

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

BOSTON MUNICIPAL COURT  
CENTRAL DIVISION  
Docket 1101CR005277

COMMONWEALTH

v.

MATTHEW BUSA

**BRIEF OF *AMICUS CURIAE* DIGITAL MEDIA LAW PROJECT  
IN SUPPORT OF DEFENDANT MATTHEW BUSA'S MOTION TO DISMISS**

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**TABLE OF CONTENTS**

**INTRODUCTION**..... 1

**STATEMENT OF FACTS**..... 1

**INTERESTS OF AMICUS** ..... 2

**SUMMARY OF ARGUMENT**..... 2

**ARGUMENT**..... 3

**I. SECTION 147 IS UNCONSTITUTIONALLY OVERBROAD.** ..... 3

        A. Overbreadth under the First Amendment and Article 16. .... 3

        B. Section 147 Must Be Stricken under the Overbreadth Doctrine of the First Amendment and Article 16 of the Massachusetts Declaration of Rights Because it Criminalizes a Wide Array of News Reporting, Political Speech, and Free Expression..... 4

        C. Section 147’s Broad Criminalization of Speech Cannot Survive First Amendment Scrutiny, Because Unlike Other Intellectual Property Doctrines it is Not Narrowly Tailored to Protect Free Expression..... 10

        D. The Constitutional Defects in Section 147 Cannot be Cured through Prosecutorial Discretion or Judicial Interpretation. .... 12

**II. SECTION 147 IS PREEMPTED BY FEDERAL COPYRIGHT LAW**..... 15

        A. Preemption Under the Supremacy Clause. .... 15

        B. All Claims Raised under Section 147 are Expressly Preempted through Section 301 of the Copyright Act, and Therefore Section 147 is Void Under the Supremacy Clause..... 16

            1. *The Works Protected Under Section 147 are the Same Subject Matter as those Protected Under Section 106 of the Copyright Act.* ..... 17

            2. *Section 147 Governs the Same Rights as Copyright, By Criminalizing the Manufacture, Display, and Distribution of a Word or Image, Without More*..... 19

        C. Section 147 Directly Conflicts With Federal Copyright Policy By Criminalizing Uses of Another’s Word Or Image in Circumstances Where Congress Has Expressly Allowed Such Uses..... 22

**CONCLUSION** ..... 23

**APPENDIX A – M.G.L. ch. 266, § 147**

**APPENDIX B – Penn. Cons. Stat. § 4119 (as enacted Oct. 16, 1996)**

**APPENDIX C – Selected Provisions of Penn. Cons. Stat. § 4119 and M.G.L. ch. 266, § 147**

**APPENDIX D – 17 U.S.C. § 301**

## TABLE OF AUTHORITIES

### Cases

<i>Aristocratic Restaurant of Mass., Inc. v. Alcoholic Beverages Control Comm'n</i> , 374 Mass. 547 (1978) .....	3
<i>Bonito Boats Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141 (1989).....	15, 22
<i>Brennan v. Bd. of Educ. Comm'rs</i> , 310 Mass. 784 (1942) .....	13
<i>Brown v. Entertainment Merchants Ass'n</i> , 131 S.Ct. 2729 (2011).....	10
<i>Buckley v. Valeo</i> , 424 U.S. 1 (1976) .....	7
<i>City of Lakewood v. Plain Dealer Publ'g Co.</i> , 486 U.S. 750 (1988) .....	12
<i>Commonwealth v. A Juvenile</i> , 368 Mass. 580 (1975).....	4, 14
<i>Commonwealth v. College Pro Painters Ltd.</i> , 418 Mass. 726 (1994) .....	15, 16, 22
<i>Commonwealth v. Mandell</i> , 61 Mass. App. Ct. 526 (2004) .....	14
<i>Commonwealth v. Omar</i> , 981 A.2d 179 (Pa. 2009).....	passim
<i>Curtis v. Herb Chambers I-95, Inc.</i> , 458 Mass. 674, 677 (2011) .....	17, 19, 21
<i>Dastar Corp. v. Twentieth Century Fox Film Corp.</i> , 539 U.S. 23 (2003).....	15
<i>Eldred v. Ashcroft</i> , 537 U.S. 186 (2003).....	11
<i>Feldman v. Twentieth Century Fox Film Corp.</i> , 723 F. Supp. 2d 357 (D. Mass. 2010). .....	20
<i>Free v. Bland</i> , 369 U.S. 663 (1962).....	15
<i>Golan v. Holder</i> , 132 S. Ct. 873 (2012).....	11
<i>Gooding v. Wilson</i> , 405 U.S. 518 (1972).....	12
<i>Hines v. Davidowitz</i> , 312 U.S. 52 (1941) .....	16, 22
<i>Hisquierdo v. Hisquierdo</i> , 439 U.S. 572 (1979).....	16
<i>John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.</i> , 186 F. Supp. 2d 1 (D. Mass. 2002).....	19
<i>Lee v. Mt. Ivy Press, L.P.</i> , 63 Mass. App. Ct. 538 (2005) .....	20
<i>Mendoza v. Licensing Bd. of Fall River</i> , 444 Mass. 188 (2005).....	4
<i>Monroe Stationers &amp; Printers, Inc. v. Munroe Stationers Inc.</i> , 332 Mass. 278 (1955) .....	11
<i>Morales v. Trans World Airlines, Inc.</i> , 504 U.S. 374 (1992).....	16
<i>Moulton v. Brookline Rent Control Bd.</i> , 385 Mass. 228 (1982) .....	14
<i>O'Brien v. Borowski</i> , 461 Mass. 415 (2012) .....	14
<i>Orson, Inc. v. Miramax Film Corp.</i> , 189 F.3d 377 (3d Cir. 1999) .....	16
<i>Pan-Am. Prods. &amp; Holdings, LLC v. R.T.G. Furniture Corp.</i> , 825 F. Supp. 2d 664 (M.D.N.C. 2011).....	15
<i>People v. Borriello</i> , 588 N.Y.S.2d 991 (N.Y. Sup. Ct.1992).....	21
<i>Pyle v. School Comm. of S. Hadley</i> , 423 Mass. 283 (1996).....	13
<i>Qualitex Co. v. Jacobsen Prods. Co.</i> , 514 U.S. 159 (1995) .....	10
<i>Rosenbloom v. Kokofsky</i> , 373 Mass. 778 (1977) .....	13
<i>Secretary of State of Md. v. Joseph H. Munson Co.</i> , 467 U.S. 947 (1984).....	4

<i>Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.</i> , 914 F. Supp. 665 (D. Mass. 1995).....	17
<i>United States v. Stevens</i> , 130 S. Ct. 1577 (2010).....	12
<i>Vault Corp. v. Quaid Software Ltd.</i> , 847 F.2d 255 (5th Cir. 1988).....	15
<i>Virginia v. Hicks</i> , 539 U.S. 113 (2003).....	3, 4

Statutes

15 U.S.C. § 1125.....	2
15 U.S.C. § 1127.....	18
17 U.S.C. § 101.....	18, 21
17 U.S.C. § 102(b).....	11, 18
17 U.S.C. § 104A.....	21
17 U.S.C. § 106.....	20, 21
17 U.S.C. § 106A.....	21
17 U.S.C. § 107.....	11
17 U.S.C. § 108.....	21, 22
17 U.S.C. § 109.....	22
17 U.S.C. § 112.....	21
17 U.S.C. § 115.....	22
17 U.S.C. § 301.....	passim
37 C.F.R. § 2.21.....	18
950 Mass. Code Regs. § 62.13.....	19
M.G.L. ch. 110H, § 1.....	18
M.G.L. ch. 110H, § 12.....	2, 11
M.G.L. ch. 266, § 147.....	passim
U.S. Const. Art. I § 8 cl. 8.....	3, 22
U.S. Const. Art. VI.....	3

Other Authorities

Chad Finn, <i>Patrice Bergeron bitten by Alexandre Burrows</i> , Boston.com (June 2, 2011), <a href="http://articles.boston.com/2011-06-02/sports/29609553_1_patrice-bergeron-bruins-finger">http://articles.boston.com/2011-06-02/sports/29609553_1_patrice-bergeron-bruins-finger</a> .....	1
<i>Corporate America Flag</i> , AdBusters, <a href="http://www.adbusters.org/cultureshop/corporateflag">http://www.adbusters.org/cultureshop/corporateflag</a> .....	8
Eugene Volokh, <i>Freedom of Speech and Information Privacy</i> , 52 Stanford L. Rev. 1049 (2000).....	10
H.R. Rep. No. 94-1476 (1976), reprinted in 1976 U.S.C.C.A.N. 5659.....	17
Patrik Jonsson, <i>Worldwide BP Protest Day Vilifies BP for Gulf Oil Spill</i> , Christian Science Monitor (June 12, 2010), <a href="http://www.csmonitor.com/USA/2010/0612/Worldwide-BP-Protest-Day-vilifies-BP-for-Gulf-oil-spill">http://www.csmonitor.com/USA/2010/0612/Worldwide-BP-Protest-Day-vilifies-BP-for-Gulf-oil-spill</a> .....	9
Richard H. Fallon, <i>Making Sense of Overbreadth</i> , 100 Yale L.J. 853 (1991).....	12
William F. Patry, <i>Patry on Copyright</i> (2012).....	17, 19

## INTRODUCTION

Before the Court is Defendant Matthew Busa's motion to dismiss charges brought under Massachusetts's "anti-counterfeiting" law, M.G.L. ch. 266, § 147 ("Section 147"). The Digital Media Law Project ("DMLP") submits this brief as an *amicus curiae* because it believes that Section 147 on its face is: (1) a dangerously overbroad restriction on free speech, contrary to the First Amendment to the United States Constitution and Article 16 of the Massachusetts Declaration of Rights; and (2) preempted by federal copyright law, pursuant to the Supremacy Clause of the U.S. Constitution and 17 U.S.C. § 301. Accordingly, DMLP respectfully requests that the Court strike Section 147 in its entirety.

## STATEMENT OF FACTS<sup>1</sup>

This case concerns t-shirts sold by defendant Matthew Busa, bearing the orca logo of the Vancouver Canucks covered by the universal "no" symbol (a circle containing a diagonal line). The shirts also bore the text "BOSTON FIGHTS / VANCOUVER BITES." Mr. Busa began selling the t-shirts after Canucks forward Alexandre Burrows bit the finger of Boston Bruins forward Patrice Bergeron in a fight that erupted during game one of the Stanley Cup Finals on June 1, 2011. *See* Chad Finn, *Patrice Bergeron bitten by Alexandre Burrows*, Boston.com (June 2, 2011), [http://articles.boston.com/2011-06-02/sports/29609553\\_1\\_patrice-bergeron-bruins-finger](http://articles.boston.com/2011-06-02/sports/29609553_1_patrice-bergeron-bruins-finger) (last visited May 21, 2012). On June 8, 2011, Andrea Powers, an agent for the NHL, and Detective Gwendolyn Brown saw Mr. Busa selling the t-shirts on the street outside of the TD Garden during game four of the Stanley Cup Finals. Detective Brown subsequently confiscated

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<sup>1</sup> For the purposes of this brief, DMLP assumes as true the allegations set forth in the July 9, 2011, Affidavit of Andrea Powers; the August 8, 2011, Incident Report of Detective Gwendolyn Brown; and the exhibits and attachments accompanying those documents.

Mr. Busa's merchandise as a violation of Section 147. The Commonwealth now seeks to prosecute Mr. Busa under that law.

### INTERESTS OF AMICUS

As described more fully in its motion for leave to file this *amicus* brief, the DMLP provides legal assistance, training, and other resources for online and citizen media. The DMLP regularly appears as an *amicus curiae* in cases with important implications for online speech, journalism, and the public good. As described further herein, the DMLP is concerned about Section 147 because it criminalizes a wide range of protected speech, including political speech, news reporting, criticism, and everyday personal expression.

### SUMMARY OF ARGUMENT

Section 147 makes it a crime for a person or entity to “use[], display[], . . . distribute[], [or] sell[]” any item bearing a “trademark, service mark, trade name, label, term, device, design, or word” that is used and registered by another entity to identify its goods or services, without authorization from the other entity. M.G.L. ch. 266, § 147. The statute provides no exceptions for use in commentary, news reporting, protest, or other forms of speech protected by the First Amendment and Article 16. Although the statute invokes trademark concepts, it does not include the standard elements of trademark law that narrow the reach of the doctrine and protect free speech; namely (1) that the defendant's use must be likely to cause consumer confusion or source dilution, and (2) that any punishment for violation of trademark rights must be weighed with free speech principles before it may be prohibited. *See, e.g.*, 15 U.S.C. § 1125 (a)(1)(A) (requiring confusion, mistake, or deception for trademark infringement); M.G.L. ch. 110H, § 12(i) (same). As a result, Section 147 is unconstitutionally overbroad. *See Commonwealth v.*

*Omar*, 981 A.2d 179, 189 (Pa. 2009) (striking a highly similar anti-counterfeiting law as unconstitutional under the First Amendment).

Furthermore, Section 147's blanket prohibition against copying, displaying, and distributing unauthorized copies of words and images, without exception, conflicts with Congress's exclusive domain over all laws which concern the same subject matter and general rights as federal copyright law, and is therefore invalid under the Supremacy Clause of the U.S. Constitution. U.S. Const. Art. VI; 17 U.S.C. § 301. Section 147 upsets the carefully crafted bargain between the rights of the public and those of intellectual property holders by prohibiting any and all unauthorized reproduction of any "word" or "design" that another uses as a mechanism for identifying that person's good or services. M.G.L. ch. 266, § 147(a). This contravenes federal law, and frustrates the balance sought by Congress in allowing certain unauthorized uses of another's work in order to further the progress of science and art. *See* U.S. Const. Art. I, § 8, cl. 8. This court should therefore declare the law void.

## **ARGUMENT**

### **I. SECTION 147 IS UNCONSTITUTIONALLY OVERBROAD.**

#### **A. Overbreadth under the First Amendment and Article 16.**

Because Section 147, by its explicit terms, criminalizes a wide array of protected speech, it is unconstitutionally overbroad. A statute is overbroad and invalid under the First Amendment and/or Article 16 of the Massachusetts Declaration of Rights if it "punishes a 'substantial' amount of protected free speech, 'judged in relation to the statute's plainly legitimate sweep,'" *Virginia v. Hicks*, 539 U.S. 113, 118-19 (2003) (quoting *Broadrick v. Oklahoma*, 413 U.S. 601, 615 (1973)); *see also Aristocratic Restaurant of Mass., Inc. v. Alcoholic Beverages Control Comm'n*, 374 Mass. 547, 555-56 (1978) (recognizing independent overbreadth doctrine under

Article 16).<sup>2</sup> A defendant may raise an overbreadth argument under the state and federal free speech provisions even if the defendant's own conduct could be proscribed by a more narrow statute. *See Secretary of State of Md. v. Joseph H. Munson Co.*, 467 U.S. 947, 957 (1984) (First Amendment); *Mendoza v. Licensing Bd. of Fall River*, 444 Mass. 188, 200 n. 14 (2005) (Article 16). Because the overbreadth doctrine is designed to preserve free speech generally, a showing that a statute prohibits a substantial amount of protected speech "suffices to invalidate *all* enforcement of that law, 'until and unless a limiting construction or partial invalidation so narrows it as to remove the seeming threat or deterrence to constitutionally protected expression.'" *Hicks*, 539 U.S. at 119 (quoting *Broadrick*, 413 U.S. at 613) (emphasis in original). Moreover, an overbroad statute cannot be fixed through judicial construction where the language of the statute plainly prohibits constitutionally protected expression; rather, the statute must be stricken and correction left to the legislature. *Commonwealth v. A Juvenile*, 368 Mass. 580, 594-95 (1975).

**B. Section 147 Must Be Stricken under the Overbreadth Doctrine of the First Amendment and Article 16 of the Massachusetts Declaration of Rights Because it Criminalizes a Wide Array of News Reporting, Political Speech, and Free Expression.**

By its terms, Section 147 criminalizes *any* display, manufacture, or distribution of a word or image that another party uses as a trademark, including when done for purely expressive reasons or in a way that is completely outside of its trademark meaning. The statute provides that "[w]hoever willfully manufactures, uses, displays, advertises, distributes, offers for sale, sells or

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<sup>2</sup> Article 16 protects a greater scope of speech than the First Amendment, and therefore a statute may be held overbroad under Article 16 even if the reach of the statute does not offend the federal constitution. *See Mendoza v. Licensing Bd. of Fall River*, 444 Mass.188, 201-02 (2005) (restriction on nude dancing held overbroad under Article 16 despite narrower protection offered under the First Amendment).



possesses with intent to sell or distribute any item or services bearing or identified by a counterfeit mark shall be punished . . . .” M.G.L. ch. 266, § 147(b). A “counterfeit mark” is “any unauthorized reproduction or copy of intellectual property,” and “intellectual property” is “any trademark, service mark, trade name, label, term, device, design or word that is (1) adopted or used by a person to identify such person’s goods or services, and (2) registered . . . under the laws of the commonwealth or of any other state, or registered in the principal register of the United States Patent and Trademark Office.” § 147(a). The statute, therefore, criminalizes any use of any item bearing a word, image, or other trademark that another has registered with a state or federal trademark office, unless the registered trademark owner authorizes the use.

The Supreme Court of Pennsylvania recently struck a substantially identical law<sup>3</sup> as constitutionally overbroad in *Commonwealth v. Omar*. 981 A.2d 179. There, the law provided that “[a]ny person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting.” *Id.* at 181 n.1. Like Section 147, a “counterfeit mark” was defined as “any unauthorized reproduction or copy of intellectual property,” with “intellectual property” defined as “[a]ny trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify that person’s goods or services.” *Id.*

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<sup>3</sup> See Appendix A (full text of M.G.L. ch. 266 § 147); Appendix B (full text of Penn. Cons. Stat. § 4119 (as originally enacted)); and Appendix C (comparison of selected provisions from both statutes). Unlike Section 147, the Pennsylvania statute did not contain a registration requirement in order for the mark to be protected under the statute. As discussed below, this distinction does not affect the result in the case at bar because it does not limit the wide range of uses by a *defendant* that are protected by the Constitution, but proscribed by the statute.

Noting that the law was likely passed “to prohibit the deceptive, unauthorized use of a trademark for profit,” the Supreme Court of Pennsylvania nevertheless held that “[a]lthough the statute ha[d] a laudable and constitutional purpose, the plain language of the statute as written prohibit[ed] a much broader range of uses of trademarks, many of which involve constitutionally protected speech.” *Omar*, 981 A.2d at 186. The court found that by “criminaliz[ing] the use of any items bearing an unauthorized reproduction of terms or words used by a person to identify that person’s goods or services,” the statute “unconstitutionally prohibit[ed] protected speech, including the use of words on a sign praising or protesting any entity with a trademarked name.” *Id.* at 187. This included entirely neutral uses, such as the court’s own “use of the words ‘Nike’ and ‘Penn State’ in [the court’s written] opinion without the permission of the company or the university.” *Id.* Accordingly, the court struck the law as overbroad. *Id.* at 189.

The same constitutional deficiencies exist in this case. Section 147 criminalizes, *inter alia*, the willful “use[], display[], . . . distribut[ion] . . . or possess[ion] with intent to . . . distribute” of any item bearing an unauthorized use of a “label, . . . design or word” that is used and registered by another person to identify that person’s goods or services. M.G.L. ch. 266, § 147. The result of this broad prohibition against using certain words and images is that a massive array of speech protected under the First Amendment and Article 16 becomes criminal, including news reporting and political speech.

News organizations universally run stories about corporations, mentioning companies and their marks by name. It is nearly impossible to look at the front page of any newspaper or news website without seeing a company referenced by its trademarks. The sports sections of newspapers routinely include trademark-registered words, such as “Red Sox,” “Celtics,”

“Bruins,” or “Patriots.”<sup>4</sup> News outlets therefore constantly “use[], display[], [and] distribute[]” items bearing a “term . . . or word” that is used by a person to identify goods or services, without that person’s authorization, which, according to plain language of the statute, constitutes a “counterfeit mark.” *See* M.G.L. ch. 266, § 147. If the statute is enforced against publications with more than 1,000 copies in circulation, the journalists involved will face “imprisonment in the state prison for not more than ten years.” M.G.L. ch. 266, § 147(b)(3). Even worse, state and local governments themselves own federally-registered trademarks, and could use the law to threaten, punish, or suppress criticism of services bearing those marks. *See, e.g.*, MASS.GOV, Registration No. 3,007,252 (owned by the Commonwealth); TECHBOSTON, Registration No. 3,891,940 (owned by the City of Boston).

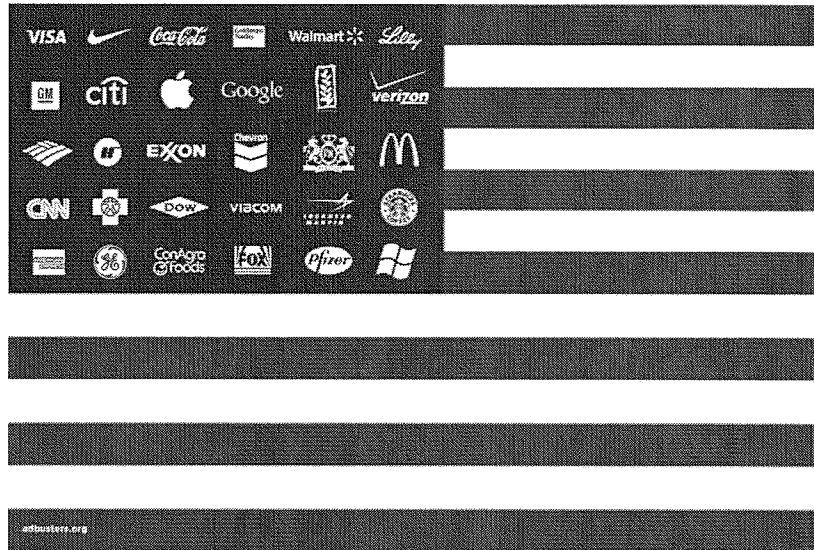
Allowing the state to criminally prosecute such uses creates a perpetual cloud of criminality over every media organization that operates or distributes news within the Commonwealth. The government could opt to enforce Section 147 against any and every news organization based on the mere mention of any registered trade name at any time, and seize any distributed publications – or even the printing presses themselves – under the letter of the law. M.G.L. ch. 266, § 147(g). Such unfettered discretion and temptation for retaliatory enforcement is fundamentally at odds with the free speech protections of the state and federal constitutions.

The law also criminalizes many forms of political speech central to the aims of the First Amendment and Article 16. *See Buckley v. Valeo*, 424 U.S. 1, 14-15 (1976) (“The First Amendment affords the broadest protection to such political expression in order to assure the unfettered interchange of ideas for the bringing about of political and social changes desired by

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<sup>4</sup> *See* RED SOX, USPTO Registration No. 1,095,475; BOSTON CELTICS, Registration No. 1,003,131; BOSTON BRUINS, Registration No. 953,886; NEW ENGLAND PATRIOTS, Registration No. 995,095.

the people.” (internal quotation omitted)). For example, the organization AdBusters sells a “corporate America flag,” which critiques corporate influence in American policy by replacing the stars of the American Flag with corporate logos:



*Corporate America Flag*, AdBusters, <http://www.adbusters.org/cultureshop/corporateflag> (last visited May 21, 2012). By using specific logos, AdBusters is directly calling out thirty specific organizations as engaging in improper influence on American policy. And yet, under Section 147, the creators and purchasers of this flag would paradoxically have to obtain permission from each of the corporations they wish to criticize before they could display the flag in Massachusetts, or face risk of arrest.

Similarly, protesters calling for a boycott of British Petroleum (“BP”) following the ecological disaster at the Deepwater Horizon oil platform displayed BP-owned logos to identify the brands they wished people to boycott, such as in this protest sign captured in a photograph published in the *Christian Science Monitor*:



See Patrik Jonsson, *Worldwide BP Protest Day Vilifies BP for Gulf Oil Spill*, *Christian Science Monitor* (June 12, 2010), <http://www.csmonitor.com/USA/2010/0612/Worldwide-BP-Protest-Day-vilifies-BP-for-Gulf-oil-spill> (last visited May 21, 2012). Again, Section 147 would require the BP protesters to obtain authorization from BP to criticize the company using its logo and require the *Christian Science Monitor* to obtain permission to display the photograph containing the logo and the word "BP" in its report on the protest. See BP (drawing), Registration No. 3,515,941; BP (wordmark), Registration No. 4,128,850.

Furthermore, Section 147 absurdly criminalizes the use of trademark-registered words even when the use has nothing to do with the goods or services offered by a registrant. The law does not require that the words in question be used for their trademark purpose, or with respect to any particular set of goods or services, criminalizing the use of such words for their plain English meaning. For instance, Section 147 makes it a crime to write or display the word "BOSTON" on any item without authorization from a company – and possibly *every* company – that has registered the wordmark BOSTON with the United States Patent and Trademark Office. As of the drafting of this brief, this would include, among others, an acoustics company, a distiller, two different medical products companies, an office supplies manufacturer, a machine fabricator, a food service company, a magazine publisher, and a piano maker. See USPTO Registration Nos.

1,369,831; 1,494,446; 1,607,115; 1,619,693; 1,512,670; 522,912; 1,996,529; 2,506,549; 1,743,058.<sup>5</sup>

In the end, the conduct proscribed by Section 147 is limited only by a prosecutor's imagination. The statute is wildly overbroad, violates both the First Amendment and Article 16 of the Declaration of Rights, and must be stricken.

**C. Section 147's Broad Criminalization of Speech Cannot Survive First Amendment Scrutiny, Because Unlike Other Intellectual Property Doctrines it is Not Narrowly Tailored to Protect Free Expression.**

Because Section 147 "imposes a restriction on the content of protected speech, it is invalid unless [the Commonwealth] can demonstrate that it passes strict scrutiny—that is, unless it is justified by a compelling government interest and is narrowly drawn to serve that interest." *Brown v. Entertainment Merchants Ass'n*, 131 S.Ct. 2729, 2738 (2011). Even if Section 147's effort to suppress a market in counterfeit goods were held to serve a compelling government interest, the means used by the statute are not narrowly tailored because (as discussed above) the statute sweeps in a vast amount of expressive activity that has nothing to do with protection of trademarks.

Although regulations of intellectual property can exist consistent with free speech protections, merely classifying a statute as an "intellectual property law" does not inherently allow it to survive First Amendment scrutiny. Eugene Volokh, *Freedom of Speech and Information Privacy*, 52 Stanford L. Rev. 1049, 1063 (2000). To the contrary, intellectual property regimes that restrict speech are permissible only if they strike a balance with the First Amendment and make accommodations for constitutionally protected speech.

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<sup>5</sup> Nor is Section 147 limited to use of simple English. By including "any trademark" as part of its definition, the law criminalizes the display of any visual element that another has used to identify goods or services – including colors that are registered as trademarks. See *Qualitex Co. v. Jacobsen Prods. Co.*, 514 U.S. 159 (1995) (holding that colors, standing alone, can be trademarks under the Lanham Act).

By using the term “counterfeiting” in the title of Section 147, the Commonwealth appears to be invoking trademark law principles. Unlike existing state and federal trademark law, however, no accommodation is made for constitutionally-protected speech. Trademark laws generally accommodate expressive uses of trademarks by limiting their scope to deceptive commercial speech and by recognizing exceptions for critical use and other fair uses. *See, e.g.*, M.G.L. ch. 110H, § 12(i) (limiting finding of infringement under Massachusetts trademark law to circumstances when “the use is likely to cause confusion or mistake or to deceive as to the source origin” of goods and services); *Monroe Stationers & Printers, Inc. v. Munroe Stationers Inc.*, 332 Mass. 278, 280 (1955) (common law unfair competition applies when public is misled “into buying the defendant’s goods in the belief that they were buying those of the plaintiff”); 15 U.S.C. § 1125(c)(3) (prohibiting application of federal trademark dilution law to, *inter alia*, noncommercial uses, nominative and descriptive fair uses, and uses which criticize the mark or its owner).

Likewise, by prohibiting unauthorized copying of another’s words or images, Section 147 evokes (and, as explained below, improperly interferes with) copyright law. Once again, the statute omits the “built-in First Amendment accommodations” of copyright law, namely, the equitable doctrine of fair use and the statutory requirement that copyright not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery.” 17 U.S.C. §§ 102(b), 107; *see Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003). Copyright survives First Amendment scrutiny only because of these accommodations. *Id.* at 221; *accord Golan v. Holder*, 132 S. Ct. 873, 890-91 (2012).

Section 147 is in no sense narrowly tailored to achieve its ends, and therefore it cannot be saved simply because those ends echo the purposes of recognized forms of intellectual property

law. The statute's sweeping overbreadth is fatal; Section 147 fails strict scrutiny under the First Amendment, and accordingly must be declared void.

**D. The Constitutional Defects in Section 147 Cannot be Cured through Prosecutorial Discretion or Judicial Interpretation.**

It is irrelevant whether the Commonwealth currently intends to use Section 147 to prosecute the constitutionally protected conduct described above; the overbreadth doctrine does not allow an overbroad law to survive based upon the discretion of law enforcement. *United States v. Stevens*, 130 S. Ct. 1577, 1591 (2010) (“We would not uphold an unconstitutional statute merely because the Government promised to use it responsibly.”). Even if one believed that the state would apply the law in a content-neutral manner, the law must nevertheless be struck as overbroad for the chilling effect it has upon legitimate speakers. The overbreadth doctrine is “necessary because persons whose expression is constitutionally protected may well refrain from exercising their rights for fear of criminal sanctions provided by a statute susceptible of application to protected expression.” *Gooding v. Wilson*, 405 U.S. 518, 521 (1972). Moreover, “[b]ecause such schemes vest administrative officials with statutorily unbounded discretion to determine what speech to allow and disallow, [overbroad statutes] may both invite and conceal forbidden content-based discrimination.” Richard H. Fallon, *Making Sense of Overbreadth*, 100 *Yale L.J.* 853, 867 (1991); see *City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 759 (1988) (rejecting licensing schemes when there exists a “substantial power to discriminate based on the content or viewpoint of speech by suppressing disfavored speech or disliked speakers”).



Furthermore, Section 147's constitutional defects cannot be cured by judicial interpretation.<sup>6</sup> When interpreting a statute, a court's "primary duty is to interpret a statute in accordance with the intent of the Legislature," and "[w]here the language of a statute is clear and unambiguous, it is conclusive as to legislative intent." *Pyle v. School Comm. of S. Hadley*, 423 Mass. 283, 285 (1996). "If the language of a provision is unclear, a court may look to outside sources for assistance in determining the correct construction. . . . Where, however, no such ambiguity exists, these outside aides are unavailable . . . and the enactment must be interpreted according to the 'usual and natural meaning' of its language." *Rosenbloom v. Kokofsky*, 373 Mass. 778, 781 (1977) (internal citations omitted); see *Brennan v. Bd. of Educ. Comm'rs*, 310 Mass. 784, 789 (1942) ("We must construe the statutes as they are written.").

As discussed above, the language of Section 147 clearly reaches protected speech. Moreover, it does not support a limiting construction. In *Omar*, the Commonwealth of Pennsylvania attempted to save its counterfeiting statute by relying upon the clause "with intent to sell or distribute," which the Commonwealth argued would limit the full list of proscribed acts to commercial activity. 981 A.2d at 187. The Supreme Court of Pennsylvania rejected that argument, noting that such a reading of the statute would contravene both its plain meaning and reasonable principles of interpretation, because read in that manner "the statute would prohibit the selling of items with the intent to sell and the distribution of items with the intent to distribute, which results in grammatically absurd redundancy." *Id.* Applying the "last antecedent" canon of construction, the court held that the "with intent to sell or distribute" clause must modify only the last verb in the list: "possesses." *Id.* Any alternative reading would do

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<sup>6</sup> The DMLP respectfully disagrees with the defendant that a limiting interpretation is possible in this case, while agreeing that the defendant could not be found guilty if prosecuted under a statute narrowed sufficiently by the Massachusetts General Court to be constitutional.

“violence to the sentence as written by the legislature.” *Id.* The “last antecedent” rule is similarly controlling in our Commonwealth, *Moulton v. Brookline Rent Control Bd.*, 385 Mass. 228, 230-31 (1982), and such an argument as applied to Section 147 must fail for the same reason.

The root of Section 147’s constitutional infirmity is not a lack of clarity or ambiguous terms, problems which might be remedied by canons of construction. *See O’Brien v. Borowski*, 461 Mass. 415, 427 (2012) (interpreting the ambiguous term “fear” in an anti-harassment statute so as to avoid unconstitutionality). Instead, the statute’s infirmity rests upon how clearly it applies to a wide range of impermissible activity. By its very terms, the statute prohibits the manufacture, display, distribution, and sale of items that bear upon them a word that is registered by another for identifying goods or services, without authorization from such other person. No free speech protections exist in Section 147, nor can they be read into the statute without ignoring the plain language of the text. As the Massachusetts Appeals Court has noted, “[w]e are not free to add language to a statute for the purpose of interpreting it according to what we might imagine to be the Legislature’s objective.” *Commonwealth v. Mandell*, 61 Mass. App. Ct. 526, 528 (2004). Because the plain language of Section 147 reaches a vast range of conduct that is unquestionably protected by the First Amendment, the statute must be stricken so that the legislature has a chance to modify the statute; it cannot be cured by judicial interpretation. *A Juvenile*, 368 Mass. at 594-95; *see also Omar*, 981 A.2d at 191 (Castille, J., concurring) (“[T]he statute, on its face, is unambiguous, and we may not disregard those obvious deficiencies to essentially re-write the statute so as to keep trademark counterfeiting illegal until the General Assembly manages to define the offense in a constitutional manner.”).

Because Section 147, by its explicit words, contemplates the criminalization of a wide variety of expressive conduct, it must be struck as unconstitutionally overbroad.

## **II. SECTION 147 IS PREEMPTED BY FEDERAL COPYRIGHT LAW.**

### **A. Preemption Under the Supremacy Clause.**

Separate from its unconstitutional overbreadth, Section 147 must be struck because it improperly interferes with federal copyright law. “Through its authority under the Supremacy Clause . . . Congress has preempted all state law rights that are equivalent to those protected under federal copyright law.” *Pan-Am. Prods. & Holdings, LLC v. R.T.G. Furniture Corp.*, 825 F. Supp. 2d 664, 690 (M.D.N.C. 2011). Section 147 intrudes upon Congress’s exclusive domain by criminalizing any manufacturing, display, distribution, or selling of an unauthorized copy of a term, label, design, or word, upsetting the careful balance struck by federal law. *See Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33-34 (2003) (noting the careful balance struck in copyright); *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 269-70 (5th Cir. 1988) (striking a Louisiana statute as violating federal copyright policy); *cf. Bonito Boats Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (noting similar balance in patent law, and rejecting a state law that upset such balance).

As the United States Supreme Court has long recognized, “any state law, however clearly within a State’s acknowledged power, which interferes with or is contrary to federal law, must yield.” *Free v. Bland*, 369 U.S. 663, 666 (1962) (citing *Gibbons v. Ogden*, 22 U.S. (9 Wheat.) 1, 210-11 (1824)). The courts of Massachusetts “are obligated to declare invalid any State statute or regulation that purports to regulate a field that Congress has reserved exclusively to itself.” *Commonwealth v. College Pro Painters Ltd.*, 418 Mass. 726 (1994).

To determine the scope of the exclusive domain of Congress, one must first examine congressional intent. *Id.* Congress’s intent to preempt state law can be expressly conveyed within a statute. *See Morales v. Trans World Airlines, Inc.*, 504 U.S. 374, 383 (1992). Congress has indicated that it intends to provide the exclusive basis for claims concerning the general subject matter of copyright law and rights granted thereunder. *See* 17 U.S.C. § 301. Courts must also consider the consequences of allowing concurrent regulation: if the state law conflicts with or impedes the full objective of Congress in the relevant federal law, the state law is preempted. *See Hisquierdo v. Hisquierdo*, 439 U.S. 572, 590 (1979); *Hines v. Davidowitz*, 312 U.S. 52, 67 (1941). In the case of copyright, both approaches dictate that Section 147 must be struck.

**B. All Claims Raised under Section 147 are Expressly Preempted through Section 301 of the Copyright Act, and Therefore Section 147 is Void Under the Supremacy Clause.**

Section 301 of the Copyright Act (“Section 301”) states that “all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright . . . are governed exclusively by this title.” 17 U.S.C. § 301(a).<sup>7</sup> The section, through its open and general terms, plainly indicates Congress’s intended exclusive domain. Although Section 301 itself acts to preempt particular claims, where every claim that could be brought under a particular state statute would assert only rights equivalent to copyright and thus invade Congress’s intended exclusive domain, a court must strike the law itself under the Supremacy Clause. *See Orson, Inc. v. Miramax Film Corp.*, 189 F.3d 377, 382-87 (3d Cir. 1999) (using § 301 as a framework to analyze and strike a state statute controlling motion picture distributions under the Supremacy Clause).

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<sup>7</sup> The full text of 17 U.S.C. § 301 is set forth in Appendix D.

The Supreme Judicial Court has employed a two-part test for analyzing the scope of copyright preemption under Section 301 of the Copyright Act. According to the Supreme Judicial Court, a claim is preempted when (1) the work of authorship at issue is within the type of works protected by the Copyright Act, and (2) the State law claim asserts a legal or equitable right equivalent to the rights under section 106 of the Copyright Act. *Curtis v. Herb Chambers I-95, Inc.*, 458 Mass. 674 (2011). As explained below, the works protected under Section 147 are within the same subject matter, and every right granted under the statute is equivalent to a corresponding right under copyright. Accordingly, because every claim under Section 147 would be preempted by Section 301, Section 147 itself is void.

*1. The Works Protected Under Section 147 are the Same Subject Matter as those Protected Under Section 106 of the Copyright Act.*

As noted above, a claim is preempted under the express provision of Section 301 when the claim “come[s] within the subject matter of copyright.” 17 U.S.C. § 301(a). Claims based on works within this scope are preempted regardless of whether the works are actually protected under federal law. Therefore, a state cannot decide to grant copyright-like protection to works that are not federally protected, such as works that are in the public domain, insufficiently original, or embodied in a useful article. *See Skinder-Strauss Assocs. v. Mass. Continuing Legal Educ., Inc.*, 914 F. Supp. 665, 680-81 (D. Mass. 1995) (finding a section 93A claim preempted, whilst simultaneously finding the work at issue unprotectable under federal copyright); H.R. Rep. No. 94-1476, at 131 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5747 (“As long as a work fits within one of the general subject matter categories . . . the bill prevents the States from protecting it even if it fails to achieve Federal statutory copyright because it is too minimal or lacking in originality to qualify, or because it has fallen into the public domain.”); William F. Patry, *Patry on Copyright* § 18:14 (2012) (noting that Congress chose the words “within the

subject matter of copyright” over “subject to protection” to preempt state protection of federally unprotected works).

The Copyright Act defines the subject matter of federal copyright as “original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated . . . .” 17 U.S.C. § 102(a). The statute enumerates the works in question as including, *inter alia*, literary works – which includes any expression of words or numbers, regardless of length – pictorial and graphic works, sculptural works, music and sound recordings, and audiovisual works. 17 U.S.C. § 102(a); *see* 17 U.S.C. § 101 (defining “literary work” as “any work other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia”).

In comparison, the subject matter of Section 147 is defined as “any trademark, service mark, trade name, label, term, device, design or word” that is used to identify another’s goods or services. M.G.L. ch. 266, § 147(a). The terms “trade name,” “label,” “term,” “device,” “design,” and “word” clearly refer to items that would be called graphic, literary, or sculptural works in the copyright context. Both Massachusetts trademark law and the federal Lanham Act define “trademark” and “service mark” as any “word, name, symbol, or device” that is used to identify and distinguish goods or services. *See* M.G.L. ch. 110H, § 1; 15 U.S.C. § 1127. These, too, are within the general categories of copyright as literary, graphic, sculptural, or aural works. By requiring state or federal registration before protecting the word or image, Section 147 ensures that all works protected under this statute will be fixed in a tangible medium of expression, as required to fall within the scope of section 301. *Compare* 17 U.S.C. § 102(a) (noting that works must be “fixed in a tangible medium of expression” for copyright), *with* 37 C.F.R. § 2.21(a)(3) (requiring a federal trademark applicant to submit a “clear drawing of a mark”), *and* 950 Mass.

Code Regs. § 62.13(2) (application to register a trademark in Massachusetts “must be accompanied by a specimen showing the mark in use”).

Accordingly, the entire scope of Section 147 falls within the subject matter of copyright.

2. *Section 147 Governs the Same Rights as Copyright, By Criminalizing the Manufacture, Display, and Distribution of a Word or Image, Without More.*

Congress also intended to preempt state grants of any right within the general scope of the rights of copyright. 17 U.S.C. § 301(a). A law will not survive preemption merely because it grants slightly different rights from the specific rights under copyright. *See Patry, supra*, at § 18:16 (“The state right may be narrower, broader, or contain somewhat different elements, yet it will still be preempted if its essence is the same as the federal right; that’s why the test is one of equivalency, not identity.”). Quite to the contrary, allowing slight modifications to the scope of rights would allow states to upset the balance struck by Congress between the exclusive rights of authors and the rights of the general public through incremental adjustments.

Instead, the Supreme Judicial Court has indicated that a law is “equivalent” to the rights granted under Copyright when (a) an act violating the state law right would, by itself, violate the exclusive right provided by federal copyright law, and (b) the state claim has no “extra element” that changes the action so that it is “qualitatively different from a copyright infringement claim.”

*Curtis*, 458 Mass. at 678 (quoting *Computer Assocs. Int’l v. Altai, Inc.*, 982 F.2d 693, 716 (2d Cir. 1992)).<sup>8</sup> The Massachusetts Appeals Court has stated that “[t]he extra element inquiry is not

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<sup>8</sup> It is this “extra element” test that saves state trademark law claims, provided that such claim is based upon a requirement of showing a likelihood of confusion or intent to deceive. *See Curtis*, 458 Mass. at 421 (striking several claims as preempted, except deception through fraudulent misrepresentation); *John G. Danielson, Inc. v. Winchester-Conant Properties, Inc.*, 186 F. Supp. 2d 1, 29 (D. Mass. 2002) (preempting a Chapter 93A claim absent allegations of deception); *see also Patry, supra*, at § 18:36 (“[T]he key to a non-preempted claim is that the conduct concerns

accomplished merely by counting the elements of a claim. The fact that a State claim has more elements than a Federal claim will not necessarily save it from preemption . . . . Rather, the dispositive factor is the nature of the claim asserted.” *Lee v. Mt. Ivy Press, L.P.*, 63 Mass. App. Ct. 538, 549 (2005) (internal citations omitted). “Elements of intent or commercial malfeasance are not sufficient to save a state claim from preemption.” *Feldman v. Twentieth Century Fox Film Corp.*, 723 F. Supp. 2d 357, 360 (D. Mass. 2010).

Because Section 147 criminalizes infringement upon the same rights that are granted by federal copyright law, without any further elements or requirements, it satisfies the second prong of the SJC’s copyright preemption test. Section 106 of the Copyright Act sets forth the essential rights protected under copyright:

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work . . . ; (2) to prepare derivative works . . . ; (3) to distribute [the] work to the public . . . ; (4) [in the case of all works except sound recordings] to perform the copyrighted work publicly; (5) . . . to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 106. Section 147 covers the same ground. The relevant text of Section 147 reads as follows:

Whoever willfully manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any item or services bearing or identified by a counterfeit mark shall be punished as follows:

M.G.L. ch. 266, § 147(b). As noted above, a “counterfeit mark” is defined as an unauthorized reproduction of “intellectual property,” where “intellectual property” is defined as “any

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the manner of marketing of the work, rather than the copying.”). As explained above, Section 147 does not require such an element.



trademark, service mark, trade name, label, term, device, design or word” that is adopted and registered to define one’s goods or services. § 147(a).

It is facially apparent that the acts criminalized in Section 147 are the same in nature as those in section 106 of the Copyright Act. Much of the language is identical, or virtually so. The rights of “display” and “distribut[ion]” are identical. No meaningful, qualitative difference can be made between the unauthorized “manufacture[.]” of an item bearing a word or image and the unauthorized “reproduc[tion]” of the same.

Similarly, commercial “sale” is within the scope of distribution under the Copyright Act. *See* 17 U.S.C. § 106(3) (“distribution” includes “by sale or other transfer of ownership”). For works within the scope of copyright, prohibiting “advertise[ment]” of items bearing an unauthorized word or image is, in essence, an attempt to proscribe the passing off of creative works as one’s own. The Supreme Judicial Court has already held such a claim preempted. *Curtis*, 458 Mass. at 678-79; *see People v. Borriello*, 588 N.Y.S.2d 991, 995 (N.Y. Sup. Ct.1992) (“The element of ‘advertisement’ for sale is also not an ‘extra element’ that would qualitatively change the statute.”). The catchall term “use” does not impart any meaning that would not be covered by the rights of display, performance, reproduction, or distribution in copyright. Indeed, the word “use” is frequently employed in the Copyright Act as a shorthand for an action which implicates some or all of the enumerated federal rights. *See, e.g.*, 17 U.S.C. § 101 (mentioning “use” of a work made for hire); § 104A(e)(2)(B) (concerning “use” of a work previously in the public domain); § 106A(c)(3) (concerning “reproduction, depiction, portrayal, or other use” of a work of visual art); § 108(f)(2) (concerning “use” of copies of works made in a library); § 112(d) (concerning the “use” of an ephemeral recording).

For these reasons, all claims arising under Section 147 would amount to allegations that the defendant committed an act governed by the exclusive rights of copyright, to a type of work protected under the subject matter of copyright. No additional elements are. Congress, through section 301, has clearly indicated that such a law cannot stand, and this court is therefore “obligated to declare” the law invalid. *College Pro Painters*, 418 Mass. at 728.

**C. Section 147 Directly Conflicts With Federal Copyright Policy By Criminalizing Uses of Another’s Word Or Image in Circumstances Where Congress Has Expressly Allowed Such Uses.**

Allowing Section 147 to stand not only contravenes the express intent of Congress, it also “stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.” *Hines*, 312 U.S. at 67. The express preemption of all equivalent state law claims reflects an effort to establish national uniformity in copyright law, “[o]ne of the fundamental purposes behind the Patent and Copyright Clauses of the Constitution.” *Bonito Boats*, 489 U.S. at 162. With this national uniformity, Congress has developed an intricate array of qualifications and limitations to the general exclusive rights of copyright, in order to safeguard free speech and fulfill its mission “[t]o promote the Progress of Science and useful Arts.” U.S. Const. Art. I § 8, cl. 8. This includes the free-speech protection of fair use, as discussed in part I.C *supra*, and other specific exemptions, compulsory licenses, and limitations on claims. *See, e.g.*, 17 U.S.C. § 108 (allowing copying of works for certain archival purposes); § 109 (restricting the exclusive right of distribution to the first sale of an item); § 115 (forcing the compulsory licensing of sound recordings embodying musical works).

This careful balance of copyright has been developed over the past 220 years, and cannot be supplanted by the Commonwealth’s decision to prohibit all copying, display, and distribution of certain works, without any safeguards or qualifications. *Cf. Bonito Boats*, 489 U.S. at 151

(noting, in a discussion of patent law, that “state regulation of intellectual property must yield to the extent that it clashes with the balance struck by Congress”). Section 147 makes criminal countless acts that federal law protects as part of its carefully-constructed balance and greater objective of promoting the progress of science and art. Under the Supremacy Clause, this conflict must be resolved in favor of federal law. For this reason, Section 147 must be declared void.

### **CONCLUSION**

For the foregoing reasons, the DMLP respectfully requests that this court hold Section 147 invalid, both as unconstitutionally overbroad under the First Amendment and Article 16 of the Massachusetts Declaration of Rights, and as preempted by federal copyright law.

Respectfully submitted,

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## Appendix A – M.G.L. ch. 266, § 147

### Section 147 – Items or services bearing or identified by counterfeit mark; sales; penalties

(a) For purposes of this section, the following words shall have the following meanings:—

“Counterfeit mark”, any unauthorized reproduction or copy of intellectual property, or intellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed, or identifying services offered or rendered, without the authority of the owner of the intellectual property.

“Intellectual property”, any trademark, service mark, trade name, label, term, device, design or word that is (1) adopted or used by a person to identify such person’s goods or services, and (2) registered, filed or recorded under the laws of the commonwealth or of any other state, or registered in the principal register of the United States Patent and Trademark Office.

“Retail value”, the counterfeiter’s regular selling price for the item or service bearing or identified by the counterfeit mark; provided, however, that in the case of items bearing a counterfeit mark which are components of a finished product, the retail value shall be the counterfeiter’s regular selling price of the finished product on or in which the component would be utilized.

(b) Whoever willfully manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any item or services bearing or identified by a counterfeit mark shall be punished as follows:

(1) if the violation involves 100 or fewer items bearing a counterfeit mark or the total retail value of all items bearing or of services identified by a counterfeit mark is \$1,000 or less and is a first offense, by imprisonment in a jail or house of correction for not more than two and one-half years;

(2) if the violation involves more than 100 but fewer than 1,000 items bearing a counterfeit mark or the total retail value of all items bearing or of services identified by a counterfeit mark is more than \$1,000 but less than \$10,000 or is a second offense, by imprisonment in the state prison for not more than five years;

(3) if the violation involves 1,000 or more items bearing a counterfeit mark or the total retail value of all items bearing or of services identified by a counterfeit mark is \$10,000 or more or if the violation involves the manufacture or production of items bearing counterfeit marks or if the violation involves the manufacture or production of items that pose a threat to the public health or safety or it is a third or subsequent offense, by imprisonment in the state prison for not more than ten years.

(c) For the purposes of this section, the quantity or retail value of items or services shall include the aggregate quantity or retail value of all items bearing or of services identified by every counterfeit mark the defendant manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses.

(d) A person having possession, custody or control of more than 25 items bearing a counterfeit mark shall be presumed to possess said items with the intent to sell or distribute. Any state or federal certificate of registration of any intellectual property shall be prima facie evidence of the facts stated therein.

(e) Any person convicted under this section shall, in addition to any penalty imposed pursuant to subsection (b), be punished by a fine in an amount not to exceed three times the retail value of the items bearing or of services identified by a counterfeit mark, unless extenuating circumstances are shown by the defendant.

(f) Any person convicted under this section shall, in addition to any penalty imposed pursuant to subsections (b) and (e), be punished by a fine in an amount equal to 75 per cent of the retail value of the items bearing or of services identified by a counterfeit mark, when the items involved pose a threat to public health or safety.

(g) Any items bearing a counterfeit mark and all personal property including, but not limited to, any items, objects, tools, machines, equipment, instrumentalities or vehicles of any kind, employed or used in connection with a violation of this section shall be seized by any law enforcement office; provided, however, that all such seized personal property shall be forfeited in accordance with the provisions of chapter 257. Upon the request of the intellectual property owner, all seized items bearing a counterfeit mark shall be released to the intellectual property owner for destruction or disposition; provided, however, that if the intellectual property owner does not request release of seized items bearing a counterfeit mark, such items shall be destroyed unless the intellectual property owner consents to another disposition.

**Appendix B – Penn. Cons. Stat. § 4119 (as enacted Oct. 16, 1996)<sup>10</sup>**

§ 4119. Trademark counterfeiting

(a) Offense defined.—Any person who knowingly manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any items or services bearing or identified by a counterfeit mark shall be guilty of the crime of trademark counterfeiting.

(b) Presumption.—A person having possession, custody or control of more than 25 items bearing a counterfeit mark may be presumed to possess said items with intent to sell or distribute.

(c) Penalties.—

(1) Except as provided in paragraphs (2) and (3), a violation of this section constitutes a misdemeanor of the first degree.

(2) A violation of this section constitutes a felony of the third degree if:

(i) the defendant has previously been convicted under this section; or

(ii) the violation involves more than 100 but less than 1,000 items bearing a counterfeit mark or the total retail value of all items or services bearing or identified by a counterfeit mark is more than \$2,000, but less than \$10,000.

(3) A violation of this section constitutes a felony of the second degree if:

(i) the defendant has been previously convicted of two or more offenses under this section;

(ii) the violation involves the manufacture or production of items bearing counterfeit marks; or

(iii) the violation involves 1,000 or more items bearing a counterfeit mark or the total retail value of all items or services bearing or identified by a counterfeit mark is more than \$10,000.

(d) Quantity or retail value.—The quantity or retail value of items or services shall include the aggregate quantity or retail value of all items or services bearing or identified by every counterfeit mark the defendant manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses.

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<sup>10</sup> Following the Supreme Court of Pennsylvania's Decision in *Commonwealth v. Omar*, 981 A.2d 179 (Pa. 2009), the Pennsylvania General Assembly made significant amendments to the statute. See Pa. Legis. Serv. 2010-74, H.B. 727 (West) (Oct. 19, 2010). No other reported edits have been made to this section.

(e) Fine.—Any person convicted under this section shall be fined in accordance with existing law or an amount up to three times the retail value of the items or services bearing or identified by a counterfeit mark, whichever is greater, unless extenuating circumstances are shown by the defendant.

(f) Seizure, forfeiture and disposition.—

(1) Any items bearing a counterfeit mark and all personal property, including, but not limited to, any items, objects, tools, machines, equipment, instrumentalities or vehicles of any kind, knowingly employed or used in connection with a violation of this section may be seized by any law enforcement officer.

(2) All seized personal property referenced in paragraph (1) shall be forfeited in accordance with applicable law unless the prosecuting attorney responsible for the charges and the intellectual property owner consent in writing to another disposition.

(g) Evidence.—Any Federal or State certificate of registration of any intellectual property shall be prima facie evidence of the facts stated therein.

(h) Remedies cumulative.—The remedies provided for in this section shall be cumulative to the other civil and criminal remedies provided by law.

(i) Definitions.—As used in this section, the following words and phrases shall have the meanings given to them in this subsection:

“Counterfeit mark.” Any of the following:

(1) Any unauthorized reproduction or copy of intellectual property.

(2) Intellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed or identifying services offered or rendered, without the authority of the owner of the intellectual property.

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“Intellectual property.” Any trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify that person’s goods or services.

“Retail value.” The counterfeiter’s regular selling price for the item or service bearing or identified by the counterfeit mark. In the case of items bearing a counterfeit mark which are components of a finished product, the retail value shall be the counterfeiter’s regular selling price of the finished product on or in which the component would be utilized.



Appendix C – selected provisions of Penn. Cons. Stat. § 4119 and M.G.L. ch. 266, § 147,  
annotated for comparison

**Penn. Cons. Stat. § 4119 (as enacted)**

**Any person who knowingly** manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any **items** or services bearing or identified by a counterfeit mark shall be **guilty of the crime of trademark counterfeiting.**

**As used in** this section, the following words **and phrases** shall have the meanings **given to them in this subsection:**

“Counterfeit mark.” **Any of the following: (1)** Any unauthorized reproduction or copy of intellectual property. **(2)** Intellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed or identifying services offered or rendered, without the authority of the owner of the intellectual property.

“Intellectual property.” Any trademark, service mark, trade name, label, term, device, design or word adopted or used by a person to identify **that** person’s goods or services.

**M.G.L. ch. 266, § 147**

**Whoever willfully** manufactures, uses, displays, advertises, distributes, offers for sale, sells or possesses with intent to sell or distribute any **item** or services bearing or identified by a counterfeit mark shall be **punished as follows**

**For purposes of** this section, the following words shall have the **following** meanings:

“Counterfeit mark”, any unauthorized reproduction or copy of intellectual property, **or** intellectual property affixed to any item knowingly sold, offered for sale, manufactured or distributed, or identifying services offered or rendered, without the authority of the owner of the intellectual property.

“Intellectual property”, any trademark, service mark, trade name, label, term, device, design or word **that is (1)** adopted or used by a person to identify **such** person’s goods or services, **and (2) registered, filed or recorded under the laws of the commonwealth or of any other state, or registered in the principal register of the United States Patent and Trademark Office.**

## Appendix D – 17 U.S.C. § 301

### Section 301 – Preemption with respect to other laws

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to--

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or

(2) any cause of action arising from undertakings commenced before January 1, 1978;

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106; or

(4) State and local landmarks, historic preservation, zoning, or building codes, relating to architectural works protected under section 102(a)(8).

(c) With respect to sound recordings fixed before February 15, 1972, any rights or remedies under the common law or statutes of any State shall not be annulled or limited by this title until February 15, 2067. The preemptive provisions of subsection (a) shall apply to any such rights and remedies pertaining to any cause of action arising from undertakings commenced on and after February 15, 2067. Notwithstanding the provisions of section 303, no sound recording fixed before February 15, 1972, shall be subject to copyright under this title before, on, or after February 15, 2067.

(d) Nothing in this title annuls or limits any rights or remedies under any other Federal statute.

(e) The scope of Federal preemption under this section is not affected by the adherence of the United States to the Berne Convention or the satisfaction of obligations of the United States thereunder.

(f) (1) On or after the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990, all legal or equitable rights that are equivalent to any of the rights conferred by section 106A with respect to works of visual art to which the rights conferred by section 106A apply are governed exclusively by section 106A and section 113(d) and the provisions of this title relating to such sections. Thereafter, no person is entitled to any

such right or equivalent right in any work of visual art under the common law or statutes of any State.

(2) Nothing in paragraph (1) annuls or limits any rights or remedies under the common law or statutes of any State with respect to--

(A) any cause of action from undertakings commenced before the effective date set forth in section 610(a) of the Visual Artists Rights Act of 1990;

(B) activities violating legal or equitable rights that are not equivalent to any of the rights conferred by section 106A with respect to works of visual art; or

(C) activities violating legal or equitable rights which extend beyond the life of the author.