up to dominate a white man’s sport.<sup>80</sup>

Rick Rush pounced on the obvious marketability of Woods’ newly acquired celebrity, created his now famous *The Masters of Augusta* painting, and commemorated Woods’ glory surrounding his record-breaking victory at the 1997 Masters Tournament. The painting depicted Woods in three different poses, included his caddy, and portrayed prior Masters Tournament winners in the background.<sup>81</sup> Rush licensed to Jireh Publishing the exclusive right to sell his painting, and Jireh did.<sup>82</sup> In less than a year, it sold 250 paintings at \$700 each.<sup>83</sup> The years-long

legal battles that followed illustrate perfectly the problem with athletes' publicity rights, artists' First Amendment rights, and courts' attempts to balance them.

### A. Procedural History

Woods responded quickly. Through his licensing agent, ETW, which owned the trademark "TIGER WOODS," he brought federal Lanham Act trademark infringement, unfair competition, and false advertising claims, as well as state law deceptive trade practices claims against Jireh Publishing.<sup>84</sup> In response, Jireh sought declaratory judgment that Rush's paintings are protected by the First Amendment.<sup>85</sup> On summary judgment, the district court held for Jireh on all issues and dismissed the case.<sup>86</sup> ETW appealed.

### B. Opinion

Before the Sixth Circuit, ETW argued that the district court erred in granting Jireh's summary judgment motion because several issues of material fact remained in dispute. First, ETW argued that Jireh infringed the TIGER WOODS mark when it included it in marketing and promotional materials that accompanied the Rush painting.<sup>87</sup> Jireh, by contrast, argued that it did not infringe under trademark's fair use doctrine—in other words, it merely used the mark in its descriptive sense and in good faith.<sup>88</sup> The Sixth Circuit agreed: Jireh merely used the mark "on the back of the envelope containing the print and in the narrative description of the print," and that, perhaps most important, the materials "clearly identif[ied] Rush as the source of the" painting.<sup>89</sup>

Second, ETW argued that, independent of its right in Woods' name, it also had broad rights in Tiger's image and likeness.<sup>90</sup> The Sixth Circuit disagreed.<sup>91</sup> It distinguished between a the use of a source designating word on a good from the use of an athlete's photograph on a good.<sup>92</sup> Unlike a traditional word mark, the court reasoned, which designates the source of a commercial good, "[n]o reasonable person could believe that merely because these photographs or paintings contain Woods' likeness or image, they all originated with Woods."<sup>93</sup>

Third, ETW argued that Jireh's use of Woods' image and likeness suggested a false endorsement.<sup>94</sup> Jireh, by contrast, argued that its use of Woods' image and likeness was protected expression under the First Amendment.<sup>95</sup> The Sixth Circuit agreed.<sup>96</sup>

It applied the Second Circuit's so-called *Rogers* test, designed to balance an artist's First Amendment rights to use a person's celebrity in his or her piece of art with the celebrity's right to control his or her celebrity. Effectively, the test precludes a false endorsement claim based on an artist's use of a person's celebrity unless "the public interest in avoiding consumer confusion outweighs the public interest in free expression," which only occurs when "the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title explicitly misleads as to the source of the content of the work."<sup>97</sup>

When applied to Rush's painting, the Sixth Circuit found that "the presence of Wood's image in Rush's painting...does have artistic relevance to the underlying work and...does not explicitly mislead as to the source of the work."<sup>98</sup> Thus the Sixth Circuit affirmed summary judgment with respect to ETW's false endorsement claim.<sup>99</sup>

Fourth, ETW claimed that Jireh's publication and marketing of Rush's painting violated Woods' publicity right.<sup>100</sup> The Sixth Circuit disagreed, holding that Jireh's First Amendment rights outweighed Woods' publicity right.<sup>101</sup> The court's holding was clear; its reasoning was not, however, as it applied a minimum of three distinct tests to the facts before it:

First, applying the Restatement's approach, which the Sixth Circuit interpreted as "a rule analogous to the rule of fair use in copyright law," the court found that Rush's painting had substantial informational and creative content that outweighed any adverse market effect on ETW's ability to sell the painting.<sup>102</sup>

Second, applying the Tenth Circuit's approach, the Sixth Circuit engaged in an ad-hoc balancing of Rush's expressive rights and Woods' commercial interest in protecting his publicity right.<sup>103</sup> In so balancing, the court found that Woods' appearance in Rush's painting, "which display[s] one of his major achievements," would reduce the commercial value of his publicity right.<sup>104</sup>

Third, applying the California Supreme Court's transformative effects test, the Sixth Circuit found that Rush's painting contained significant transformative elements making it "especially worthy of First Amendment protection...." Unlike mere "unadorned, nearly photographic reproduction[s] of" celebrities' images, the Sixth Circuit found important the "collage of images" in Rush's painting, which "combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods' achievement...."<sup>105</sup>

### Analysis

The Sixth Circuit's long and winding opinion in the Tiger Woods litigation illustrates perfectly the courts' struggles to balance an athlete's publicity right with an artist's First Amendment rights. Before even reaching the publicity rights issue, the Sixth Circuit reviewed *de novo* the district court's summary judgment ruling, addressed eight distinct legal theories, and applied six different legal tests. Even still, once it did finally reach the publicity rights issue, the opinion applied at least three seemingly different tests and was unclear whether it endorsed—or even favored—one over another.

This should not and need not continue. Courts faced with First Amendment defenses in publicity rights cases should approach the issue differently. They should stop relying on imperfect balancing tests, view the publicity right more narrowly, and permit only false endorsement-like theories to proceed.

Thus, in publicity rights cases that pit an athlete's publicity right against an artist's First Amendment right, a court should preclude the athlete from claiming a violation of his or her publicity right unless the artist's use of the athlete's name, image, or likeness rises to the level of suggesting false sponsorship or endorsement. To determine if it does, the court should ask whether a reasonable person would mistakenly believe that the athlete endorses the artist's artwork, when in fact the athlete does not. Even if it finds that the reasonable person would, however, the court should still require that the athlete allege facts sufficient to demonstrate actual current or future market harm.<sup>106</sup>

It is worth noting, finally, that the athlete in this situation would be well advised to bring a federal false endorsement claim rather than a state law publicity right claim. Although entirely the decision of the athlete and his or her counsel, courts view more favorably false endorsement claims than they do publicity right claims. After all, false endorsement assumes, to some extent, actual market harm—the athlete likely would not bring such a claim unless the perceived association is financially detrimental to his or her celebrity or reputation. Publicity rights claims, by contrast, are less tied to the financial harm to the athlete, especially when pitted against the typical artists' countervailing First Amendment rights. If courts can practice a framework like this, then perhaps they can begin to rein in the expanding publicity right, provide a workable analytical framework for addressing dueling interests, and bring some much needed clarity to this existing body of law.

### Conclusion

Forty years ago, the Supreme Court—for the first and only time—addressed the conflict between the publicity right and First Amendment. Its opinion should have provided clarity to a then-poorly understood area of law. It did not, and in the years since, federal and state appellate courts have attempted, time and again, to provide some clarity. They developed a variety of tests to balance the competing rights, considered various theoretical justifications to ground the publicity right, and issued numerous confusing (and sometimes conflicting) opinions. The doctrinal expansion of the publicity right, coupled with the practical growth of athletes' celebrity and personality, has simply proven to be too much for the courts to handle. The framework proposed here might help to provide some much needed clarity to this muddled body of law.

### Endnotes

1. U.S. CONST., art. 1, § 8, cl. 8.
2. *Id.*
3. Roberta Rosenthal Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47, 61 (1994) (explaining rationale).
4. Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953).
5. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 564 (1977).
6. Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1163 (2006).

7. *See, e.g.*, Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 222-23 (1954) (arguing that a valuable persona could be created "only after [a person] has expended considerable time, effort, skill, and even money").
8. Dogan, *supra* note 6, at 1190.
9. *Haelan Labs.*, 202 F.2d at 868.
10. *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 972 (10th Cir. 1996) (considering whether, on the facts of the case before it, a defendant's First Amendment rights trump a plaintiff's publicity right).
11. *Hilton v. Hallmark Cards*, 580 F.3d 874, 890 (9th Cir. 2009) (asking whether an allegedly infringing use represents a substantial transformation of a plaintiff's publicity right).
12. *Compare Comedy III Prods., Inc. v. Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001) (considering "the purpose and character of the [allegedly infringing] use" to determine whether the [person's] likeness is one of the 'raw materials' from which an original work is synthesized") with *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (determining instead the "predominant purpose of the [allegedly infringing] product").
13. *Id.* at 1162-63 ("[C]ourts [continue to] have little way of determining whether a particular speech limitation is necessary or even appropriate...to serve the [publicity-right] law's normative goals.").
14. *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915 (2003).
15. *Id.*
16. *Id.*
17. *Id.*
18. Dogan, *supra* note 6, at 1167.
19. *Id.*
20. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).
21. *Id.* at 195.
22. *Id.*
23. *Pavesich v. New Eng. Life Ins. Co.*, 50 S.E. 68 (Ga. 1905); *Foster-Milburn Co. v. Chinn*, 120 S.W. 364, 366 (Ky. 1909).
24. *E.g., id.*
25. *See, e.g.*, *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 170 (5th Cir. 1941) (affirming dismissal of publicity-right-violation claim "the publicity [the athlete] got was only that which he had been constantly seeking and receiving").
26. *Id.* at 167-68.
27. *Id.* at 171.
28. *Id.* (Holmes, J., dissenting).
29. *Id.*
30. Paul C. Weiler et al., *SPORTS AND THE LAW: TEXT, CASES, AND PROBLEMS* 629 (5th ed.). In 1990, Babe Ruth's daughters brought a trademark infringement claim against a calendar manufacturing company after it used three photographs of Ruth in one of its calendars. *See Pirone v. MacMillan, Inc.*, 894 F.2d 579, 580 (2d Cir. 1990). They did not recover. *Id.* at 583. The Second Circuit held that "a photograph of a human being, unlike a portrait of a fanciful cartoon character is not inherently 'distinctive' in the trademark sense of tending to indicate origin." *Id.*
31. *Haelan Labs. v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir. 1953).
32. *Id.* at 867.
33. *Id.*
34. *Id.*
35. *Id.* (internal quotations omitted).
36. *Id.*
37. Melville B. Nimmer, *The Right of Publicity*, 19 L. & CONTEMP. PROBS. 203, 212 (1954).

38. *Supra* note 8, at 1174 (quoting Rochelle Cooper Dreyfuss, *Express Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 405 (1990)).
39. *Supra* note 38, at 630.
40. *Id.* at 632.
41. Terry Lofton, *To 'Be Like Mike,' Gatorade Had to Poach Michael Jordan from Coke*, SPORTS BUSINESS DAILY (Feb. 17, 2014), available at <http://www.sportsbusinessdaily.com/Journal/Issues/2014/0-2/17/Champions/Schmidt-Jordan.aspx>.
42. Darren Rovell, *Famed 'Be Like Mike' Gatorade Ad Debuted 25 Years Ago*, ABC NEWS (Aug. 8, 2016 3:20 PM), available at <http://abcnews.g-o.com/Sports/famed-mike-gatorade-ad-debuted-25-years-ago/story?id=41213270>.
43. *Id.*
44. *Winters v. New York*, 333 U.S. 507, 510 (1948).
45. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 771-72 n.24 (1976) (internal quotations omitted).
46. *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1015-18 (3d Cir. 2008).
47. *Id.*
48. *City of Lakewood v. Plain Dealer Publ'g Co.*, 486 U.S. 750, 756 n.5 (1988).
49. *Campbell v. Acuff-Rose Music, Inc.*, 501 U.S. 569, 579 (1994).
50. *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 565 (1977).
51. *Id.* at 572-73.
52. *Id.*
53. *Id.*
54. *Zacchini v. Scripps-Howard Broadcasting Co.*, 376 N.E.2d 582, 583 (Ohio 1978).
55. *Id.* at 290 (Celebrezze, J., concurring).
56. *See, e.g., Hart v. Elec. Arts, Inc.*, 808 F. Supp. 2d 757, 775 (D.N.J. 2011) (limiting *Zacchini's* holding to its facts); *C.B.C. Distrib. & Mktg, Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823 (8th Cir. 2007).
57. Pamela Samuelson, *Revisiting Zacchini: Analyzing First Amendment Defenses in Right of Publicity and Copyright Cases*, 57 TUL. L. REV. 836, 915 (1983).
58. *Id.*
59. *Id.* at 916.
60. *Id.*
61. The Tenth Circuit outright rejected the district court's use of the fair-use defense in a famous publicity-rights case raising the First Amendment defense. *See Cardtoons v. Major League Baseball Players Ass'n*, 95 F.3d 959, 964, 972 (10th Cir. 1996).
62. *See, e.g., Campbell v. Acuff-Rose Music, Inc.*, 501 U.S. 569, 579 (1994).
63. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804-08 (Cal. 2001).
64. *Id.*
65. *Id.*
66. Eugene Volokh, *Freedom of Speech and Right of Publicity*, 40 Hous. L. REV. 903, 914-15 (2003).
67. *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc) (internal quotations in original).
68. *Id.*
69. Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 LOY. L.A. ENT. L. REV. 471, 493 (2003).
70. RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 47, cmt. d (1995).
71. *Doe*, 110 S.W.3d at 374.
72. U.S. CT. OF APPEALS FOR THE NINTH CIRCUIT, *Jury Instructions: 15.6 Infringement—Elements and Burden of Proof—Trademark*, available at <http://www3.ce9.uscourts.gov/jury-instructions/node/-233>; *see also* 15 U.S.C. § 1114(1).
73. *Victoria's Secret Stores v. Artco Equip. Co.*, 194 F. Supp. 2d 704, 724 (S.D. Ohio 2002).
74. 15 U.S.C. § 1125(a).
75. *Id.*
76. *See, e.g., ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 922 (6th Cir. 2003); *Pirone v. MacMillon, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990).
77. MCCARTHY, *THE RIGHTS OF PUBLICITY & PRIVACY*, § 5:30 (2d ed. 2000).
78. Rick Reilly, *Strokes of Genius*, 58 SPORTS ILLUSTRATED, Apr. 21, 1997, at 36.
79. *Id.* at 37.
80. *Id.*
81. *ETW Corp.*, 332 F.3d at 916.
82. *Id.*
83. *Id.*
84. *Id.*
85. *Id.* at 917.
86. *Id.* at 918.
87. *Id.*
88. *Id.*
89. *Id.*
90. *Id.*
91. *Id.* at 920.
92. *Id.*
93. *Id.*
94. *Id.*
95. *Id.*
96. *Id.* at 921.
97. *Id.*
98. *Id.*
99. *Id.*
100. *Id.* at 923.
101. *Id.*
102. *Id.*
103. *Id.*
104. *Id.*
105. *Id.*
106. Whether the athlete alleges facts sufficient to demonstrate actual current or future market harm, of course, will change at each stage of litigation. *See, e.g., ASPCA v. Feld Entm't, Inc.*, 677 F. Supp. 2d 55, 59 n.4 (D.D.C. 2009) (granting a defendant's post-trial directed verdict motion for lack of standing despite rejecting the defendant's pre-trial summary judgment motion for lack of standing, *see ASPCA v. Ringling Bros. & Barnum & Bailey Circus*, 317 F.3d 334, 336 (D.C. Cir. 2003)).

**Ryan Hersh is a recent honors graduate of University of Connecticut School of Law, where he earned the Intellectual Property Certificate and served as Articles Editor for *Connecticut Law Review*. He wrote the above article for his spring 2017 Sports and the Law course, for which he earned the course's highest grade. Ryan practices intellectual property law with a New York City-based firm.**

# The Law Goes to Broadway<sup>1</sup>

By Bennett Liebman

Broadway's mega-hit musical "Hamilton" could be seen by many as simply the most recent in a long line of legal dramas. It could be summarized as two brilliant rival attorneys confronting each other over a course of three decades leading to momentous, and eventually disastrous, consequences.<sup>2</sup> "Hamilton" points out the host of connections between the bar and the stage. While these connections are deep on the playwright side, one can also find lawyers as composers, lyricists and actors. There are many courtroom dramas and musicals with songs based on the practice of law.

## Musicals by Lawyers

An interesting number of composers and lyricists have been involved in the law. At the behest of his father, Oscar Hammerstein attended Columbia Law School for two years<sup>3</sup> and even worked for a time at a law firm. Mae West allegedly advised him early in his theatrical career: "Listen, get out of this crazy business and go back to your law career. The theatre ain't for you, kid. You got too much class!"<sup>4</sup> Fortunately, he did not heed Ms. West's advice. Hammerstein stayed in theater and became America's most successful lyricist.

---

---

*"Despite the number of shows with courts and lawyers, there is not an abundance of songs involving the law."*

---

---

One composer who did graduate from Columbia Law School was Arthur Schwartz. While he published his first song in 1923, he continued his legal practice into the late 1920s. Only with increased success on Broadway did he give up practicing law. What followed was a near 40-year career producing classic songs such as, "That's Entertainment," "Dancing in the Dark," and "By Myself." There are no reported cases where Arthur Schwartz served as an attorney.

Hoagie Carmichael received his law degree from Indiana University and did practice law for a few years before devoting his career to music. Carmichael wrote the music for 1940's "Walk with Music," and his songs were featured in many Broadway revues over the decades. Another example includes the prominent San Francisco-based lawyer Joseph Deign Redding, who contributed the libretto to Victor Herbert's operetta "Natoma," in 1911.

Other composers who did not successfully find their ways through law school included Cole Porter, who lasted a year at Harvard Law School, and Harold Rome, who attended one year of school at Yale Law School. Paul Simon who wrote the score to "The Capeman," which ran

for two months on Broadway in 1998, attended Brooklyn Law School for one year.

In the comic opera world, the renowned librettist W.S. Gilbert of the 19th century team of Gilbert and Sullivan served for a time as a lawyer.<sup>5</sup> He practiced for four not particularly successful years. It has been said that he averaged five clients per year.<sup>6</sup> Nor did these few clients pay well, as in his first two years of practice he earned a total of £25.<sup>7</sup> Nonetheless, after his many successes in the theater in 1891, Gilbert started in 1891 to serve as a magistrate in Middlesex County.<sup>8</sup> Thus, his career arc saw him serving as a lawyer, librettist and magistrate. In "Iolanthe," Gilbert had the Lord Chancellor sing, "The law is the true embodiment of everything that's excellent. It has no kind of faults or flaw. And I, my lords, embody the law."

Two prominent American lawyer-playwrights contributed to several musicals. Elmer Rice contributed some lyrics to his play "Street Scene," when it was transformed into a musical in 1947.<sup>9</sup> Lawyer-playwright Benjamin Kaye<sup>10</sup> contributed lyrics to a song in the Garrick Gaities of 1925, and wrote some lyrics for an early Richard Rogers show in 1919, entitled "Up Stage and Down."<sup>11</sup>

## Songs About the Law

Despite the number of shows with courts and lawyers,<sup>12</sup> there is not an abundance of songs involving the law. One musical with many law-related songs is 1998's "Parade," about the Leo Frank murder trial and subsequent lynching. Much of the conclusion of the first act involves testimony at and the reaction to the trial. The nine trial-related songs include, "It Is Time Now," "Twenty Miles from Marietta," "Frankie's Testimony," "The Factory Girls," "Newt Lee's Testimony," "My Child Will Forgive Me," "That's What He Said," "It's Hard to Speak My Heart," and "Closing Statements." 2010's "Scottsboro Boys" also has songs from its murder trials in "Nothin'" and "Financial Advice."

Most other musicals tend to have one law-related number. The best-known law-related song might be Billy Flynn's "Razzle Dazzle" in "Chicago."

In "Hamilton," only the early second act number "Non Stop" references the respective law practices of Burr and Hamilton, with Aaron Burr singing, "I finished up my studies and I practiced law," with Alexander Hamilton responding, "I practiced law, Burr worked next door."

"Legally Blonde" might be about the life of an improbably successful student in law school, but it also has few law related songs. The closest to a law song involves the loathsome criminal law professor Callaghan urg-

ing his students on the first day of class to “Look for the Blood in the Water.” Callaghan sings:

Read your Thomas Hobbs  
Only spineless snobs  
Will quarrel with the morally dubious  
jobs  
Yes, blood in the water  
Your scruples are a flaw.

Other law-related songs included the Groucho Marx sendup of “Samovar the Lawyer” in the 1980 musical “A Day in Hollywood/A Night in the Ukraine.” There is “My Son the Lawyer” from 1962’s “A Family Affair,” “Pay the Lawyer,” from 1989’s “Welcome to the Club” and “The Family Solicitor” from 1986’s “Me and My Girl.” The Gershwins included court-related songs in their two satiric musicals of the early 1930s: “When the Judges Doff the Ermine” is in “Let ‘Em Eat Cake,” and in “Of Thee I Sing,” the Supreme Court judges sing the prelude to “Here’s a Kiss for Cinderella” and join with the newly inaugurated president in “Some Girls Can Bake a Pie.”

---

*“Surprisingly, few lawyers have made it to Broadway. The most illustrious lawyer-actor is probably Paul Robeson, who starred in both dramas and musicals.”*

---

In addition to “Iolanthe,” W.S. Gilbert injected the law and lawyers into the lyrics of many of his shows including “The Mikado,” “Trial by Jury,” “HMS Pinafore,” “The Sorcerer” and the “Grand Duke.”<sup>13</sup> In “The Mountebanks,” an opera written with Alfred Cellier (not Arthur Sullivan), Gilbert suggested some legal advice for Ophelia in pursuing a breach of promise action against Hamlet: “Ophelia, to her sex was a disgrace, Whom nobody could feel compassion for, Ophelia should have gone to Ely Place, To Consult an Eminent Solicitor.”<sup>14</sup>

One other musical with a significant number of law-related songs is arguably the first musical of all time, John Gaye’s “The Beggar’s Opera,” from 1728.<sup>15</sup> The show contains songs such as: “The Charge Is Prepar’d; The Lawyers Are Met,” “Since Laws Were Made for Ev’ry Degree,” “And When My Hero in Court Appears,” and “O Cruel, Cruel, Cruel Case.” Songs about the law have been present since the dawn of musicals.

## Lawyers as Actors

Surprisingly, few lawyers have made it to Broadway. The most illustrious lawyer-actor is probably Paul Robeson, who starred in both dramas and musicals. Robeson famously played “Othello” and starred in Eugene O’Neil’s “All God’s Chillun Got Wings.” He sang “Ol’ Man River” in the 1932 revival of “Show Boat.”

John Cleese of Monty Python fame has a degree from University of Cambridge Law School. He performed in the musical “Half a Sixpence” in the 1960s on Broadway, and also played the voice of God in “Spamalot.”

The lawyer, politician-turned-actor Fred Dalton Thompson starred in 2013’s “A Time to Kill.” Jerry O’Connell, the star of many movies, dropped out of Southwestern Law School. He was featured on Broadway in “Living on Love” and “Seminar.”

Ross Martin, known for his role on television’s “Wild, Wild West,” was a graduate of George Washington Law School. He was on Broadway in “Hazel Flagg” and “Shin-bone Alley.”

John Kerr was in five Broadway plays in the 1950s and won a Tony for “Tea and Sympathy.” He graduated from UCLA Law School in 1969, and after that appeared only sporadically as an actor.

Tom Schmid was a lawyer who was in the Broadway revival of “Annie Get Your Gun.” He was also in numerous movies and television shows.

Michael Maguire won a Tony Award for playing Enjolras in the original Broadway cast of “Les Miserables.” At the age of 53, he received a law degree from Southwestern Law School and practices family law in Beverly Hills.<sup>16</sup>

Estelle Parsons enjoyed a nearly 60-year career in Broadway. She graduated from Boston University School of Law.

Grant Mitchell, who graduated from Harvard Law School and practiced law for a short time, appeared in dozens of Broadway shows and movies from 1900 to 1950. Another character actor with many credits who was initially a lawyer was Ralph Morgan. He was the brother of Frank Morgan, who played the character of the Wizard of Oz.

Maclyn Arbuckle unsuccessfully practiced law in Texarkana, Texas in the late 19th century. After leaving the law for the stage, he became a successful character actor both on Broadway and in early movies.

One stunt-casted lawyer was Jerry Springer, who before his television days practiced law in Cincinnati for nearly two decades. Springer appeared in limited runs in both “Chicago” and the “Rocky Horror Show.”

## Legal Plays

Determining whether a show or a movie is law-related is not a simple matter. Must it involve lawyers?<sup>17</sup> Must it involve a court case? Must there be an actual trial? Do administrative or foreign tribunals count?<sup>18</sup> Does it comment on the legal system?<sup>19</sup> The intent here is to lecture those plays that focus on lawyers, their clients, judges, juries, and their roles in the legal system.

There are numerous books reviewing movies with legal content.<sup>20</sup> Judge Alex Kosinski has written that “lawyers and trials are a perennial subject of moviemaking.”<sup>21</sup> There are numerous guides to the best legal movies.<sup>22</sup> Yet, with so many movies focused on the law, there are far fewer plays that do as well.

---

---

*“Yet this list of what were also made into top movies does not scratch the surface of legal plays. While there have been far fewer plays than movies, there are numerous legal plays.”*

---

---

Of the top 50 legal movies as determined by a panel for the American Bar Association in 2008,<sup>23</sup> only 10 were Broadway shows. These were: “12 Angry Men,” “Inherit the Wind,” “Witness for the Prosecution,” “Judgment at Nuremberg” “A Man for All Seasons,” “A Few Good Men,” “Compulsion,” “Counselor at Law,” “The Caine Mutiny,” and “A Time to Kill.”<sup>24</sup> Stage adaptation of two of the top legal movies—“Anatomy of a Murder” and “To Kill a Mockingbird”—were made, but neither adaptation reached Broadway. While we tend to think that Broadway dramas are the impetus for future movies, only five of these shows actually were, such as: “Inherit the Wind,” “Witness for the Prosecution,” “A Man for All Seasons,” “A Few Good Men,” “Compulsion,” and “Counselor at Law.” Broadway’s “Caine Mutiny Court Martial” opened as the film version was being made. “Judgment at Nuremberg” did not appear on Broadway until four decades after the film. Both “Twelve Angry Men” and “Judgment at Nuremberg” were television dramas before they were filmed.

Yet this list of what were also made into top movies does not scratch the surface of legal plays. While there have been far fewer plays than movies, there are numerous legal plays. There have been American courtroom dramas since 1771’s “The Trial of Atticus, Before Justice Beau, For A Rape.”<sup>25</sup> In 1842, there was the trial drama “The People’s Lawyer.”<sup>26</sup>

There is Shakespeare’s “Merchant of Venice.”<sup>27</sup> There have been Supreme Court plays, such as: “Thurgood” and “First Monday in October.” An off-Broadway play named “The Mountain,” about William O. Douglas, opened in 1990, and “The Originalist,” about Antonin Scalia, started off Broadway in 2015.<sup>28</sup> Elmer Rice wrote “Counselor at Law” (1931) and “On Trial” (1914), “For the Defense” (1919), “It Is the Law,” (1922), “Judgment Day (1934) and “The Winner” (1954). Other legal plays include: “The Woman on the Jury” (1923), “The Trial of Mary Dugan” (1927), “The Bellamy Trial” (1931), “They Shall Not Die” (1934), “Night of January 16” (1935),<sup>29</sup> “The Trial of Dr. Beck” (1937), “Billy Budd” (1951), “The Crucible” (1953), “Time Limit” (1956), “The Ponder Heart” (1956) “The Andersonville Trial” (1959), “A Case of Libel” (1963),

“The Trial of Lee Harvey Oswald” (1967), “The Man in the Glass Booth” (1968), “In the Matter of J. Robert Oppenheimer” (1969), “The Trial of the Catonsville Nine” (1971), “The Runner Stumbles” (1976), “Zoot Suit” (1979), and “Race” (2009). The number of new legal non-musical plays has shrunk in recent years. Revivals of “Inherit the Wind,” “A Man for All Seasons,” and “The Crucible” appear, but new legal plays on Broadway are scarce.

## Lawyers as Playwrights

Lawyers make prolific playwrights. There have been lawyer-playwrights for centuries. An 1811 book states that:

A large majority of those who have been eminently successful in writing for it, have been originally bred to the study of the law. A fact so predominating in such a number of instances, cannot be the result of mere accident, and therefore manifestly indicated that there must exist, some connection however imperceptible to the world in general, between the law and drama.<sup>30</sup>

The Roman first century lawyer and philosopher Seneca wrote at least nine different plays.<sup>31</sup> He committed suicide upon the orders of the Emperor Nero. Eight of his tragedies—“Agamemnon,” “Hercules,” “Furens,” “Medea,” “Thyestes,” “Oedipus,” “Phaedra,” “Phoenisse,” and “Troades”—have survived.<sup>32</sup>

## The 16th to 18th Centuries

The 1500s to the 1700s cultivated many lawyer playwrights. Marc Lescarbot was one of them, and he received his law degree in France in 1598.<sup>33</sup> He spent much of his time in Canada, which at that time was referred to as “New France.” His dramatic poem, “Théâtre de Neptune,” was performed at Port Royal in Acadia, in what is claimed to be the first European theatrical production in North America outside of New Spain.<sup>34</sup>

Pierre Corneille was a 17th century French lawyer and playwright.<sup>35</sup> He wrote numerous plays over a 50 year period. His play “Le Cid” was performed on Broadway in 1958. “Corneille has often been referred to as the “father” of French classical tragedy.”<sup>36</sup>

In England, in the early 16th century, John Rastell, who was Sir Thomas More’s brother-in-law,<sup>37</sup> was both a lawyer and a playwright.<sup>38</sup> His play “The Four Elements” is rarely, but occasionally, performed. As a publisher, he was the first Englishman to print plays.<sup>39</sup>

In France, Pierre Mariveaux in the 18th century was trained as a lawyer<sup>40</sup> and wrote numerous plays and comedies that survive to this day. In 1997, the musical “Triumph of Love” opened on Broadway based on his comedy “Le Triomphe de l’Amour.”

---

*“Arthur Murphy in the 18th century was a barrister, actor and a playwright in England. Not only did he have an active legal practice, he also wrote numerous plays in the second half of the 18th century.”*

---

In 18th century France, Pierre Augustin Caron De Beaumarchais wrote the comedies “Le Barbier de Seville” and “Le Mariage de Figaro,” both of which are famous for their adaptation to opera.<sup>41</sup> Beaumarchais served as a magistrate for many years and rewrote the hunting laws of France.<sup>42</sup> He also opined on the legal rights of kings and the French Parliament.<sup>43</sup> He helped establish the dramatist’s right to his or her own work<sup>44</sup> and largely “established the present system of royalties and copyrights.”<sup>45</sup>

Henry Fielding was both a lawyer and a magistrate in England.<sup>46</sup> While he may best be known for “Tom Jones” and other novels, he also wrote a number of plays.<sup>47</sup> He had 10 plays in production during the 1735 to 1736 season.<sup>48</sup> George Bernard Shaw considered Fielding to be the greatest English playwright other than Shakespeare from the Middle Ages until the 19th century.<sup>49</sup> The political nature of Fielding’s plays disturbed the ruling forces in the English government. In order to prevent production of Fielding’s plays, the government in 1737 passed the Licensing Act that “forbade the production of any play not approved by the Lord Chamberlain.”<sup>50</sup> It was not repealed until 1968.

Arthur Murphy in the 18th century was a barrister, actor and a playwright in England. Not only did he have an active legal practice, he also wrote numerous plays in the second half of the 18th century. “The Grecian Daughter” was one of the most popular shows of the era.<sup>51</sup>

## The 19th Century

Not surprisingly, there were many American lawyer-playwrights in the 1800s. Philadelphia-based attorney Richard Penn Smith wrote numerous popular plays in the decade between 1828 and 1838.<sup>52</sup> Smith played an outsized role in popularizing the story of Davy Crockett at the Alamo. Hugh Henry Brackenridge was also an attorney from Pennsylvania. He served as a member of the Pennsylvania Supreme Court from 1799 until his death in 1816.<sup>53</sup> During the Revolutionary War, he wrote the plays “The Battle of Bunker-Hill” (sic) and “The Death of General Montgomery at The Siege of Quebec.”<sup>54</sup> Another Pennsylvania-based politician-playwright-lawyer was Ralph T. Conrad. Conrad served as a lawyer and judge in Pennsylvania and was also the mayor of Philadelphia. He wrote the play “Jack Cade,” which was very successful in the first half of the 19th century.

Edward Owings Towne wrote the play “Other People’s Money” in 1895, basically two decades before the term was popularized by Louis Brandeis in his book “Other People’s Money, and How the Bankers Use It.” Towne also wrote the play “By Wits Outwitted,” and many books and poems. He served as an attorney in Chicago and New York City.

Augustus Thomas, who worked as a lawyer in Missouri in the late 19th century, wrote dozens of Broadway plays from 1891-1928. He also wrote and directed several silent films.

Fred Marsden left the field of law to become a playwright. He wrote many comedies and melodramas before his suicide in 1888.

John McNally was a Harvard Law School graduate who abandoned law to become involved in the theater. He initially worked as a critic, and then wrote numerous farces in the late 19th and early 20th century.

Another lawyer-playwright was Mordechai Noah, who was one of the most prominent Jewish Americans in the first half of the 19th century. Noah even led an effort to establish a Jewish community in Grand Island, New York, near Niagara Falls. He wrote many plays, including the popular “She Would Be a Soldier.”<sup>55</sup> After his efforts at Grand Island failed, Noah dedicated himself to establishing a homeland for the Jews in Palestine.

Interestingly enough, the modern founder of Zionism, Theodor Herzl, was also a lawyer-playwright. He received his law degree from the University of Vienna in 1884. He wrote numerous comedies before writing the drama “The New Ghetto” in 1894. The show chronicles a Jewish lawyer’s attempt to find himself in a modern world.<sup>56</sup>

In France, Jules Verne received his law degree in 1849. Besides his extremely successful novels, he also wrote many plays.<sup>57</sup>

The famed novelist Wilkie Collins graduated from law school in 1851 and was called to the bar. There is no record of his practicing. Besides his novels, Collins wrote the play “The Lighthouse.” He wrote the play “The Frozen Deep” with assistance from Charles Dickens, and he and Dickens collaborated on “No Thoroughfare.” Collins’ novels were the basis for many other plays, including the musical “The Woman in White,” which was on Broadway in 2005.

E.T.A. Hoffman studied law at the University of Königsberg and became a court official with the Prussian government in Berlin. In 1816, he was appointed as a judge. Starting in 1799, he wrote many plays. His artistic output was not limited to playwrighting, however. He also was a novelist, composer, conductor, and painter.

## 20th Century

The 20th century saw a slew of American lawyer-playwrights. Foremost among them was the Pulitzer prize winning author Elmer Rice. Rice practiced law for several years before he started playwriting. He claimed that he passed the New York State bar exam even though "some of my answers were in blank verse; others included jokes, limericks, quotations from Shakespeare, the Bible, Omar Khayyam and Lewis Carroll."<sup>58</sup> Rice wrote about 30 plays on Broadway over his career of more than five decades.

Benjamin Kaye wrote five comedies for Broadway. He also provided the English translations for Charles Aznavour's lyrics when "Aznavour" appeared on Broadway in 1970.

Henry Denker wrote seven plays for Broadway. In one of his more successful plays, "A Far Country," the future district attorney in television's "Law and Order," Steven Hill played Sigmund Freud. Before he became successful in the writing business, Denker was a general practitioner whose business included worker's compensation law.

Lawrence Langner was an esteemed patent lawyer at Ladas and Parry. He wrote many plays over a quarter century and helped to found and run the Theatre Guild.

Archibald MacLeish wrote five plays on Broadway and won a Tony Award and a Pulitzer Prize in 1959 for "J.B." Besides being a poet and the Librarian of Congress, MacLeish graduated from Harvard Law School, where he was a member of the law review and received the Faye Diploma for "evidence of the greatest legal promise."<sup>59</sup> He practiced law in Boston for three years at Choate, Hall and Stewart.

George Hazelton wrote five plays in the early 20th century. He was a practicing lawyer when his 1900 play "Mistress Nell" became a hit.

Langdon Mitchell was admitted to the New York bar in 1886. He wrote numerous plays for Broadway in the early 20th century, and his 1906 play, "The New York Idea," has seen numerous revivals.

Jerome Weidman, who attended the New York University School of Law, wrote the book for four musicals (and his own play "The Mother Lover"). He also wrote the Pulitzer Prize winning "Fiorello."

Norman Krasna attended St. John's Law School. He wrote 11 plays for Broadway from 1931 to 1975, along with numerous film scripts.

George Scarborough graduated from the University of Texas Law School in 1897 and practiced law in Texas for eight years. He authored 10 Broadway plays from 1913 to 1927.

In the United Kingdom, the novelist John Galsworthy graduated from Oxford and was called to the bar in 1890.

Based on his success as a writer, he was able to give up his legal practice. While he is now best known for "The Forsyte Saga," he wrote numerous plays in the first third of the 20th century.

John Mortimer was a very successful attorney. He was called to the bar in 1948 and was appointed a Queen's Counsel in 1966. He represented many defendants in obscenity cases. He wrote many plays, including "The Dock Brief," "The Wrong Side of the Park," and "A Voyage Round My Father."

In the early 20th century, French writer Tristan Bernard started his career as an attorney. Besides novels, he wrote more than 40 plays for the French stage. Four of his plays made it to Broadway in the first decade of the 20th century.

In 1937, Toronto-based lawyer Brian Doherty's Broadway hit was "Father Malachy's Miracle."<sup>60</sup> Doherty also founded the Shaw Festival on Niagara-on-the-Lake in Ontario. He continued to practice law for nearly 30 years after his success with "Father Malachy's Miracle."

While not technically a dramatist, the writer and worker's compensation lawyer Franz Kafka has provided the source material for many Broadway plays, including "Metamorphosis," "The Trial," "In the Penal Colony," and "Le Procès."

## Current Lawyer-Playwrights

The most prominent lawyer-playwright is probably Ken Ludwig, who graduated from Harvard Law School and has a degree in international law from the University of Cambridge. Ludwig wrote the hit shows "Lend Me a Tenor" and "Moon over Buffalo" and the librettos for the musicals "The Adventures of Tom Sawyer" and "Crazy for You." He also worked for years in the Washington office of Steptoe and Johnson.<sup>61</sup>

## Conclusion

Given the examples of Cole Porter and Oscar Hammerstein, many cynics might believe that the quickest path to Broadway from law school involves dropping out of school. Yet the continued presence of lawyers in theatre for centuries suggests otherwise. Lawyers and theatre seem a natural match. To paraphrase W. S. Gilbert's lyrics from "Iolanthe," the law embodies the theatre. There will certainly be more lawyers on Broadway in our future.

## Endnotes

1. This is intended to be a general survey, rather than an encyclopedic treatment of this topic. This article would not be possible without access to the Internet Broadway Database (ibdb.com). The webpage of Professor Christine Alice Corcos of Louisiana State University Law Center is also a great resource, as it showcases the non-legal careers of lawyers and law school graduates. See <http://faculty.law.lsu.edu/ccorcos/Student%20>

- Services/What%20Else%20You%20Can%20Do%20With%20a%20Law%20Degree.htm.
2. Given the success of "Hamilton," will there be additional plays or musicals based on legal rivalries? Will we see a musical about the disagreements between Supreme Court Justices William O. Douglas and Felix Frankfurter or between Louis Brandeis and James McReynolds?
  3. Hugh Fordin, *Getting to Know Him*, 33 (1995).
  4. Oscar Andrew Hammerstein, *The Hammersteins: A Musical Theatre Family*, 97 (2010).
  5. Sir W.S. Gilbert, *Encyclopedia Britannica*, available at <https://www.britannica.com/biography/W-S-Gilbert>.
  6. Claire Lee Purdy, *Gilbert and Sullivan, Masters of Birth and Melody*, 11 (1946); Weston P. Hatfield, "Sir William Schwenk Gilbert—Lawyer and Librettist," 46 *A.B.A. Journal* 386 (1960). Even with his theatrical successes, Gilbert regularly resorted to litigation and "Gilbert must be among the most litigious writers in history." X.J. Kennedy, Jane W. Stedman "A New Life of W. S. Gilbert," *The New Criterion*, January 1, 1997.
  7. Weston P. Hatfield, "Sir William Schwenk Gilbert—Lawyer and Librettist," 46 *A.B.A. Journal* 386 (1960).
  8. *Id.* at 389; Jane W. Stedman, *W.S. Gilbert: A Classic Victorian and His Theatre*. 338 (1996); Sir W. S. Gilbert Drowned: Tragical Death of The Great Playwright, *Irish Times*, May 30, 1911. Gilbert as a magistrate "was known for his refusal to believe that the evidence of the police was always correct and his concern to establish the social background and the life chances of those who came before him for sentencing." Ian Bradley, "The Very Model of a Modern Victorian Agnostic," *Times of London*, May 28, 2011.
  9. Ethan Mordden, *Beautiful Mornin'*, 148 (1999).
  10. Kaye co-founded the firm Kaye Scholer in 1917. It is now part of Arnold & Porter Kaye Scholer LLP.
  11. Steven Suskin, *Show Tunes: The Songs, Shows, and Careers of Broadway's Major Composers*, 81 (2014).
  12. Even "Hello Dolly" has a New York City courtroom scene which enables the secondary lovers Cornelius Hackl and Irene Molloy to sing "It Only Takes a Moment." The court in "Hello Dolly" is per Playbill at a "courtroom on Centre Street" presumably the same court used in "Here's Love," the musicalized version of the film "Miracle on 34th Street." Much of the second act in "Here's Love" takes place at the New York Supreme Court. Furthermore, there is a New York courthouse scene in "The Producers." That scene could also take place in the same courthouse.
  13. "Gilbertian Lawyers" 14 *Green Bag* 603 (1902).
  14. *Id.*
  15. Ethan Mordden, *Anything Goes*, 3 (2013).
  16. See <https://www.superlawyers.com/california-southern/article/to-dream-a-dream-of-family-law/0dc2cf7b-4438-4611-bdac-943a31ef7e63.html>.
  17. For example, there are no lawyers, only jurors, in "Twelve Angry Men."
  18. For example, 1969's "In the Matter of J. Robert Oppenheimer" involves an administrative hearing before the Personnel Security Board of the Atomic Energy Commission. The "Caine Mutiny Court Martial" does not involve a formal court.
  19. Many of these questions are raised in Ross D. Levi, *The Celluloid Courtroom* (2005).
  20. *Id.* See also Paul Bergman and Michael Asimow, *Reel Justice* (1996); John Denvir ed. *Legal Reelism: Movies as Legal Texts* (1996); Steve Greenfield, Guy Osborn and Peter Robson, *Film and the Law*, (2010), Stefan Machura and Steven Robson, *Law and Film* (2001); Rennard Strickland, Tere E Foster, Taunya Lovell Banks, *Screening Justice--The Cinema of Law: Significant Films of Law, Order, and Social Justice*, (2006).
  21. Alex Kosinski, Foreword in Bergman and Asimow. *Id.* at xi. Similarly, it has been written that, "Few figures—perhaps only cowboys soldiers, police and private eyes—have had a more extensive and consistent cinematic presence than lawyers." Allen K. Rostron, "Book Review Lawyers, Law & the Movies: The Hitchcock Cases," 86 *Cal. L. Rev* 211, 213 (1998).
  22. "The Best Legal Movies That Every Law Student Should Watch," <https://lawschooli.com/best-law-school-movies/>; "The 25 Greatest Legal Movies," available at [http://www.abajournal.com/magazine/article/the\\_25\\_greatest\\_legal\\_movies/](http://www.abajournal.com/magazine/article/the_25_greatest_legal_movies/); "Honorable Mention," available at [http://www.abajournal.com/magazine/article/honorable\\_mentions/](http://www.abajournal.com/magazine/article/honorable_mentions/); "Some Movies For the Law Student," available at [http://faculty.law.lsu.edu/ccorcos/Student%20Services/What%20Else%20You%20Can%20Do%20With%20a%20Law%20Degree.htm#MOVIES FOR THE LAW STUDENT](http://faculty.law.lsu.edu/ccorcos/Student%20Services/What%20Else%20You%20Can%20Do%20With%20a%20Law%20Degree.htm#MOVIES%20FOR%20THE%20LAW%20STUDENT).
  23. *Id.* "25 Greatest Legal Movies" and "Honorable Mention." 25 top-ranked films, followed by 25 honorable mentions.
  24. This is not counting the musical "Chicago."
  25. Thomas Raymond Long, *A History of the American Courtroom Play*, (1966).
  26. Thus, there were references to the people's lawyer before Louis Brandeis, Louis Lefkowitz or Eliot Spitzer.
  27. Classic plays, like "The Frogs," "Volpone," and "Saint Joan," could be added as well.
  28. Opening off Broadway at approximately the same time as "The Originalist" was the play "Kunstler," about the radical defense attorney William Kunstler, who had close to the opposite ideology of Justice Scalia.
  29. Maxwell Anderson's "Winterset," from 1935, is based on the Sacco-Vanzetti case, but it is a crime drama rather than a legal drama.
  30. *The Mirror of Taste, and Dramatic Censor*, Vol. III, 228 (1811).
  31. See [http://ancient-literature.com/rome\\_seneca.html](http://ancient-literature.com/rome_seneca.html) <https://www.britannica.com/biography/Lucius-Annaeus-Seneca-Roman-philosopher-and-statesman> <https://www.farnamstreetblog.com/2015/08/the-wisdom-of-seneca-a-lawyers-advice-for-life-in-the-fast-lane/>.
  32. <http://www.iep.utm.edu/seneca/>.
  33. J.C. Lapp, "Marc Lescarbot and New France," 54 *Queen's Quarterly* 323 (1947).
  34. Betty Wright, "A Road Well Travelled," *Halifax Chronicle-Herald*, November 17, 2016; Jacqueline Warlow, "Something to Applaud; All the World's a Stage for Thriving Nova Scotia Theatre Scene," *Halifax Chronicle-Herald*, September 10, 2014.
  35. "Pierre Corneille: The Celebration at Rouen of His Tercentenary," *New York Tribune*, June 3, 1906.
  36. <https://www.britannica.com/biography/Pierre-Corneille>.
  37. More was the subject of "A Man for All Seasons."
  38. See Albert J. Geritzs and Amos Lee Laine, *John Rastell* (1983).
  39. See [https://www.ischool.utexas.edu/~rarebook/r\\_Rastell.html](https://www.ischool.utexas.edu/~rarebook/r_Rastell.html).
  40. <https://www.britannica.com/biography/Pierre-Carlet-de-Chamblain-de-Marivaux>; Michael Billington, "Move Over Moliere, Marivaux's Subversive Comedy Is up There with Mozart and Shakespeare, says Michael Billington," *Guardian*, April 28, 1999.
  41. See <http://www.theatrehistory.com/french/ Beaumarchais001.html>.
  42. Brian M. Morton, "Beaumarchais: Legal Expert," 39 *French Review*, 717 719, April 1, 1966.
  43. *Id.*
  44. See Gregory S. Brown, "After the Fall: The Chute of a Play, Droits d'Auteur, and Literary Property in the Old Regime," 22 *French Historical Studies*, 465 (1999).

45. George Halasz, "Beaumarchais Inaugurated Modern Royalty System" *New York Herald Tribune*, June 26, 1927.
46. See Frederick G. Ribble, "Fielding at the Bat: A Reappraisal," 110 *Studies in Philology*, 903 (2013).
47. Robert D. Hume, *Henry Fielding and The London Theatre 1728-37* (1988).
48. Alan D. Boyer, "Justice Fielding, the Novel, and the Law," 4 *Yale Journal of Law and the Humanities*, 187, 192 (1992).
49. *Id.* at 190.
50. *Id.* at 192.
51. See Howard H. Dunbar, *The Dramatic Career of Arthur Murphy* (1946); John Pike Emery, *Arthur Murphy* (1946); Victor M. Alper, *Arthur Murphy, Tragedian: A Critical Edition of "The Grecian Daughter"* (1973).
52. See "Biography of Richard Penn Smith," *Burton's Gentleman's Magazine and American Monthly Review* (1839); "Richard Penn Smith," *The Every Body's Album; A Humorous Collection of Tales, Quips, Quirks, Anecdotes, and Facetiae*, October 1, 1836.
53. Madeline Sapienza, *The Triumph of Modern Chivalry Over the Iron Crown: Hugh Henry Brackenridge and the Law in the Commonwealth of Pennsylvania* (1990).
54. James O'Toole, "Hugh Henry Brackenridge Our Founding Father," *Pittsburgh Post-Gazette*; Jan 2, 2000.
55. See generally *A Literary Autobiography of Mordecai Manuel Noah with an introduction by George Alexander Kohut* (1897). Another lawyer-playwright of the 19th century, Samuel Judah, was found guilty of criminal libel in his attacks on Noah.
56. "New Ghetto: First Presentation In English," *The American Israelite*, July 24, 1919.
57. See <http://jv.gilead.org.il/biblio/plays.html> (last viewed August 18, 2017).
58. Randolph N. Jonakait, "Law in the Plays of Elmer Rice," 19 *Law and Literature*, 401, 409 (2007).
59. Edgar J. Driscoll Jr., "Archibald MacLeish Is Dead at 89," *Boston Globe*, April 21, 1982.
60. "Doherty Play Praise Rises," *Toronto Globe and Star*, November 19, 1937.
61. Liza Mundy, "Ken Ludwig's Brief for the Stage," *Washington Post*, September 7, 1988. Other current lawyer-playwrights across the world whose plays have not reached Broadway include Wajhat Ali, Eleanor Wong (a vice-dean of the law faculty at the National University of Singapore), Bob Philp, Norman Shabel, Jalene Mack, and Uruguayan Andres Castillo. This list could also include lawyer and hockey great Ken Dryden, who co-wrote the play "Les Canadiens."

**Bennett Liebman is a Government Lawyer in Residence at the Government Law Center of Albany Law School. He previously served as the Deputy Secretary for Gaming and Racing in the Governor's Office and as executive director of the Government Law Center.**

# NYSBA's CLE On-Demand Bringing CLE to you... when and where you want it!

Select from hundreds of  
NYSBA CLE Video/Audio  
On-Demand Courses

[www.nysba.org/cleonline](http://www.nysba.org/cleonline)

Our online on-demand courses combine streaming video or audio with MP3 or MP4 download options that allow you to download the recorded program and complete your MCLE requirements on the go. Includes:

- Closed-captioning for your convenience.
- Downloadable course materials CLE accessible 24 hours a day, 7 days a week.
- Access CLE programs 24 hours a day, 7 days a week.



From the NYSBA Book Store >

# Counseling Content Providers in the Digital Age

*A Handbook for Lawyers*

For as long as there have been printing presses, there have been accusations of libel, invasion of privacy, intellectual property infringements and a variety of other torts. Now that much of the content reaching the public is distributed over the Internet, television (including cable and satellite), radio and film as well as in print, the field of pre-publication review has become more complicated and more important. ***Counseling Content Providers in the Digital Age*** provides an overview of the issues content reviewers face repeatedly.

***Counseling Content Providers in the Digital Age*** was written and edited by experienced media law attorneys from California and New York. This book is invaluable to anyone entering the field of pre-publication review as well as anyone responsible for vetting the content of their client's or their firm's Web site.

**Table of Contents:**

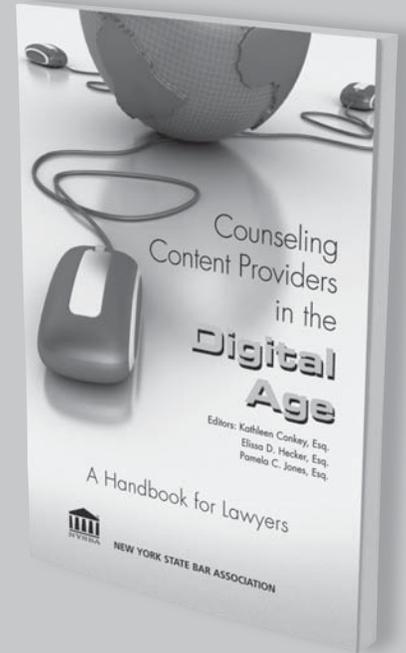
Introduction; Defamation; The Invasion of Privacy Torts; Right of Publicity; Other News-gathering Torts; Copyright Infringement; Trademark Infringement; Rights and Clearances; Errors and Omissions Insurance; Contracting with Minors; Television Standards and Practices; Reality Television Pranks and Sensitive Subject Matter; Miscellaneous Steps in Pre-Broadcast Review.

## Get the Information Edge

1.800.582.2452 [www.nysba.org/pubs](http://www.nysba.org/pubs)

Mention Code: PUB8860N

\*Discount valid through February 8, 2018



**EDITORS**

Kathleen Conkey, Esq.  
Elissa D. Hecker, Esq.  
Pamela C. Jones, Esq.

**PRODUCT INFO AND PRICES**

2010 / 480 pages, softbound  
PN: 4063 (Print)  
PN: 4063E (Downloadable PDF)

**\$55 NYSBA Members**  
**\$70 Nonmembers**

\$5.95 shipping and handling within the continental U.S. The cost for shipping and handling outside the continental U.S. will be based on destination and added to your order. Prices do not include applicable sales tax.



## There Was Once a Ballpark—Mourning the Dodgers, Meeting the Mets, William Shea, and the Rise and Fall of the Continental League

*From the Society for American Baseball Research Baseball Biography Project*

By David Krell

Brooklyn.

To its Cyclone rollercoaster-riding, Prospect Park-picnicking, egg cream-drinking denizens, the borough—a city until annexed by New York City on New Year's Day, 1898—is a cultural touchstone. It is where a guy named Nathan birthed a hot dog empire, gal twin cousins named Patty and Cathy got into teenage hijinks, and bank robbers named Sonny and Sal robbed a Chase Manhattan bank during a dog day afternoon in August. It is home to NYPD personnel in 2010s popular culture—the Reagans on *Blue Bloods*, the 99th precinct on *Brooklyn 99*, and corrupt cops Harlee Santos and Matt Wozniak on *Shades of Blue*.

It welcomed back Kotter, gave us Kramden, and took Kings County as its name. It cemented disco as the latest fad in *Saturday Night Fever*, a bridge bearing the borough's name as a lasting architectural achievement, and a baseball team as an eternal symbol of hope and heartbreak.

From its debut in 1883 to its departure in 1957, that team, the Brooklyn Dodgers, became, perhaps, Brooklyn's greatest icon. Synonymous with baseball, the Dodgers, just one of its many monikers, anchored the borough. No matter one's ethnic background, financial stature, or profession, a Brooklynite found baseball to be a common language. Ebbets Field, which entered baseball's lexicon in 1913, became a meeting place, a leisure outlet, and a second home for Dodgers fans. In 1950, the Dodgers found a new home in Los Angeles concurrently with its archrival squad, the New York Giants, who also moved West, to San Francisco. For four years thereafter, Major League Baseball had no National League team in New York City.

The New York Mets played their first game in 1962, using the Polo Grounds, left vacant by the Giants. With the colors of blue and orange as an homage to their National League predecessors, the Mets filled the gap—or tried to—created when the Dodgers and the Giants left for California. When the Mets inaugurated their new home on April 17, 1964, its moniker did not derive from a baseball insider at the executive, coaching, or managerial

level, nor was it from a former player, elected officeholder, or war hero. It was William Alfred Shea.

His was not a name known beyond the political, business, and legal fraternities of New York City and, by extension, other metropolises affecting his law firm's clients. However, without his affability, cunning, and legal acumen, the National League may have found itself without a franchise in the Big Apple—perhaps until the second half of the 1960s—to fill the emptiness, in hearts and on the sports pages, created by the departed Dodgers and Giants.

Described in his 1991 *New York Times* obituary as “a burly and affable man with a firm handshake for messengers and moguls alike,”<sup>1</sup> born in Manhattan in 1907, Shea, who was known as “Bill” to clients, colleagues, and friends—had a penchant for making deals, no ego, and a commitment to charitable endeavors, including the Brooklyn Public Library. He counted among his friends, clients, and acquaintances a roster of the nation's political elite—mayors, governors, senators, congressmen, vice presidents, and presidents, from John F. Kennedy to George H. W. Bush. Shea's business and political networking, affability, and cunning set the foundation for the creation of the Mets, who were initially owned by Joan Payson, a former New York Giants season ticketholder.

Filling the footprints left by the Dodgers and the Giants weighed on the shoulders of New York City Mayor Robert Wagner, who relied on Shea for counsel, leadership, and building consensus in a task that conventional wisdom earmarked as unlikely at best and impossible at worst. Shea's cohorts on the committee were Democratic politician James Farley, retail mogul Bernard Gimbel, and real estate executive Clint Blume. “We are in competition with other cities now but I can't see certain National League teams resisting an offer which includes 14,000,000 people within 35 miles,”<sup>2</sup> explained Shea.

Shea had Wagner's confidence, a rolodex of VIP contacts, and a title—Chairman of the Mayor's Baseball Committee of the City of New York; the position was unsalaried. When Wagner turned to Shea, he tapped into the civic duty that was a part of Shea's DNA. There was

nothing expected in the way of compensation, nor was any sought.

Shea's grandson Scott explains:

This was social impact investing. I don't think he was compensated for the work he did for the commission, plus he took time off from his law firm and his clients, and personal responsibilities and obligations. Mrs. Payson did not purchase the franchise as a money-making endeavor, she had plenty, for sure. They felt it was for the greater good for the City of New York and baseball. With regard to New York, apparently, he came to the revelation that if New York did not have as many unifying factors as possible—mostly in sports—that the social fabric of New York, given its diversity, would unravel. For what it is worth, he is partly responsible for the New York Islanders, the Brooklyn Nets, the Nassau Coliseum, the New York Titans/Jets, the original annual AFL-NFL football games, which I am pretty sure morphed into the Super Bowl, and the AFL-NFL merger.<sup>3</sup>

With Milton Gould, a litigator beyond compare, with whom he had been classmates at George Washington High School in Manhattan's Washington Heights neighborhood, Shea began the law firm Shea, Gallop, Klemenko & Gould in 1964, the debut year of Shea Stadium, by merging his firm's with Gould's.

Name changes for the next decade and a half resulted in the streamlined moniker Shea & Gould. Neighbors in Sands Point, Long Island, the two partners—often referred to as Blarney and Chutzpah—drove into Manhattan together every day.<sup>4</sup> The firm's DNA contained Shea's powerful counsel in politics, sports, and business, combined with Gould's unparalleled litigation prowess.

With a "What can we do for you?" approach, rather than a slick sales pitch declaring the firm's business and political connections, track record, and client list, Shea and Gould were competitive with their brethren boasting deeper pockets, further reaches in business and politics, and richer history. Client service was the cornerstone—work for a client because one has something to offer, not merely to enhance the firm's coffers.

"Jews, Greeks, and Catholics were not invited to work at the Wall Street firms," explains Thomas Constance, one of the last managing partners of Shea & Gould, a Shea protégé, and chairman of the law firm Kramer Levin.

But those firms didn't do trials, mostly negligence, bankruptcy, and corporate law. Gould's firm was comprised

of litigators. Shea's firm was an Irish Catholic firm with some Jews—Manning Hollinger & Shea, which practiced in the areas of corporate law, banking, and tax. They decided to create a firm based upon a melting pot, which became Shea Gallop Climenko & Gould.

Find something that's important to the client so that he can trust you. Do everything. If he needs a doctor, find him a doctor. Always be available. One day, I got a call from the general counsel of Fuqua Industries. We had played together in a corporate softball league. He said, 'My law firm is too busy to see me. Do you think you can come up to the suite at the Regency to talk about a bond offering with Lehman Brothers?' This was in the late 1970s. He suggested that I get Shea or Gould to come. Bill said, 'I'll be ready in 10 minutes. Let's go down and see Milton.' When we got to Milton's office, Bill said, 'Milton, we're taking Tommy over to the Regency. We're going to meet Fuqua. Whatever they were doing, they stopped. When we got in the car, Bill charmed the general counsel and Fuqua became a blue chip client.'<sup>5</sup>

Decades before corporate America affirmed mentor-mentee programs, leadership lectures, and executive training as building blocks for the next generation of management, Shea's firm's power structure tutored its underlings informally. Shea emphasized this in his law practice—investing time in a younger lawyer's matter was an opportunity to instruct and, consequently, assure that the firm maintained an approach centered on client service.

Shea and Gould built their firm to be one of the nation's most powerful before closing its doors in 1994, following Shea's death in 1991 and, subsequently, Gould's retirement. Though he became an icon in New York City's legal, charitable, and sports communities, Shea had a background steeped in modesty, which contrasted the power broker image bestowed upon him.

"He was born at home in an apartment at 526 West 151st Street, between Broadway and Amsterdam in the Sugar Hill neighborhood of the island of Manhattan, to his 24-year-old father and his 22-year-old mother in June of 1907. His younger sister moved to Los Angeles with his mother and performed in silent movies to pay for him to go to Georgetown University and Georgetown Law School during the Depression; he graduated in 1931. I think his class had seven people in it! After law school, he returned to New York, and because he had the law degree, when so few did, he was a scarce commodity," describes Scott Shea. "One of the first groups he worked

with was the Brooklyn Trust Company (and George McLaughlin, president), the bank that then owned a portion of the Brooklyn Dodgers; I think having foreclosed on a portion during the Depression. The legend goes that Mr. McLaughlin asked my grandfather and Walter O'Malley if they wanted to take over the interests, and my grandfather declined, declaring that Mr. O'Malley would be a better person to take it over."<sup>6</sup>

When Shea devoted his energy to Wagner's baseball fiat, he was 51 years old, married, and the father of three children between the ages of seven and 18. His *curriculum vitae* included:

- Appointed as counsel to the Liquidation Bureau of the State Banking Department in 1934,
- Attorney of record for New York Title and Mortgage Company in 1935,
- Trustee of the Brooklyn Public Library in 1954, appointed by Mayor Wagner, and
- Member of the New York State Insurance Board in 1956, appointed by New York Governor Averell Harriman.

Mayor Wagner knew of Shea from the library appointment, in addition to a 1957 effort by McLaughlin and Payson to purchase the Giants from Horace Stoneham and keep the princes of the Polo Grounds in New York; McLaughlin had hired Shea to represent him.

Major League Baseball Commissioner Ford Frick advised the committee that a team and a stadium were the paramount responsibilities of the committee. Frick's ante—declaring New York City “open territory” for a new team; the National League, of course, wanted this paradigm while the American League was “split on the matter.” Shea said: “We intend to work on the site and team simultaneously, for these go together.”<sup>7</sup> Ebbets Field was a contender for the site,<sup>8</sup> as was the Polo Grounds.<sup>9</sup>

On January 31, 1958, Mayor Wagner placed the burden on baseball's decision makers regarding a new team in the Big Apple: “The commitment is here as far as the city is concerned. Now it's up to the National League.”<sup>10</sup> If the league planted a team in Wagner's metropolis, a new stadium would be constructed by 1960.<sup>11</sup> There was a feeling that Flushing Meadows would be the place for a new ballpark.<sup>12</sup> Robert Moses, the city's most powerful political operative at the time, had offered Dodgers owner Walter O'Malley the site as a condition for keeping the Dodgers in the New York City metropolitan area. O'Malley rejected it in favor of building a stadium in Chavez Ravine, approximately 3,000 miles westward.

An alternative existed in Jersey City—Roosevelt Stadium, built as a WPA project in the 1930s. It had “ample parking space [and] could be substantially enlarged at comparatively small cost.”<sup>13</sup> Plus, the Dodgers had

played 15 games there in 1956 and 1957, so it qualified as a Major League Baseball possibility.

Shea's mission took a leap forward on July 7th—a formal bid to plant a National League team in New York City: stadium seating 52,000 and costing approximately \$12,000,000.<sup>14</sup> National League president Warren Giles offered Flushing Meadows in Queens as a prospective location.<sup>15</sup>

The Philadelphia Phillies turned away overtures to move;<sup>16</sup> the Cincinnati Reds rejected the possibility because of inadequate parking at Crosley Field;<sup>17</sup> and Milwaukee Braves owner Lou Perini considered jettisoning the team, which he moved from Boston in 1953, to establish a new team in New York—or so went the rumor.<sup>18</sup> All turned down Shea's overtures.

New York City's prospects for a National League franchise seemed dim. Shea, an inventive lawyer who saw that a solution resides in every problem, led a new approach—create a third league, the Continental League. “An eight-team league was formed on paper. Branch Rickey was made its president, but Shea was its work-horse,” explained sports writer Leonard Koppett. “People with money were found to back clubs. Polite discussions (on the surface) explored how a third league could get started and gradually be absorbed into the established baseball structure. For the existing teams, this strategy was largely a holding action, a delaying tactic; the pushy newcomers would get discouraged and go away.”<sup>19</sup>

Such was not the case.

Toots Shor's, a legendary midtown Manhattan watering hole for sports and entertainment folks, provided the backdrop for Shea's announcement on November 13<sup>th</sup>. Teams in this new structure would be based in: New York City, Dallas-Fort Worth, Houston, Toronto, Denver, Miami, Minneapolis-St. Paul, and Detroit.

In addition, “several cities on the West Coast” presented opportunities.<sup>20</sup> There was support, apparently, from the National League's inner sanctum. “About ten days ago, I received a visit from an important National League executive, whose name I cannot divulge. He assured me that if New York were willing to lead the way in the formation of a third major league, he could put me in touch with people who are eager and financially able to promote big league baseball in at least seven other cities,”<sup>21</sup> explained Shea.

A question remained: Would the duopoly of the American League and the National League expand, or would this new structure be independent, with no support from Major League Baseball? Shea, ever the pragmatist, showed bluntness rather than bluff: “We hope to work with organized baseball, but, if we must go outside the realm of organized ball, we are prepared to do that too.”<sup>22</sup>

Shea's statement contrasted the public version, which had Frick, National League president Warren Giles, and American League president Will Harridge against expansion or an independent league.<sup>23</sup> Players, too, stood in its path. If either expansion or a third league emerged, then the players would work in a new paradigm, provided that the owners agreed. J. Norman Lewis, the attorney for the players, warned that if Shea "is looking to incite the players to jump, I think he is barking up the wrong tree."<sup>24</sup> Frick opined that players could sacrifice pension benefits if a third league drained the American League and National League rosters.<sup>25</sup> Reserve clauses in players' contracts also presented an obstacle.

Rickey's gravitas lent an elder statesman quality to analyzing the dilemmas, solutions, and consequences posed by a third league. Most evident with signing Jackie Robinson to the Brooklyn Dodgers in 1945 and, thereby, breaking the informal—though formidable—racial barrier existing since the 1880s, Rickey's accomplishments as a general manager garnered immediate respect, including four World Series championships with the St. Louis Cardinals. He also signed several players who became highly significant factors for the 1960 World Series champion Pittsburgh Pirates.

To the casual observer, it might have seemed odd that a man in his late 70s would take on the responsibility of shepherding a new baseball league. However, anyone who knew Branch Rickey would think it odd if he did not. Rickey, after all, was a baseball man. This new venture not only provided a challenge, but also filled a void in professional baseball—at least, that's how Rickey, Shea, Wagner, and their colleagues saw it. They received a boost when Frick and the owners okayed the venture, a decision based on independence rather than expansion. "I firmly believe we will have a third league within five years,"<sup>26</sup> stated Frick. The paradigm of possible cities changed to: New York, Buffalo, New Orleans, Dallas-Fort Worth, Minneapolis-St. Paul, Seattle, Mexico City, Montreal, and Toronto.<sup>27</sup>

To qualify, the franchises needed ballparks with a minimum capacity of 25,000, a schedule of 154 games, terms of Major League Baseball agreements, including minimum salary agreement, and a players' pension plan.<sup>28</sup> Shea addressed the stadium requirement as a non-issue: "Some are already built, others are under construction. Some present stadiums are being enlarged. You have to figure about 18 months for the construction of a stadium, and if we got stuck we have other facilities available on a temporary basis."<sup>29</sup>

*New York Times* scribe Arthur Daley preached, in bit of prescience, that Major League Baseball offered, in fact, nothing to the third league. Despite the "enthusiasm and acknowledged abilities of Bill Shea and his New York committee,"<sup>30</sup> Daley believed the idea would—or should—give way to expanding the American League

and National League with two teams apiece, which is what ultimately happened:

- 1961 American League expansion
  - Los Angeles Angels (later California Angels, Anaheim Angels, and Los Angeles Angels of Anaheim)
  - Washington Senators (second major league team with the Senators name)
- 1962 National League expansion
  - New York Mets
  - Houston Colt .45s (later Houston Astros)

Daley's rationale was sound: there was no mechanism for obtaining players, a New York team would have difficulty creating loyalty, and minor league players who jumped ship for the new league would not offer comparable value to fans wishing to see major leaguers.<sup>31</sup>

Joan Payson wanted a seat at the table of ownership, having seen her beloved Giants voyage to San Francisco; a part owner of the team, Payson had voted against the move. It was a boon, certainly, to get an owner with passion as deep as her pockets. Payson, who also had financial interests in horse racing, gave a bridge to nostalgia for fans still teary-eyed from the evaporation of National League fixtures. Shea, in addition, remained positive, brushing back the diatribes from Daley and others criticizing the pool of players. "Take a good Triple A player and put a major league uniform on him and he'll play like a major leaguer,"<sup>32</sup> declared Shea.

On June 18th, Shea held another news conference to outline the financial costs and, once again, set 1961 as the league's inaugural year. The price tag for the new league was \$100,000,000 and the price tag for the New York franchise was \$4,500,000.

New York was the fulcrum upon which the rest of the league balanced; whether it would consist of eight or 10 teams was not yet decided. Finances, like stadiums, did not pose a formidable challenge, according to Shea, who emphasized dedication over dollars: "The syndicates of each city in the new league will be as financially sound as ours. "The backers of the various franchises are not interested in making money from baseball. They are interested only in the future of the game. When the New York syndicate meets with Frick we will inform him that all the cities are set and that stadiums are being prepared."<sup>33</sup> By the end of July, the Continental League had five definite cities, with three more yet to be announced, and included: New York, Houston, Toronto, Denver, and Minneapolis-St. Paul.<sup>34</sup>

Senator Estes Kefauver, the Democratic vice presidential running mate of Adlai Stevenson in 1956, held promise for the Continental League by proposing a bill capping a team's ability to keep players at 100 and allowing for

60 of them to be available in an “unrestricted draft” and creating a territorial perimeter for a team maxing at a 35-mile radius.<sup>35</sup> Kefauver’s bill would have propelled the Continental League forward, but it did not get off the ground. Frick testified before the Senate antitrust committee, underscoring his belief of adding a new league to the ranks of professional baseball, but signaling that Capitol Hill’s involvement could impede its path.

In its report, the *Washington Post* stated that the cap on the number of players reserved by a Major League Baseball team would be 80. The American and National Leagues had their thumbs on the scale, in evidence through Kefauver’s questioning regarding the source of the new league’s players. If the Majors refused to release players from contracts and, in turn, the Continental League from filling rosters, then a faceoff would occur, with the last resort being a raid on Major League Baseball teams. This had happened before with the short-lived Federal League in the 1910s.<sup>36</sup> Frick appeared willing to work with Shea, Rickey, and the new league’s franchises, as long as they became part of Major League Baseball and not an independent entity. In this template, Frick offered draft rights, rights of waivers, rights to trade and purchase contracts, and rights to agreements with minor league clubs.<sup>37</sup>

The Warwick Hotel, an elegant establishment that served as Cary Grant’s New York City residence for several years,<sup>38</sup> became the center of the universe on August 18, 1959 for baseball fans curious about the prospect, viability, and plans of a third league. A summit of sorts took place with leaders from Major League Baseball and the Continental League conferring about vital issues, including schedules, stadiums, and player contracts.<sup>39</sup> Shea underscored the logic for Rickey’s Continental League presidency, noting “ability in the baseball field, dignity, respect by baseball people, forward-looking attitude, and pioneer background.”<sup>40</sup> By September, Frick revealed his thoughts about the Continental League’s ability to compete with the talent in the Majors that would not happen for possibly five years.<sup>41</sup>

A little more than a week after Frick’s pronouncement, Rickey promoted the Continental League on “What’s My Line?”, a CBS game show requiring four panelists to deduce a person’s “line”—slang for occupation—through a series of “yes or no” questions; when the person was a celebrity, the panelists wore blindfolds to prevent immediate recognition. After Arlene Francis figured Rickey’s identity—with an assist from Chuck Connors, star of “The Rifleman” and a former player signed by Rickey in the Dodgers organization—Bennett Cerf, one of the founders of publisher Random House, inquired about the third league. “Inevitable as tomorrow morning,”<sup>42</sup> responded Rickey.

Cities awaited the green light for becoming a Major League city. As the Continental League moved forward, for example, Honolulu was rejected in the eight-team for-

mat, but it was told that an expansion to 10 or more teams would trigger another look. Though Shea offered no reason here, the Associated Press speculated that the rejection “undoubtedly involved the distance and expense.”<sup>43</sup>

While Richard Nixon and John F. Kennedy campaigned to be the 35th President of the United States, the power structure of the Continental League faced a threat—or, at the very least, a distraction—when the National and American Leagues planned to expand by adding two teams apiece, making each a 10-team operation. At this point, the Continental League’s cities were New York, Houston, Buffalo, Atlanta, Dallas-Fort Worth, Minneapolis-St. Paul, and Toronto.<sup>44</sup>

Rickey opposed a merger—it was a third league or bust.<sup>45</sup> Working around the clock to fortify the Continental League’s “major league status,” Shea revealed: “I can tell you this much. We have no thought of disbanding. We’re trying to break our necks to satisfy every possible demand made of us by the majors in the hope of obtaining recognition from organized baseball as a valid third major league.”<sup>46</sup> Further, he dismissed the idea of the New York franchise abandoning its “moral obligation” for a National League slot. There would also be a financial penalty, “almost as much as it would cost to buy a league franchise.”<sup>47</sup>

While Bert Parks cavorted as Harold Hill in “The Music Man” at the Majestic Theatre, Dean Martin and Judy Holliday graced movie screens in the romantic comedy “Bells Are Ringing,” and Nixon battled Kennedy, New Yorkers found that the Continental League took another turn. At a summit in Chicago, on August 2, 1960, Dodgers owner Walter O’Malley created the gateway to compromise by offering to absorb four Continental League cities—two for the American League and two for the National League.<sup>48</sup> Reversing course, the Continental League morphed into this expansion plan. The demise of a third league could not be considered, in any way, a failure. Shea and Rickey had shaken the bedrock of Major League Baseball.

Shea, in particular, spun the situation as a victory, which it was. “My principal mission from the start has been to assure New York of having every-day baseball again. Today’s action gives us assurance and makes it more urgent than ever for the city to proceed with the construction of the new stadium in Flushing Meadow,”<sup>49</sup> he stated.

Dick Young of the *New York Daily News* called it “a momentous compromise”<sup>50</sup> and declared that “Mayor Wagner should pin a medal on him on the steps of City Hall.”<sup>51</sup> Jimmy Cannon of the *New York Journal-American* praised Shea’s immobility against the status quo embraced by team owners:

They’re afraid of Senators and Representatives and they buckle any time one of

them threatens to compose a law which will limit their operations which are immune from anti-trust regulations.

That's how Shea got to them. They tried to duck him and they presented him with reasons why his unpopulated league couldn't do it. There were instances when they proposed deals they realized he couldn't accept. They couldn't con him.<sup>52</sup>

It was the culmination of a byzantine series of maneuvers relying on Shea's ability to persuade, cajole, and execute. He sought no reward, financial or honorific—it was a civic obligation that fueled Shea. "He considered himself blessed by the life the city had provided him and saw bringing the National League back to New York City as a cause because he considered it the best city in the country, and as such, it should have a National League baseball team," revealed Scott Shea.

I often wonder how the hell he pulled this off. There were so many headwinds. How do you have the grit to stand in the face of them and not give up? There were millionaires, politicians, and power brokers in New York City and across the country who said it couldn't happen, that it would not happen. The personal sacrifice was enormous. The professional sacrifice was, and would have continued to be, enormous had he failed. Nobody asked him to give so much. He just did it. Similar to his randomly giving Mets tickets to religious charities supporting underprivileged, homeless and orphaned children together with five dollars per ticket so that the children could buy hot dogs, Cracker Jacks and a soda—to which the chaperones would object on a health basis. He would tell the folks running the organizations that if they did not permit the children to have hot dogs, Cracker Jacks and soda—the complete game experience—he would find out, and then he would not give any more tickets. Although I am sure this, too, was a bluff.<sup>53</sup>

In 1961, the American League introduced the Los Angeles Angels and the second incarnation of the Washington Senators. In 1962, the National League introduced the New York Mets and the Houston Astros.

For their first two years, the Mets played in the Polo Grounds while engineers, architects, and laborers built their new home in Queens, which was supposed to be Flushing Meadow Municipal Stadium. Staten Island Borough President Albert Maniscalco spearheaded the dubbing of the Mets' new stadium, without Shea's knowledge. "Shea negotiated with the city council to create a

stadium. He got creative with municipal bonding and the banks. Albie was chairman of the city council. He told me that they wanted Shea to appear before the council. Shea was in Queens having lunch. Albie called the police and told them to send a car and bring him to City Hall. Shea had no idea what was going on. Then, Albie moved to name the stadium after him,"<sup>54</sup> revealed Constance.

Debuting in 1964 and demolished after the 2008 season, William A. Shea Municipal Stadium exists in photographs, film and video, and memories; Citi Field replaced it in 2009. Appropriately, Shea christened the ballpark bearing his name by throwing out the first ball at the inaugural game—a 4-3 loss to the Pirates. Honoring the National League's past, the Mets bore the colors of their predecessors—blue for Dodgers, orange for Giants. The year after his death, his wife, May Nori Shea, threw out the first pitch of the 1992 season. In 2008, the stadium's final year, his son, Bill Shea, Jr., threw out the season's first pitch and two of Shea's grandsons threw out the first pitches of the season's penultimate game.

Shea's leadership sculpted expansion that went beyond tamping the tears shed for the transplanting of the Dodgers and Giants to the West Coast. Houston escalated from a minor league metropolis rooting for the Buffaloes, a team with a lineage dating back to the 1880s. Fast becoming part of the national conversation because of America's Space Race with the Russians—which began when the communists launched the Sputnik satellite in 1957—Houston's status as the headquarters for NASA complemented a newfound foothold in the Major Leagues with the Colt .45s, a National League team moniker reflecting Texas lore, legend, and history concerning gunslingers, cowboys, and sheriffs.

Washington lost the Senators to the Land of 10,000 Lakes after the 1960 season; the team became the Minnesota Twins. Expansion, in turn, created a new Washington Senators team for the American League; in addition to the Los Angeles Angels. Washington lost this incarnation after the 1971 season—the team went to the Lone Star State and became the Texas Rangers.

While the label "power broker" is attached to Shea, it conjures up an image of smoke-filled rooms, feet propped on a desk while making phone calls, and manipulation of egos. In the end, the "power broker" gains a boon—financial, favors, reputation, additional power. Such was not the case with Shea. To him, the Continental League—and, in turn, expansion—was a matter of civic pride. Period.

Building upon the foundation set by Shea and Rickey, who were prescient in their selection of locations for Continental League franchises, Major League Baseball expanded further. In 1969, it added the San Diego Padres, the Montreal Expos (now the Washington Nationals), the Kansas City Royals, and Seattle Pilots (now the Milwaukee Brewers). In 1977, the Toronto Blue Jays and Seattle Mariners were created. 1993 brought Colorado Rockies

and Florida Marlins (now the Miami Marlins). In 1998, the Arizona Diamondbacks and Tampa Bay Devil Rays (now the Tampa Bay Rays) were created.

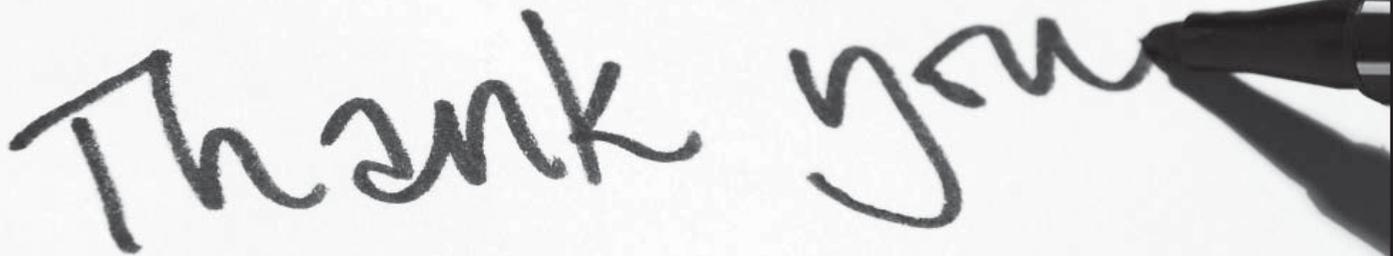
There is no statue at Citi Field honoring the man who neither sought nor received tangible benefits from fulfilling a mayoral mission to bring National League baseball to a city reeling from the loss of two baseball institutions. Shea is a member of the Mets Hall of Fame; the team retired his name, an honor not bestowed upon any other member of the baseball community.

At every Mets home game, thousands of fans traverse an area named Shea Bridge, just behind the grandstands between right field and center field. It is doubtful that many of them know about the man responsible for their beloved team's birth.

## Endnotes

1. David Margolick, *William A. Shea, 84, Dies; the Lawyer Behind the Mets*, N.Y. TIMES, October 4, 1991.
2. Harold Rosenthal, *Mayor's Group Says N.Y. Must Make Bid*, N.Y. HERALD TRIBUNE, December 11, 1957.
3. Telephone interview with Scott Shea, April 28, 2017.
4. *Id.*
5. Interview with Thomas Constance, February 24, 2017.
6. Telephone interview with Scott Shea, April 25, 2017.
7. Harold Rosenthal, *NY Open to New Club, Frick Assures*, N.Y. HERALD TRIBUNE, December 17, 1957.
8. *New York Still Hopes*, N.Y. TIMES, January 15, 1958.
9. *Mayor's Group Plans Talk With N.L. Club Owners*, N.Y. HERALD TRIBUNE, December 29, 1957.
10. Tommy Holmes, *Fails to Say What Rent It Must Pay: Baseball Circles Skeptical of Plan*, N.Y. HERALD TRIBUNE, February 1, 1958.
11. *Id.*
12. *Id.*
13. *Id.*
14. Tommy Holmes, *Wagner Proposes 52,000-Seat Park*, N.Y. HERALD TRIBUNE, July 8, 1958.
15. *Id.*
16. Roscoe McGowen, *Mayor Says His Baseball Aide Talked to Phils About Shift Here*, N.Y. TIMES, April 16, 1959.
17. *Id.*
18. *Wagner Proposes 52,000-Seat Park*, *supra* note 140.
19. Leonard Koppett, *The New York Mets: The Whole Story* (London, England: The Macmillan Company, 1970 ) 20.
20. Tommy Holmes, *N.Y. Opens Drive for 3d Major League*, N.Y. HERALD TRIBUNE, November 14, 1958.
21. *Id.*
22. *Id.*
23. *Players' Lawyer Says They'll Boycott 'Renegade' League*, N.Y. HERALD TRIBUNE, November 15, 1958.
24. *Id.*
25. *Id.*
26. *Majors Invite a Third League; City Preparing Baseball Team*, Associated Press, N.Y. TIMES, May 22, 1959.
27. *Id.*
28. *Id.*
29. *'61 Target Date for N.Y. Debut in 3d League of 8 or 10 Cities*, N.Y. HERALD TRIBUNE, May 23, 1959.
30. Arthur Daley, *Sports of the Times: Trojan Horse*, N.Y. TIMES, May 26, 1959.
31. *Id.*
32. Howard M. Tuckner, *Mrs. Payson in Group Seeking 2d Team Here*, N.Y. TIMES, June 10, 1959.
33. Howard M. Tuckner, *New League to Spend \$100,000,000*, N.Y. TIMES, June 19, 1959.
34. *Five Cities Form Third Major League*, Associated Press, WASHINGTON POST, July 28, 1959.
35. Lee Lowenfish, *Branch Rickey: Baseball's Ferocious Gentleman*, (Lincoln & London: University of Nebraska Press, 2007) 568.
36. Dave Brady, *Frick Assures Senate Committee Third League 'Will Be Reality'*, WASHINGTON POST, July 30, 1959.
37. *Id.*
38. *Historic Luxury Hotel in New York City*, <http://warwickhotels.com/new-york/>.
39. Harold Rosenthal, *Baseball Okays 3d League; Rickey Boss*, N.Y. HERALD TRIBUNE, August 19, 1959.
40. *Id.*
41. Whitney Shoemaker, *Third League Won't Rate With Others*, WASHINGTON POST, September 5, 1959.
42. *What's My Line?*, CBS, September 13, 1959.
43. *New League Rejects Bid of Honolulu*, Associated Press, WASHINGTON POST, October 10, 1959.
44. Howard M. Tuckner, *Continental Loop Opposes a Merger*, N.Y. TIMES, July 20, 1960.
45. *Id.*
46. Howard M. Tuckner, *Shea and Rickey To Move Forward*, N.Y. TIMES, July 21, 1960.
47. *Id.*
48. Michael Shapiro, *Bottom of the Ninth: Branch Rickey, Casey Stengel, and the Daring Scheme to Save Baseball from Itself* (New York: Henry Holt and Company, 2009) 213.
49. Joseph M. Sheehan, *Baseball to Add 4 Cities in Majors*, N.Y. TIMES, August 3, 1960.
50. Dick Young, *CL Dead; Big Leagues to Add 4 Clubs*, NEW YORK DAILY NEWS, August 3, 1960.
51. Dick Young, *Young Ideas*, NEW YORK DAILY NEWS, August 4, 1960.
52. Jimmy Cannon, *Sports Today: Expansion*, New York Journal-American, August 3, 1960.
53. Telephone interview with Scott Shea, April 28, 2017.
54. Interview with Thomas Constance.

**David Krell is the author of the book *Our Bums: The Brooklyn Dodgers in History, Memory and Popular Culture*. He is also the co-editor of the NYSBA book *In the Arena*. David is a member of the bar in New York. He is also admitted in New Jersey and Pennsylvania.**



Thank you

*As a New York State Bar Association member you recognize  
the value and relevance of NYSBA membership.*

*For that, we say thank you.*

Your commitment as members has made NYSBA the largest voluntary state bar association in the country. You keep us vibrant and help make us a strong, effective voice for the profession.

Sharon Stern Gerstman  
*President*

Pamela McDevitt  
*Executive Director*



# The Entertainment, Arts and Sports Law Section Welcomes New Members

Laura J. Akscin Foord	Anna Cui	Keith Haymes	Jolevette Mitchell	Nicholas Jacob Schmitt
Cody Alongi	Avani Sanjay Dalal	Bethany Marie Haynes	Travis J. Mock	Daniel E. Schnapp
Marshall Amores	Natasia Iris DaSilva	Ashley Nicole Higginson	Britney R. Monroe	Ms. Nina M. Sedlacek
Chisom Charlene Ananaba	Emily Davis	Joseph Hoffman	Marvin Orville Morris	Sacha-Aviva Sellam
Hannah Andrade	Tara Uzra Dawood	Sarah Honan	Tyreke Moses	Jose Miguel Sevilla
Nkosi Archibald	Edward James Degnan	Lisa Iraci	Linda Mule	Christopher Shur
Aaron Arias	Alphonsus A. Delgra	Kulani A. Jalata	Connor Murphy	Julia Singer
Yvette Armstrong	Selin Demir	Raymond K. Javdan	Cody T. Nastasia	Jordan Sean Slavens
Matthew D. Asbell	Kristina M. DiMaggio	Chongho Jeon	James H. Neale	Brian Scott Sommer
Remy Asper	Celeste Dufournier	Allison L. Job	Barry H. Nemmers	Juliana Spano
Jonathan Aubin	Terrence L. Dugan	Akinyele Jordan	Morton Newburgh	Brian D. Spector
Jeremy P Auster	Dr. Jennifer Durenberger	Allen G. Kadish	Samuel Newman	Montene Speight
Charles E. Austin	Sami El-Kebbi	Rakhil Kalantarova	Jennifer Newman Sharpe	Daria Spieler
Elias M. Aydin	Andrew Allen Elman	Adam Karman	Christine M. Newton	Joseph Brandon Spinelli
Morgan Backenstoss	Kayla Epstein	David Gary Katzman	Christopher J. Norton	Raleigh Stamper
Katerina I. Barquet	Daniel Jordan Esannason	Despina Keegan	Donald Richard Nottingham	Jenae E. Steele
Oscar Basantes	Sarah Fabian	Madison Kelley	Olisa Nwokedi	Katherine Mara Ainlay Steiner
Sabrina Bazelais	Jana Slavina Farmer	Leisl B. Kerechek	Megan O'Keefe	Mark A. Sternberg
Husain Bazzi	Isolina L. Fattore	Anjee Khurana	Michael G. Oliver	Alexander Stolls
Alexandra Bear	Diana A. Felipe	Dae Hoon Kim	Douglas Panero	Katherine Subasic
Anabela Bello	Kaitlin Eleanor Fox	Adam S. King	Andrew Pawenski	Molly Ann Sullivan
Jack Berry	Alexander P. Fraser	Jace King	Genevieve Elizabeth Perez	Nathaniel Sundel
Pushpa Urmila Bhat	Mark S. Frey	Jesse Kitnick	Nicole Christine Phillips	Karen Wolfgang Swanson
Shakira Bolden	Monica Friar	Eric Klein	Samantha Pittel	Brandon Taylor
Jeanine Botwe	Sarah Fucci	Jacob Alexander Kline	Samantha Lynn Plesser	Angelique Barbara Thomas
Marco Branco	Lorraine Kay Galvis	Aryian Kohandel-Shirazi	Rodalton J. Poole	Matthew Thumser
Adam Brocklehurst	Kristin Gabrielle Garris	Jordi I. Kushner	Daniel M. Posener	Rocco Anthony Totino
Barbara Bruni	Kelly Garrison	Kait Laurie	Colman H. Preziosi	Laura Escalona Trumbull
Sara Buchholz	Kenneth Daniel Garvey	Jun Ho Lee	Stephanie Pryor	Lillian Trunnell
Molly Burke	Charity Gates	Philipp Lengeling	Colby Elizabeth Redmond	Lindsey E. Utrata
Mitchell Caceres	Lauren Gershoni	Matthew R. Lerch	Thomas Reichard	Payoshni Vakil
Amanda Calamito	Jeremy Gerstenhaber	Yan Liang	Rita Resende Soares	Hunter Anthony Vanaria
Golda Genevieve Salazar Calonge	Tiffany A. Ghicas	Ryan William Lifland	Zachary T. Richards	Thomas Joseph Vega-Byrnes
Thomas A. Canova	George Thomas Gilbert	Elladia Lopez	Luciana Rivera	Alyssa Ailleo Wade
Nicolas Mabale Caraquel	Kristina Gliklad	Yixian Lu	Olivia Robertson	Ahkianne Wanliss
Mitchel Ryan Carbullido	Seth M. Goldstein	Haoran Ma	Pamela R. Rockmore	David M. Webster
Emily Chisholm	Fredric Bruce Goodman	Hon Kei William Mak	Donovan A. Rodriques	Brooke Samantha Weinberg
Min Kyung Michelle Cho	Nicole Gould	Gabriella Manganiello	Jordan Roy	Sabrina J. Weiss
Michelle Young-eun Choe	William E. Gould	Michael Marchese	Eitan Rudansky	B. Chaundry Wilson
Blair Christian	Edward R. Grauer	Kristin Markarian	Erica Ruff	Lily Wisset
Mariam Chubinidzhe	Daniel S. Greene	Martin Marquez, Jr.	Gregory J. Ryan	Kate Wollman
Amanda K. Cipriano	Daniel Gregorio	Erika Maurice	Adam Luis Santiago	Caroline Womack
Megan Clifford	Matthew Grosbard	James McRean	Richard Sanvenero, Jr.	Theresa Worrell
Sean P. Constable	Logan Grossman	Amber Melville-Brown	Jerome D. Schad	Brandon Ross Yankowitz
Nyall John Cook	Nicole Groysman	Ashlye Meyer	Marja Christi Scheuring-Elbert	Elektra Bianca Blue Yao
Angela Cooper	Mia Guttmann	Rebecca Meyer	Stefan G. Schick	John Zakour
Brian M. Cooper	Sarah Hale	Vincent Roy Healey Milburn	Sarah R. Schmidt	Szyuan Shannon Zhu
Bridget Anne Crawford	Thomas H. Hanna, Jr.	Dylan Miller		
	Shannon Marie Harvey-Fung	Elise Miner		

# Section Committees and Chairpersons

The Entertainment, Arts and Sports Law Section encourages members to participate in its programs and to contact the Section Officers or the Committee Chairs or Co-Chairs for further information.

## Alternative Dispute Resolution

Peter V. Arcese  
11 Broadway, Suite 615  
New York, NY 10004  
peter@pvacounsel.com

Judith B. Prowda  
Sotheby's Institute of Art  
570 Lexington Avenue  
New York, NY 10022  
judith.prowda@gmail.com

## Copyright and Trademark

Donna E. Froscio  
Dunnington Bartholow & Miller LLP  
250 Park Avenue  
New York, NY 10177  
dfroscio@dunnington.com

Teresa Lee  
Pryor Cashman LLP  
7 Times Square  
New York, NY 10036-6569  
tlee@pryorcashman.com

## Digital Media

Sarah Margaret Robertson  
Dorsey & Whitney LLP  
51 West 52nd Street  
New York, NY 10019  
robertson.sarah@dorsey.com

Andrew Howard Seiden  
Curtis, Mallet-Prevost, Colt  
& Mosle LLP  
101 Park Avenue, Suite 3500  
New York, NY 10178-0061  
aseiden@curtis.com

Szyuan Shannon Zhu, Esq.  
Bank of China  
1045 Avenue of the Americas  
New York, NY 10018  
szhu@bocusa.com

## Diversity

Anne S. Atkinson  
Pryor Cashman LLP  
7 Times Square  
New York, NY 10036-6569  
aatkinson@pryorcashman.com

## Diversity (continued)

Cheryl L. Davis  
Menaker & Herrmann LLP  
10 East 40th Street, 43rd Floor  
New York, NY 10016  
cdavis@mhjur.com

## Fashion Law

Erika Maurice  
Condon & Forsyth LLP  
18th Floor  
7 Times Square  
New York, NY 10036-6554  
emaurice@condonlaw.com

Lisa Marie Willis  
Kilpatrick Townsend & Stockton LLP  
1114 Avenue of the Americas  
New York, NY 10036  
lisamwillis@gmail.com

## Fine Arts

Mary Elisabeth Conroy  
Edward W. Hayes P.C.  
515 Madison Ave., 31st Floor  
New York, NY 10022-5418  
melisabeth.conroy@gmail.com

Judith B. Prowda  
Sotheby's Institute of Art  
570 Lexington Avenue  
New York, NY 10022  
judith.prowda@gmail.com

Carol J. Steinberg  
Law Firm of Carol J. Steinberg  
74 E. 7th St., Suite F3  
New York, NY 10003  
elizabethcjs@gmail.com

## International

Irina Tarsis  
Center for Art Law  
195 Plymouth Street, 616  
Brooklyn, NY 11201  
tarsis@itsartlaw.com

## Law Student Liaisons

Jason Aylesworth  
Sendroff & Baruch, LLP  
1500 Broadway, Suite 2201  
New York, NY 10036  
jaylesworth@sendroffbaruch.com

## Legislation

Marc Jacobson  
Marc Jacobson, PC  
440 East 79th Street, 11th Floor  
New York, NY 10075  
marc@marcjacobson.com

Steven H. Richman  
Board of Elections, City of New York  
32 Broadway, 7th Floor  
New York, NY 10004-1609  
srichman@boe.nyc.ny.us

## Literary Works and Related Rights

Judith B. Bass  
Law Offices of Judith B. Bass  
1325 Avenue of the Americas  
27th Floor  
New York, NY 10019  
jbb@jbbasslaw.com

Joan S. Faier  
1011 North Avenue  
New Rochelle, NY 10804-3610  
bookf@aol.com

## Litigation

Brian D. Caplan  
Reitler Kailas & Rosenblatt LLC  
885 Third Avenue  
New York, NY 10022  
bcaplan@reitlerlaw.com

Paul V. LiCalsi  
Robins Kaplan LLP  
601 Lexington Avenue, 34th Floor  
New York, NY 10022  
pvlialcalsi@rkmc.com

## Motion Pictures

Ethan Y. Bordman  
Ethan Y. Bordman, PLLC  
244 Godwin Avenue  
Ridgewood, NJ 07450  
ethan@ethanbordman.com

Robert L. Seigel  
The Law Office of Robert L. Seigel  
575 Madison Avenue  
10th Floor  
New York, NY 10022  
rlsentlaw@aol.com

**Music and Recording Industry**  
Joyce Sydnee Dollinger  
Dollinger, Gonski and Grossman  
1 Old Country Road, Suite 102  
Carle Place, NY 11514  
jdollinger@dgglawoffices.com

Christine A. Pepe  
Business & Legal Affairs  
Tidal  
New York, NY

**Not for Profit**  
Robert J. Reicher  
2 Charlton Street  
New York, NY 10014  
rjr@rjreicherlaw.com

**Pro Bono Steering**  
Elissa D. Hecker  
Law Office of Elissa D. Hecker  
64 Butterwood Lane East  
Irvington, NY 10533  
eheckeresq@eheckeresq.com

Kathy Kim  
101 Productions, Ltd.  
260 West 44th Street  
Suite 600  
New York, NY 10036  
KathyK@productions101.com

Carol J. Steinberg  
Law Firm of Carol J. Steinberg  
74 E. 7th Street, Suite F3  
New York, NY 10003  
elizabethcjs@gmail.com

Irina Tarsis  
Center for Art Law  
195 Plymouth Street, 616  
Brooklyn, NY 11201  
tarsis@itsartlaw.com

**Publications**  
Elissa D. Hecker  
Law Office of Elissa D. Hecker  
64 Butterwood Lane East  
Irvington, NY 10533  
eheckeresq@eheckeresq.com

**Publicity, Privacy and Media**  
Edward H. Rosenthal  
Frankfurt Kurnit Klein & Selz, P.C.  
488 Madison Avenue, 10th Floor  
New York, NY 10022-5702  
erosenthal@fkks.com

**Publicity, Privacy and Media  
(continued)**  
Barry Werbin  
Herrick Feinstein LLP  
2 Park Avenue  
New York, NY 10016-5603  
bwerbin@herrick.com

**Phil Cowan/BMI Scholarship**  
Judith A. Bresler  
Withers Bergman LLP  
430 Park Avenue, 9th Floor  
New York, NY 10022  
JudithABresler@gmail.com

Richard A. Garza  
Broadcast Music, Inc. (BMI)  
250 Greenwich Street  
7 World Trade Center  
New York, NY 10019  
rgarza@bmi.com

Barbara Jaffe  
Supreme Court of the State of New York  
60 Centre Street  
New York, NY 10013-4306  
bjaffe@nycourts.gov

**Sports**  
David S. Fogel  
NBA Coaches Association  
545 Fifth Avenue, Suite 640  
New York, NY 10017  
dfogel@nmgmsports.com

Karen M. Lent  
Skadden, Arps, Slate, Meagher  
& Flom LLP  
4 Times Square, Room 34322  
New York, NY 10036-6518  
karen.lent@skadden.com

Kathleen J. Wu  
Andrews Kurth LLP  
1717 Main Street, Suite 3700  
Dallas, TX 75201  
kwu@akllp.com

**Television and Radio**  
Pamela Cathlyn Jones  
Law Offices of Pamela Jones  
P.O. Box 222  
Fairfield, CT 06824  
pamelajonesesq@aol.com

**Television and Radio (continued)**  
Barry Skidelsky  
185 East 85th Street  
New York, NY 10028  
bskidelsky@mindspring.com

Mary Ann Zimmer  
Law Office of Mary Ann Zimmer  
401 East 74th Street  
New York, NY 10021  
mazimmer74@aol.com

**Theatre and Performing Arts**  
Jason P. Baruch  
Sendroff & Baruch, LLP  
1500 Broadway, Suite 2201  
New York, NY 10036-4052  
jbaruch@sendroffbaruch.com

Kathy Kim  
101 Productions, Ltd.  
260 West 44th Street, Suite 600  
New York, NY 10036  
KathyK@productions101.com

Diane F. Krausz  
D. Krausz & Associates  
Attorneys at Law  
33 West 19th Street, 4th Floor  
New York, NY 10011  
DKrausz@dianekrausz.com

**Website**  
Jennifer Meredith Liebman  
N.Y.S. Division of Human Rights  
1 Fordham Plaza  
4th Floor  
Bronx, NY 10458-5871  
jennifermliebman@gmail.com

**Young Entertainment Lawyers**  
Laura Alda Godorecci, Esq.  
40 Maplewood Avenue  
Staten Island, NY 10306  
lagodorecci@gmail.com

## Publication of Articles

The *Journal* welcomes the submission of articles of timely interest to members of the Section. Articles should be submitted with biographical information via e-mail in Microsoft Word format. Please submit articles to:

Elissa D. Hecker  
Editor, *EASL Journal*  
eheckeresq@eheckeresq.com

NEW YORK STATE BAR ASSOCIATION

**Find us Online**



**Find the EASL Journal Online:**

- Past Issues (2000-present) of the EASL Journal\*
- EASL Journal Searchable Index (2000-present)

\*You must be an EASL Section member and logged in to access the Journal. Need password assistance? Visit our website at [www.nysba.org/pwhelp](http://www.nysba.org/pwhelp). For questions or log-in help, call 518-463-3200.



[www.nysba.org/EASLJournal](http://www.nysba.org/EASLJournal)

This *Journal* is published three times a year for members of the Entertainment, Arts and Sports Law Section of the New York State Bar Association. Members of the Section receive the *Journal* without charge. The views expressed in articles published in this *Journal* represent those of the authors only, and not necessarily the views of the Editor, the Entertainment, Arts and Sports Law Section or the New York State Bar Association.

We reserve the right to reject any advertisement. The New York State Bar Association is not responsible for typographical or other errors in advertisements.

### Accommodations for Persons with Disabilities:

NYSBA welcomes participation by individuals with disabilities. NYSBA is committed to complying with all applicable laws that prohibit discrimination against individuals on the basis of disability in the full and equal enjoyment of its goods, services, programs, activities, facilities, privileges, advantages, or accommodations. To request auxiliary aids or services or if you have any questions regarding accessibility, please contact the Bar Center at (518) 463-3200.

©2017 by the New York State Bar Association.  
ISSN 1090-8730 (print) ISSN 1933-8546 (online)

## Entertainment, Arts and Sports Law Journal

### Editor

Elissa D. Hecker  
Law Office of Elissa D. Hecker  
eheckeresq@eheckeresq.com

### Citation Editor

Eric Lanter (ericjlanter@gmail.com)

### Section Officers

#### Chair

Diane F. Krausz  
D. Krausz & Associates  
Attorneys At Law  
33 West 19th St., 4th Floor  
New York, NY 10011  
DKrausz@dianekrausz.com

#### First Vice-Chair

Richard A. Garza  
Broadcast Music, Inc. (BMI)  
250 Greenwich Street  
7 World Trade Center  
New York, NY 10019  
rgarza@bmi.com

#### Second Vice-Chair

Jason P. Baruch  
Sendroff & Baruch, LLP  
1500 Broadway, Suite 2201  
New York, NY 10036-4052  
jbaruch@sendroffbaruch.com

#### Secretary

Anne S. Atkinson  
Pryor Cashman LLP  
7 Times Square  
New York, NY 10036-6569  
aatkinson@pryorcashman.com

#### Assistant Secretary

Jennifer N. Graham  
114 Troutman Street  
Apt. 123  
Brooklyn, NY 11206  
grahambrienlaw@gmail.com

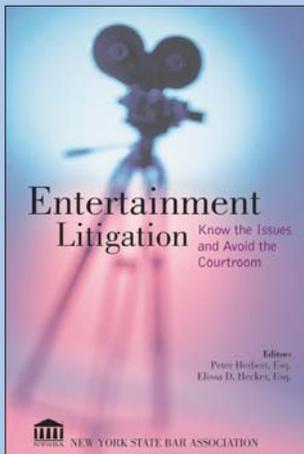
#### Treasurer

Jason Aylesworth  
Sendroff & Baruch, LLP  
1500 Broadway  
Suite 2201  
New York, NY 10036  
jaylesworth@sendroffbaruch.com

#### Assistant Treasurer

Carol J. Steinberg  
74 East 7th Street  
New York, NY 10003  
elizabethcjs@gmail.com

# Entertainment Litigation



## EDITORS

**Peter Herbert, Esq.**  
Hinckley, Allen & Snyder LLP

**Elissa D. Hecker**  
Law Office of Elissa D. Hecker

## PRODUCT INFO AND PRICES

2007 / 232 pp., softbound

PN: 4087 (Print)

PN: 4087E (Downloadable PDF)

<b>NYSBA Members</b>	<b>\$40</b>
Non-members	\$60

\$5.95 shipping and handling within the continental U.S. The cost for shipping and handling outside the continental U.S. will be based on destination and added to your order. Prices do not include applicable sales tax.

*Entertainment Litigation* is a thorough exposition of the basics that manages to address in a simple, accessible way the pitfalls and the complexities of the field, so that artists, armed with that knowledge, and their representatives can best minimize the risk of litigation and avoid the courtroom.

Written by experts in the field, *Entertainment Litigation* is the manual for anyone practicing in this fast-paced, ever-changing area of law.

## Contents

1. Contracts Without an Obligation
2. Artist-Manager Conflicts
3. Artist-Dealer Relations: Representing the Visual Artist
4. Intellectual Property Overview: Right of Privacy / Publicity and the Lanham Act
5. Anatomy of a Copyright Infringement Claim
6. Digitalization of Libraries / Google Litigation
7. Accrual of Copyright Infringement Claims
8. The Safe Harbor Provisions of the Digital Millennium Copyright Act and "X".com
9. Trademarks for Artists and Entertainers
10. Internet: A Business Owner's Checklist for Avoiding Web Site Pitfalls
11. Internet Legal Issues
12. Litigating Domain Name Disputes
13. Alternative Dispute Resolution Appendices



## Get the Information Edge

1.800.582.2452 [www.nysba.org/pubs](http://www.nysba.org/pubs)

Mention Code: PUB8861N

\*Discount valid through February 8, 2018





NEW YORK STATE BAR ASSOCIATION  
**ENTERTAINMENT, ARTS AND SPORTS LAW SECTION**  
One Elk Street, Albany, New York 12207-1002

NON PROFIT ORG.  
U.S. POSTAGE  
**PAID**  
ALBANY, N.Y.  
PERMIT NO. 155

NEW YORK STATE BAR ASSOCIATION



NEW YORK CITY  
New York Hilton Midtown

ANNUAL  
MEETING

2018  
JANUARY 22 - 26



Get Social: #nysba18

